

IN THE UNITED STATES DISTRICT COURT
IN AND FOR THE DISTRICT OF DELAWARE

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F'REAL FOODS, LLC and RICH : CIVIL ACTION
PRODUCTS CORPORATION, :
 :
Plaintiffs, :
 :
vs. :
 :
HAMILTON BEACH BRANDS, :
INC., HERSHEY CREAMERY :
COMPANY and PAUL MILLS :
d/b/a MILLS BROTHERS :
MARKETS, :
 : NO. 16-41 (CFC)
Defendants. : CONSOLIDATED

- - -

Wilmington, Delaware
Thursday, April 11, 2018
1:06 o'clock, p.m.

- - -

BEFORE: HONORABLE COLM F. CONNOLLY, U.S.D.C.J.

- - -

APPEARANCES:

MORRIS, NICHOLS, ARSHT & TUNNELL LLP
BY: RODGER D, SMITH II, ESQ. and
MICHAEL J. FLYNN, ESQ.

-and-

Valerie J. Gunning
Official Court Reporter

1 APPEARANCES (Continued):

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4 (San Francisco, California)

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6 f'real Foods, LLC and Rich Products
7 Corporation

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9 BY: FRANCIS DiGIOVANNI, ESQ. and

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11 -and-

12 DRINKER BIDDLE & REATH LLP

13 BY: WILLIAM S. FOSTER, JR., ESQ.

14 BRIANNA L. SILVERSTEIN, ESQ.
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P R O C E E D I N G S

(Proceedings commenced in the courtroom at 1:06 p.m.)

THE COURT: All right. Good afternoon. Please be seated.

Mr. Smith or Mr. Flynn. Sorry.

MR. FLYNN: Good afternoon, Your Honor. Michael Flynn from Morris Nichols. With me, my partner, Rodger Smith, and Guy Chambers from Sideman & Bancroft in San Francisco.

THE COURT: All right. Thank you.

Mr. DiGiovanni?

MR. DiGIOVANNI: Good afternoon, Your Honor. It's Frank DiGiovanni from Drinker Biddle & Reath.

With me today is Bill Foster, also from Drinker, Biddle & Reath in our D.C. office, Thatcher Rahmeier, he's from our Wilmington office and Brianna Silverstein from the D.C. office.

THE COURT: All right. Thank you.

All right. A couple housekeeping things I will just inform you. I am going to put willfulness back into the case-in-chief. There was a misunderstanding. I wasn't going to bifurcate. I mean, to the extent I used that word,

1 what I meant was, I was going to try infringement and then
2 after the verdict go right into willfulness if there had
3 been a finding of infringement. But I've decided, and
4 frankly, it has to do with now I'm much more familiar with
5 the case, to the issue of copying, and I felt it would be --
6 I'm probably informed by some of the tactics I've seen in
7 the litigation, but, in any event, I'm going to put
8 infringement -- we're going to just try it all together. It
9 seems to me it would be more efficient. And obviously
10 that's just a fact-finding issue because the question of
11 enhanced damages is left to the Court, and I will make the
12 ultimate decision if there were finding of liability as to
13 whether to award damages under 284.

14 But under the Third Circuit case law as I
15 understand it, willfulness has to go to the jury, so that's
16 fact-finding, and so I've decided all in all, and this is
17 something left completely to the Court's discretion, I think
18 we should go ahead and do the willfulness before we have a
19 verdict. All right?

20 MR. DiGIOVANNI: Your Honor, may I just say --
21 we will ask to file an amendment to the pretrial order
22 because we did not put all of our willfulness witnesses on
23 there.

24 We had understood it was not part of the --

25 THE COURT: Well, that was going to happen

1 anyway. But I was startled to see, and I can't remember
2 the exact wording, I was -- in my mind, it was pretty clear
3 what we were going to do, which is we were going to try the
4 case, and then if there was a finding of infringement, we
5 were going right to willfulness. What was your
6 understanding?

7 MR. SMITH: Your Honor, I didn't have an
8 understanding as to the timing.

9 THE COURT: All right.

10 MR. SMITH: I understood it was separated to be
11 determined.

12 THE COURT: Well, so that's just unfortunate,
13 but I wasn't going to bring a jury back. It never was in my
14 mind that we would have a break and then bring a jury back
15 in at some later date. So I guess we can address that. I
16 mean, we'll have to -- but I think both sides it sounds like
17 did not have a definitive view, or maybe you had a
18 definitive view, but it was clear to me as soon as I read
19 the papers that I was going to have to address this.

20 MR. SMITH: I agree with Mr. DiGiovanni. I
21 think we will have to take a look at the existing pretrial
22 order to make sure that any wilfulness specific witnesses,
23 and we should be able to do that in pretty short order, Your
24 Honor.

25 THE COURT: Well, that's the thing. It

1 shouldn't be that long the way I see it. But I think I used
2 the word bifurcate, which, you know, although I thought then
3 in the followup order -- in any event, that's just the way
4 it is.

5 I thought there was some misunderstanding when I
6 saw the pretrial order and the way you both identified it as
7 an issue to be dealt with and when we were going to do it.
8 When I issued it initially, the idea was, as I say, to do it
9 in two stages, but in light of I decided everything else
10 I've read, I actually think we should just do it in one
11 stage in this case. And I'm not going to do that in every
12 case, but I think this case is the right case to not
13 separate it out.

14 MR. DiGIOVANNI: In terms of, we're scheduled
15 for a five-day trial. Does that change at all?

16 THE COURT: I was going to give you 10 hours, so
17 you all asked for 14, and I don't think you should get 14.
18 And so, and I talked to my judges, colleagues, and they tell
19 me a five-day trial is typically 10 to 12, and my sense of
20 the technology and the facts and partly informed by the
21 redundancy of a lot of briefing, you guys can do it quicker
22 than if you had a time limitation, and I think ten hours
23 would be appropriate. I think I will add an eleventh hour
24 for wilfulness. You can have 11 hours.

25 MR. SMITH: Your Honor, I apologize. I'm not

1 familiar with whether you count the openings and closings in
2 that time frame.

3 THE COURT: I do. I count everything except for
4 the initial selection of the jury, except I will count
5 peremptory selection. Your clock will start ticking when we
6 get to peremptories.

7 MR. SMITH: Thank you, Your Honor.

8 THE COURT: And so no voir dire, you know,
9 nothing like that, but your clock will start ticking when we
10 get to peremptories, which I've had four trials since
11 January. It's amazing how fast peremptories move when
12 people are on the clock, so that doesn't take much time. It
13 will include openings, closings. It will include arguments
14 during the trial, and it will not include the jury charge
15 conference. I will separate that out. And so it will be
16 11 hours each.

17 MR. SMITH: Sorry, Your Honor. Your expectation
18 would be the jury would get the case Thursday or Friday
19 then?

20 THE COURT: Yes. So I just had a trial that I
21 saw Mr. DiGiovanni in the audience. That case I gave 11,
22 and I thought at the time, I thought I should have reduced
23 it. I regretted I didn't. Now, one side expanded it, but
24 unnecessarily, and took almost all 11. The other side was
25 three-and-a-half hours short and yet that was the side that

1 said they needed the 11 in that case. We tried it, started
2 Monday morning and we had it in the jury's hands Thursday
3 afternoon.

4 MR. SMITH: Thank you, Your Honor.

5 THE COURT: And I think this -- I mean, that
6 case was a very complicated drug case. You know, this is
7 pretty easy technology it seems to me.

8 MR. SMITH: Thank you.

9 MR. DiGIOVANNI: I would say, Your Honor,
10 obviously, we have four patents here and each patent has its
11 own issues as you know.

12 We did put in our pretrial order under "other"
13 an issue of perhaps further limiting the number of claims
14 that are asserted, and I think in view of your Honor's
15 ruling regarding time, that becomes even more important in
16 our view.

17 THE COURT: And I mean, I think the plaintiffs
18 would be insane to try -- if they didn't narrow their case.
19 And I kind of thought I should just leave it to you all, you
20 know.

21 I think what I could do, what I would be happy
22 to do is put a time limitation. They've got to tell you on
23 a date certain what it is, and if they aren't going to
24 narrow it and think they are going to try it, I mean, I'm
25 going to hold them to the time. And I mean good luck if

1 you try to try that not having a directed verdict on some
2 stuff. I can't envision they would want to do that. I
3 mean, how do you want to proceed?

4 I would rather not tell them they have X number
5 and you have X number. I would rather, you know, you guys
6 all figure it out knowing the time constraints.

7 MR. DiGIOVANNI: I would say this. We have
8 asked them. We've had a discussions about further limiting
9 it, and in our view, especially in view of the time
10 limitation now, we think it is imperative that they reduce
11 the number of claims, and we think it does impact us
12 perhaps.

13 THE COURT: Sure. I know it does, but I mean,
14 you're really going to try all of these patents, all of
15 these asserted claims?

16 MR. CHAMBERS: Your Honor, we have summary
17 judgment motions today, so perhaps after we get that sorted
18 out, we'll definitely take another look in view of Your
19 Honor's comments. And, yes, we will take those to heart and
20 to look at reducing again.

21 THE COURT: I mean, have you tried patent cases
22 before?

23 MR. CHAMBERS: Yes.

24 THE COURT: And you're going to try this many
25 claims? Let's say I deny all the summary judgment. You are

1 going to put in front of a jury all of these claims and
2 limitations?

3 MR. CHAMBERS: I think it could be done, Your
4 Honor. I've done a two-day, full two-day patent trial.
5 Things can be done in two days, but let me work with
6 co-counsel, and in view of Your Honor's express points, and
7 we have reduced it before and we're open to looking at
8 reducing it again.

9 THE COURT: Okay. So why don't we wait and see
10 again where we are on that.

11 MR. DiGIOVANNI: Okay. Your Honor, one point of
12 clarification. I think you already said this and I
13 apologize. Will the verdict form have willfulness, the
14 single verdict form have willfulness, or are we going to
15 have an original verdict without willfulness and then bring
16 the jury back?

17 THE COURT: No. We're going to go ahead and
18 just put it in front of them. I mean, you know, we've got
19 copying allegations. Right? I mean, to me, and I read the
20 stuff and I thought, this is not -- I mean, I had thought
21 initially this is the way to do it.

22 As you know, I'm just getting started. And I
23 mean, it was an open court. In the case I tried that I saw
24 you, I actually debated whether to even send willfulness to
25 the jury and made a number of comments. Now, it turns out

1 there was a finding of noninfringement, so it became a moot
2 point.

3 But my sense of this case is that it will
4 inevitably spill into some of the willfulness evidence. It
5 would be very hard to really, to definitively segregate it,
6 and so then we're going to have to retry it and I can see
7 the overlap. And I know this overlap argument was made on
8 the phone when I originally ruled and, you know, I know it
9 can always be made, and I was skeptical about it and I said
10 I think we can work it out. I don't think we really can in
11 this case in a really helpful way. So I just think we ought
12 to go ahead and put it in front of the jury.

13 MR. DiGIOVANNI: One thing I will say. The
14 pretrial order, because it didn't include willfulness, it
15 didn't include things like opinions of counsel and other
16 items that are going to now have to be part of this first
17 trial.

18 THE COURT: Well, and I mean, I recognize that.
19 I mean, look. I was surprised when I read your papers that
20 it was clear to me you were at least contemplating we were
21 going to have a different -- I don't think it was going to
22 be a different jury, are we going to bring them back a month
23 later. That was never intended by my comments when I said
24 we would separate or bifurcate or do it.

25 And I thought -- does somebody have my order? I

1 think I used the word separate intentionally because at
2 least it was not this case, or another case, where somebody
3 said to me bifurcate in their mind meant two complete -- not
4 only separate proceedings, but that it would be in discovery
5 bifurcated and that was not my intent.

6 And I guess we can discuss, if you can't be
7 ready for trial on April 26th because of this, but it seems
8 to me it's not that much -- I mean, more work for me.

9 MR. DiGIOVANNI: Because we have additional
10 witnesses who we have not lined up to appear, you know,
11 that's one wild card. I expect there are others, too, that
12 we have not thought about just standing here.

13 MR. CHAMBERS: Your Honor, they've designated
14 one witness as their opinion of counsel witness.

15 THE COURT: And how is that helpful?

16 MR. CHAMBERS: I think the trial can still go
17 ahead as scheduled on the 29th. There's not that much more
18 that needs to be done.

19 THE COURT: So do you know who their willfulness
20 witness is going to be?

21 MR. CHAMBERS: Yes. I'm trying to remember the
22 name of the attorney. Was that Raring? I think his name
23 was Alex Raring. That's the only witness that I'm aware of
24 that they would have on advice of counsel.

25 THE COURT: Well, I'm not sure how helpful that

1 comment was. I think Mr. DiGiovanni just was making the
2 point there might be other witnesses that he would need to
3 consult with in terms of scheduling, and that seems to me to
4 be a fair point, especially when it looks like your side as
5 it turns out didn't have the understanding I had either. So
6 reasonable minds can have different interpretations of what
7 my words meant.

8 I thought it was pretty clear. It wasn't.
9 Reasonable people at counsel table, they had a different
10 view. So I think we would all be better off to try to just
11 have helpful comments for the remainder of the day.

12 All right. That's where we are on willfulness.
13 We'll have to revisit the scheduling thing when we get to
14 the end of the day.

15 You all saw that I issued opinions on, very
16 short on the motion in limine that could affect a summary
17 judgment argument or I guess some of the other arguments
18 today. Did you both --

19 MR. SMITH: We saw the estoppel opinion
20 yesterday and this morning I think it was a Daubert order we
21 saw.

22 THE COURT: Correct. All right. Let me just
23 make a comment to everybody. I mean, you may not even know
24 this because I don't know how you guys do the briefing and
25 how it gets to us, but it's really hard to get through, you

1 know, a document this thick without tabs, so I'm going to
2 revise my order, my form order, hopefully tomorrow if not
3 next week. But I guess it's a good adage just to think
4 about if you want -- I mean, the page numbers are not even
5 chronological because we're talking multiple exhibits, and
6 so when we have 32 exhibits, I think it would be a good idea
7 to have tabs so I can get to them, but anyway I'm going to
8 make that rule now.

9 I'm going to end up with a scheduling order
10 25 pages long because of all the little rules I thought were
11 pretty obvious. I know lawyers don't necessarily know what
12 paralegals are doing to get the documents in front of us.
13 So keep that in mind as you go through oral argument today.
14 It's hard to just flip to a document and try to find
15 something.

16 MR. SMITH: Your Honor, if there's any
17 replacement copies you would like, I would be happy to. I
18 know it's after the fact.

19 THE COURT: Yes. I think at this point, it's
20 probably --

21 MR. SMITH: Understood.

22 THE COURT: Yes. I'm amending my order, but
23 just in case this order doesn't go out until next week and
24 you all have another case in front of me, it can be just
25 used as.

1 All right. Now, let's go through what would be
2 beneficial. Do you all agree that some of the motion in
3 limines could affect the summary judgment arguments?

4 MR. DiGIOVANNI: Certainly, Your Honor.

5 THE COURT: Yes. I mean, so maybe we should do
6 those first and then hit the summary judgment.

7 MR. DiGIOVANNI: Sure, Your Honor, we can do
8 that.

9 MR. CHAMBERS: Actually, Your Honor, I'm trying
10 to be helpful, but I thought that it would actually be the
11 opposite, that if the issues get narrowed down on summary
12 judgment, I think there's one the motions in limine that, or
13 some of the motions in limine could become moot if we narrow
14 the case down on summary judgment.

15 THE COURT: I thought there was some -- well,
16 let's take, like, Sato.

17 MR. CHAMBERS: Yes.

18 THE COURT: It wouldn't be good to deal with
19 that in the motion in limine first?

20 MR. CHAMBERS: Fine, Your Honor.

21 THE COURT: I don't know. I'm just asking and
22 thinking out loud here.

23 Why don't we go through this. I want to go
24 through the motion in limines first actually. I just think
25 it's going to be beneficial, so let's do that.

1 All right. So let's start with, and let's just
2 do them in order. So let's start with plaintiffs' motion in
3 limine one to preclude Japanese Utility Model Publication
4 No. 1992-136787 as prior art, and this is, of course, the
5 Sato prior art reference. All right?

6 Mr. Flynn, are you arguing this?

7 MR. FLYNN: Good afternoon, Your Honor.

8 THE COURT: All right.

9 MR. FLYNN: Michael Flynn, to address our motion
10 in limine. It was Exhibit 13 of the pretrial order.

11 Your Honor, I think in light of your order
12 yesterday on the motion in limine on IPR estoppel, the Court
13 recognizes that the defendants have explicitly,
14 unequivocally told the Court that a skilled searcher doing a
15 diligent search could not find Sato and they couldn't do it
16 in 2014 and 2015 using the very best databases, the most
17 skilled researchers, and using the very same databases that
18 the Patent and Trademark Office uses that the Patent Office
19 says contain every foreign patent that has been publicly
20 disseminated.

21 The declarations they filed in opposition to the
22 prior motion in limine make it very clear that even with the
23 Sato reference number, a skilled searcher couldn't find the
24 Sato reference.

25 Now, defendants have the burden of proof of

1 coming forward with evidence --

2 THE COURT: Can I just ask you, though. This is
3 what I find happens all the time in patent cases. I think
4 you guys are -- you seem to have no problem taking both
5 sides of the same issue. Didn't you take the flip side in
6 the collateral estoppel argument?

7 MR. FLYNN: Your Honor, we did. We said that in
8 2017, or 2016, their searchers said they couldn't find it.
9 Right. Their burden is to show that at the relevant time
10 period in 2002, 2003, prior to the filing of the '150
11 patent, it was publicly accessible. Those are two different
12 issues.

13 Now, the fact that their searcher did find it in
14 2017 in Japan and their searchers searching all the English
15 language databases, everything the PTO has couldn't find it,
16 may mean that in 2017, it was available in Japan. But their
17 burden is to show that it was publicly accessible to a
18 person of ordinary skill in the art doing a reasonable
19 search in 2002 and 2003, before the priority date of the
20 '150 patent.

21 They have not shown that at all. The only
22 evidence they've put in is the MPET procedures, which are
23 the recent MPET procedures, which say that all foreign
24 patent applications that have been publicly disseminated are
25 in the PTO databases that their searchers said they did an

1 exhaustive search on.

2 They put in the 2006 version of the Japan
3 Utility Act, but that's irrelevant because, first, Exhibit B
4 to their opposition, I couldn't find anything in there that
5 discusses publication requirements. But it's irrelevant
6 because it's from 2006 and not the version when -- not even
7 the version from 2003, but it would have been, the relevant
8 version of that would be in 1992, when Sato would have been
9 published if it had been published in a patent gazette in
10 Japan.

11 Their own searchers say there was no way to find
12 this, and the Federal Circuit case law is pretty clear that
13 the -- I mean, I think the SRI case says that the touchstone
14 of whether it's printed publication is public accessibility,
15 and it's public accessibility to someone of ordinary skill
16 in the art doing a reasonably diligent search who is
17 interested in the art.

18 THE COURT: Let me ask you: What's the burden
19 of proof?

20 MR. FLYNN: The burden of proof on them is to
21 demonstrate by clear and convincing evidence that it is a
22 printed publication under Section 102.

23 THE COURT: And what do you cite? So I looked
24 at your -- you cite Federal Rule of Evidence 803, 901 and
25 902 in support of that proposition. Where in those rules

1 does it say that -- and actually, I will read the sentence
2 from your pretrial order section. "Defendants have the
3 burden under the Federal Rules of Evidence to show by clear
4 and convincing evidence that the documents they intend to
5 assert as prior art are authentic, admissible, and/or
6 publicly available before the relevant date to qualify as
7 prior art under 35 U.S.C., Section 102," and then your cited
8 support is Federal Rule of Evidence 803, 901 and 102.

9 Where in those rules is there support for that
10 proposition that there's a clear and convincing standard of
11 proof?

12 MR. FLYNN: Your Honor, in those rules, there's
13 not. Those are the authentic rules.

14 THE COURT: And, in fact, those rules are lower.
15 Right? 901, it's not even a preponderance.

16 MR. FLYNN: Right.

17 THE COURT: So that's just a mistake on your
18 part citing --

19 MR. FLYNN: For the authenticity of the
20 document.

21 THE COURT: Wait. Can you point me to any
22 authority that says to show authenticity, you need to have a
23 clear and convincing showing?

24 MR. FLYNN: Your Honor, that's not what I'm
25 saying. To demonstrate authenticity, the burden is lower.

1 To demonstrate that it is a printed publication under
2 Section 802, the burden is clear and convincing evidence.
3 In our reply brief, we cite the Federal Circuit -- I'm
4 sorry, the Supreme Court case Microsoft versus i4i Limited
5 Partnership, the concurring opinion by Justices Breyer,
6 Scalia and Alito, where they say that the accused infringer
7 has a burden of clear and convincing evidence.

8 THE COURT: Can I ask you about that? So you've
9 got three justices that are in that opinion, Scalia, Alito
10 and Breyer. You've got four justices that didn't sign onto
11 that opinion who concurred in the judgment and signed onto
12 the lead opinion.

13 Doesn't that tell me that the majority of the
14 Court, the plurality of the Supreme Court doesn't agree with
15 you?

16 MR. FLYNN: Your Honor, I'm not sure there's a
17 dispute about whether they have to demonstrate by clear and
18 convincing evidence that something is prior art.

19 THE COURT: Okay.

20 MR. FLYNN: I mean, their burden is to prove by
21 clear and convincing evidence that a printed publication is
22 prior art to the patents-in-suit. I'm not sure that's even
23 an issue. What they are arguing is that by, you know,
24 purely by the rule that somehow a publication that they've
25 said wasn't publicly accessible somehow becomes a printed

1 publication when the standard set by the Federal Circuit
2 says that's not the case. I mean, you know, we're not the
3 ones who said it couldn't have been found. They said it,
4 not with one but two declarations, that using the best
5 databases, the same ones the PTO uses --

6 THE COURT: You said it could have been found.

7 MR. FLYNN: We said it could have been found
8 with respect to filing the IPR in 2016.

9 THE COURT: So why could it be found in 2016 --
10 wait. Just so we're all clear, what's the relevant date
11 that they have to show public accessible?

12 MR. FLYNN: It would certainly -- I mean, we
13 can say that it's the filing date of the patents,
14 November 2003.

15 THE COURT: Well, what do you want to say?

16 MR. FLYNN: More likely, let's say it's the
17 priority date of November of 2002. That's when they would
18 have to show that it was publicly accessible to a person of
19 reasonable skill in the art.

20 THE COURT: All right.

21 MR. FLYNN: Now --

22 THE COURT: Anything else?

23 MR. FLYNN: I'm happy to respond to any
24 questions or hear what the defendants have to say.

25 THE COURT: All right.

1 MR. FLYNN: Thank you, Your Honor.

2 MS. SILVERSTEIN: Good afternoon, Your Honor.

3 Brianna Silverstein for defendants.

4 It's clear that what the plaintiffs are doing
5 here is trying to conflate two different standards. The
6 estoppel standard that we've met is that a reasonable
7 searcher couldn't have found it in a diligent search when we
8 were doing the IPR search. One important distinction there
9 is that we were searching, our searchers were searching in
10 English only and the Sato publication wasn't actually
11 translated into English.

12 And the public accessibility standard is
13 different, and I would like to address your point on what
14 the burden is. Under SRI International, that's 511 F3d.
15 1186, the Federal Circuit said that you just have to make a
16 satisfactory showing.

17 THE COURT: What does that mean?

18 MS. SILVERSTEIN: We have to show that the
19 document would have been disseminated or otherwise made
20 available to persons interested and ordinarily skilled in
21 the art.

22 THE COURT: But that begs the question, by what
23 standard. So what is satisfied? It seems to me it's kind
24 of circular or redundant. Actually, I'm familiar with the
25 language. I'm trying to figure out how it's helpful. What

1 does it mean to have a satisfied showing? That's putting
2 the cart before the horse, isn't it?

3 MS. SILVERSTEIN: You could say that. I'm just
4 quoting what the Federal Circuit said.

5 THE COURT: So what's your best guess as to what
6 the Federal Circuit means when it comes to making a
7 satisfying showing?

8 MS. SILVERSTEIN: I think in this case, there's
9 no doubt that we've shown. I mean, it's a public --

10 THE COURT: Let's see some words. What words
11 should I look at? Preponderance of the evidence? Clear and
12 convincing standard? I mean, Justice Breyer was very
13 explicit, it should be clear and convincing to show the
14 existence of the prior art. Right?

15 MS. SILVERSTEIN: Sure. Yes.

16 THE COURT: Should I just blow off Justice
17 Breyer?

18 MS. SILVERSTEIN: No. As you noted, that was a
19 concurrent thing. It wasn't the full Supreme Court.

20 THE COURT: All right. So give me some language
21 I can use to help me understand what satisfying means.

22 MS. SILVERSTEIN: I suppose we would argue that
23 it's closer to a preponderance of the evidence than the
24 clear and convincing standard, but I think in any case for
25 this particular document, there's no doubt that we meet both

1 of those standards.

2 THE COURT: Okay. So let me ask you this: Say
3 the standards are different and I will say I found, it
4 struck me that if I were writing the law from scratch, it
5 might make sense to distinguish 315 from 102. 315 seems to
6 be concerned about process, judicial efficiency. 102 seems
7 to be concerned about substantive, validity of patents. I
8 can see that.

9 But my problem having said that is, as I look at
10 Jazz Pharmaceuticals, Inc. against Amneal Pharmaceuticals
11 LLC, 895 F.3d, 1347, a Federal Circuit case, it says, "A
12 reference is considered publicly acceptable upon a showing
13 that such document has been disseminated or otherwise made
14 available to the extent that persons interested and
15 ordinarily skilled in the subject matter or art exercising
16 reasonable diligence can locate it." That's exactly what
17 Mr. Flynn said. That seems to be the exact same standard
18 that's at issue with '315.

19 MS. SILVERSTEIN: We agree with you, that's the
20 standard for whether it's publicly available, but we
21 disagree that it's the same as the '315. As a practical
22 matter, it can't be the same, because then an IPR petitioner
23 that is unsuccessful in the IPR would be completely
24 estopped.

25 THE COURT: Okay. But then you do agree that

1 what I ought to look to is, could a person interested in the
2 ordinary field, the subject matter or art exercising
3 reasonable diligence have located Sato. Right? You agree
4 that's the standard?

5 MS. SILVERSTEIN: Yes.

6 THE COURT: Okay. So real quick, like
7 30 seconds. Given the declaration of your two experts, how
8 do you possibly win it?

9 MS. SILVERSTEIN: Because their experts were
10 only searching within the English language and the public
11 accessibility standard is not limited to English language.

12 THE COURT: Do you know of any case law that
13 says when I should look at 315 versus 102, one ought to be
14 English only, one ought to be other languages?

15 MS. SILVERSTEIN: No, Your Honor, I don't, but
16 you've already ruled on our 315 motion and found that we met
17 the standard for 315. So we're just talking, I'm just
18 talking right now about the 102 standard, and I mean,
19 clearly, if you look at the Hoag case that we cited, that
20 was a German thesis that was only available in one library
21 in Germany, but because it was indexed, it was found to be
22 publicly accessible. And I think we would all agree that if
23 that piece of art wasn't found through a diligent search to
24 do for an IPR, that you wouldn't -- a petitioner wouldn't be
25 estopped from using it in the future.

1 I mean, one of the things that Mr. Flynn didn't
2 mention in his talk about our evidence is the actual Sato
3 publication itself. It says date of publication on it. And
4 they have not -- they have not pointed to any evidence of
5 any kind when a foreign patent publication, especially from
6 the Japanese Patent Office, was found to not be publicly
7 accessible.

8 THE COURT: All right. Okay. Thank you.

9 MR. FLYNN: Your Honor, do you want to hear
10 anything further?

11 THE COURT: No. Thank you.

12 All right. So we're looking then just to
13 summarize plaintiffs' motion in limine number one to
14 preclude the use of the Sato reference at trial because it
15 fails to meet the printed publication requirement, Section
16 102, and I agree with the plaintiffs on this. I
17 just don't see how the defendants can satisfy the standard
18 articulated in the Jazz Pharmaceuticals case that I read and
19 quoted from. And the standard is that a reference is
20 considered publicly accessible upon the showing that such
21 document has been disseminated or otherwise made available
22 to the extent that persons interested and ordinarily skilled
23 in the subject matter or art exercising reasonable diligence
24 can reasonably locate it and the sworn declaration of the
25 defendant's experts show that exercising reasonable

1 diligence, you would not be able to locate the Sato
2 reference, and therefore I think it didn't satisfy the
3 printed publication requirement.

4 Do you have a question?

5 MR. CHAMBERS: Are you ready for number two,
6 Your Honor?

7 MR. FOSTER: Your Honor, just for the record,
8 this is the first time that an official publication from a
9 foreign Patent Office has been declared publicly
10 inaccessible.

11 If you look at the cases of the Patent Office in
12 Australia that we cited --

13 THE COURT: Thank you very much. I've read your
14 papers and you made your argument.

15 MR. FOSTER: Yes, Your Honor.

16 THE COURT: And you submitted two sworn
17 declarations from patent experts that swore that they had,
18 and I relied upon it in ruling in your favor in a prior
19 motion, and your experts detailed the comprehensive and
20 diligent search that they say their companies executed or
21 performed to locate the Sato reference and that they said
22 they were unable to locate it, and they said that a person
23 of ordinary skill in the art could not locate it or be
24 expected to locate it with a diligent search. So you can
25 take your affidavits up the to Federal Circuit. All right.

1 Let's go with motion in limine number 2.

2 MR. CHAMBERS: Thank you, Your Honor. This is
3 to exclude entering into evidence of Hamilton Beach's
4 patents, and it's a bedrock principle of patent law that a
5 patent gives a right to exclude others, but it doesn't give
6 a right to use what's described in the patent yourself. Put
7 another way, simply because you get a patent, it doesn't
8 give you a free license to use everybody else's patented
9 technology.

10 If you get a patent for a little fastener clip,
11 that doesn't give you the right to make all sorts of other
12 inventions and then say that I have a patent.

13 THE COURT: All right. I tend to agree with
14 you. I think we'll save time if I hear from the defendants
15 first.

16 MR. RAHMEIER: Good afternoon, Your Honor.

17 THE COURT: Good afternoon.

18 MR. RAHMEIER: Thatcher Rahmeier for the
19 defendants.

20 Just to be clear, I don't know what the motion
21 was, but we're really just talking about one patent here,
22 and it's Hamilton Beach's, what we call the '823 patent.

23 THE COURT: Right.

24 MR. RAHMEIER: So --

25 THE COURT: So how about this. Can you tell me,

1 I'm looking at page 2 of your motion in limine response.
2 You say the patent is inextricably linked to Hamilton
3 Beach's work on the accused product.

4 Actually, can I stop you there. Just so I
5 understand, because this is going to come up in other
6 contexts. There are two defendants. Right?

7 MR. RAHMEIER: There are two defendants.
8 There's Hershey and there's Hamilton Beach.

9 THE COURT: Okay. So on this one, this
10 particular issue is only relevant to Hamilton Beach. Is
11 that right?

12 MR. RAHMEIER: Well, yes. It's Hamilton Beach's
13 patent. It's about their design work and it relates to the
14 accused products that Hamilton Beach made. Hershey's is a
15 customer.

16 THE COURT: All right. So then going back to
17 the language in your brief, you say the patent is
18 inextricably linked to Hamilton Beach's work on the accused
19 product. It illustrates the pertinent feature of the
20 product and it demonstrates the steps. And let's stop
21 there.

22 I think you have to agree, introducing
23 unnecessarily a patent to the jury could lead to confusion.
24 Do you agree with that?

25 MR. RAHMEIER: We agree that a limiting

1 instruction is appropriate.

2 THE COURT: I get that. But to answer my
3 question is, so you do agree, the fact that you were willing
4 to go with a limiting instruction, it could lead to
5 confusion?

6 MR. RAHMEIER: It could.

7 THE COURT: Now, it could arguably be corrected
8 or avoided with a limiting instruction. But given that, how
9 does it help the jury, how is it probative to show how the
10 features of a product were to have a patent?

11 MR. RAHMEIER: So you're asking me just about
12 the features?

13 THE COURT: I'm going to go through them
14 individually. Let's just talk about the features.

15 MR. RAHMEIER: Yes. This patent is the result
16 of basically the research and development of these accused
17 products, not just similar products, but the products at
18 issue in this case.

19 THE COURT: But I mean, look, if you got the
20 accused product, you could introduce testimony, somebody who
21 worked. You could show plans, designing of the product.
22 You could show pictures of it. Why do you need to have a
23 the patent to explain to the jury what the features are of
24 the product? Just help me out with that.

25 MR. RAHMEIER: Sure. In this case particularly,

1 the patent itself was used extensively in the depositions of
2 Hamilton Beach witnesses by the plaintiff, and, in fact,
3 that testimony --

4 THE COURT: Are they going to introduce that in
5 their case-in-chief for sure?

6 MR. RAHMEIER: For sure, I can't say.

7 THE COURT: Okay. All right. What's your name,
8 sir?

9 MR. CHAMBERS: No.

10 THE COURT: What's your name, sir?

11 MR. CHAMBERS: Excuse me. Sorry.

12 THE COURT: No, no. What is your name? I just
13 want to know what your name is.

14 MR. CHAMBERS: Sorry, Your Honor.

15 THE COURT: No, no.

16 MR. CHAMBERS: Guy Chambers.

17 THE COURT: All right. So, Mr. Chambers, sorry.

18 MR. CHAMBERS: No.

19 THE COURT: Mr. Chambers, do you intend to use
20 it in your case-in-chief?

21 MR. CHAMBERS: Absolutely not.

22 THE COURT: Okay. Thanks. All right.

23 So since they are not going to use it, let's get
24 that off the table. I think my guess is they designated it
25 probably just to rebut something in case it came up.

1 Assuming they are not going to use it, why is it
2 helpful to introduce the patent to show the features of the
3 product?

4 MR. RAHMEIER: Just for the features?

5 THE COURT: That's all I'm getting at.

6 MR. RAHMEIER: Okay. Again, I think, yes, we
7 may have the machine there. The machine may go back to the
8 jury.

9 THE COURT: I assume.

10 MR. RAHMEIER: And, but, again, I think the
11 design work that was done and that resulted in this patent,
12 the patent illustrates and shows, you know, different
13 aspects and things not accused of infringement of the
14 accused products.

15 THE COURT: Is there something in the patent
16 that would tell the jury how the product works in a more
17 probative way than having the product in front of them and
18 scientists or somebody explaining how it works?

19 MR. RAHMEIER: I can't answer that.

20 THE COURT: All right. Let's go onto the next
21 topic then. Then you say the patent would show the timeline
22 of the development. Help me out with that.

23 MR. RAHMEIER: Yes. So that goes back to one of
24 my, one of the arguments here, which is, the patent is, in
25 our view, very important to the story and the background,

1 the features, the development that went into the development
2 of the accused product.

3 THE COURT: Flesh that out.

4 MR. RAHMEIER: The timeline would be evidence by
5 when a patent was filed, when it was issued. In this case,
6 the patent actually issued over the plaintiffs' patent. So
7 plaintiffs' allegations --

8 THE COURT: So it issued after the plaintiff's
9 patent?

10 MR. RAHMEIER: It did, but it issued over,
11 meaning there's something else there, meaning Hamilton Beach
12 innovated and the Patent Office found innovation and issued
13 a patent.

14 So --

15 THE COURT: Was the plaintiffs' patent part of
16 the prosecution history of the '823 patent?

17 MR. RAHMEIER: Yes. Again, the timeline part,
18 it would show in the timeline of the development and
19 research and development, when Hamilton Beach decided to go
20 to the Patent Office and try to --

21 THE COURT: So it was specifically discussed,
22 the patent-in-suit during the course of the prosecution
23 history?

24 MR. RAHMEIER: You mean actually argued and
25 discussed in the prosecution history?

1 THE COURT: Yes.

2 MR. RAHMEIER: It's cited to the face. I don't
3 think it was.

4 THE COURT: But it's cited on the face of the
5 patent?

6 MR. RAHMEIER: That's correct.

7 THE COURT: All right.

8 MR. RAHMEIER: Okay.

9 THE COURT: All right. And then you say, next,
10 you say, the '823 patent is so intertwined that the
11 plaintiffs used the '823 patent to prove its infringement
12 case.

13 Can you show me where that is because I had a
14 hard time finding it.

15 MR. RAHMEIER: It is the '377 patent, claim 27,
16 the expert report. It's cited right there at 79.

17 THE COURT: Yes. So help me out with that.

18 MR. RAHMEIER: Yes.

19 THE COURT: I was looking at it. I didn't
20 really see this.

21 MR. RAHMEIER: Okay.

22 THE COURT: So this is tab 18, paragraph 79,
23 page 45. I'm looking at paragraph 79.

24 MR. RAHMEIER: I'm looking at page 79.

25 THE COURT: Okay.

1 MR. CHAMBERS: Your Honor, this is Guy Chambers
2 again.

3 Very quickly, that's a typo. That's the only
4 page we had that typo in the report.

5 THE COURT: Wait. This is his motion, but you
6 know -- sorry.

7 MR. CHAMBERS: I just want to see if I can speed
8 things along.

9 THE COURT: Okay.

10 MR. CHAMBERS: We did have a typo. We removed
11 every other reference we could find to the '823. We have no
12 intention of relying on it. We tried to get them all out on
13 this one.

14 THE COURT: Okay. I don't even see '823 in
15 paragraph 79.

16 MR. RAHMEIER: Your Honor, that's because it's
17 not paragraph 79.

18 THE COURT: Okay.

19 MR. RAHMEIER: It's page 79.

20 THE COURT: All right.

21 MR. RAHMEIER: Two columns. On the right
22 column, the second box from the bottom.

23 THE COURT: Oh, okay.

24 MR. RAHMEIER: So the '823 patent is being
25 referenced to prove that a cup support mounted in the

1 housing limitation is met.

2 THE COURT: Okay. Hold on a second now.

3 Mr. Chambers, you're telling me that reference
4 to the '823 on page 79 of your expert report, you're saying
5 is a typo?

6 MR. CHAMBERS: Yes.

7 THE COURT: What should it be?

8 MR. CHAMBERS: Excuse me?

9 THE COURT: What should it be? '823, what
10 should it be?

11 MR. CHAMBERS: We tried to remove any reference
12 to the '823 in putting together the expert report because we
13 don't intend to rely on it.

14 THE COURT: Okay. So you are not going to rely
15 on it at trial?

16 MR. CHAMBERS: Exactly.

17 THE COURT: All right. Thank you.

18 All right. So, all right. So that dispenses
19 with that. Right?

20 So let's go with the next one. You've got the
21 '823 patent is also relevant to secondary considerations of
22 obviousness and then namely, that the defendants copied. So
23 flesh that out for me. I didn't really understand that.

24 MR. RAHMEIER: I would be happy to. I would
25 also like to start with, this is probably more important now

1 with willfulness being back in the case.

2 Okay. So I'm sure as Your Honor noticed, the
3 plaintiffs' papers are rife with allegations that defendants
4 are unscrupulous copyists I believe is the phrase they used.
5 And by extension, that we don't innovate, that we ride on
6 the coattails of others, including the plaintiffs think
7 that's what we did here with them.

8 So that simply is not true, and Hamilton Beach
9 should be permitted to present the whole picture of their
10 research and development process and what happened here in
11 this case. Again, it's for the accused products. It's not
12 just somewhere in the patent here.

13 So therefore we should be able to show to rebut
14 these allegations of us being copyists, and unscrupulous
15 copyists that is, that we do innovate.

16 THE COURT: Is there anything other than an
17 unscrupulous copyist?

18 MR. RAHMEIER: That's a good question.

19 THE COURT: All right.

20 MR. RAHMEIER: We think a blanket exclusion of
21 us being permitted, to basically have this part of our whole
22 story before the jury would be unfair and, in fact, unfairly
23 advantage to them.

24 THE COURT: Okay. All right. Thank you.

25 Mr. Chambers, if you wish to respond, I will

1 give you a chance.

2 MR. CHAMBERS: Well, I will be very quick, Your
3 Honor.

4 I think Your Honor brought up key points, which
5 is that there's other technical documents that can prove
6 the, what the structure of it is, and what they described is
7 exactly the reason why these things need to be excluded.
8 They said it was issued over plaintiffs' patent. There's
9 bad law out there, which the Federal Circuit in its Atlas
10 case made sure to get rid of, that says simply because you
11 get a patent doesn't mean that it's a defense to
12 noninfringement. This is highly prejudicial.

13 THE COURT: Let me ask you this: Especially
14 since willfulness is in, but even before with copying, but
15 now it's in.

16 So why shouldn't they be allowed to bring this
17 in to show that they had a legitimate effort to come up with
18 their mixer, they were not afraid to present it to the PTO,
19 they even cited your patent in their patent. They honestly
20 believed they didn't infringe.

21 MR. CHAMBERS: Well, what they can do, they can
22 come in and try to show that they designed it in a different
23 way, that they had their opinion of counsel. That's all
24 relevant evidence.

25 THE COURT: Well, why isn't what I just said

1 relevant?

2 MR. CHAMBERS: What?

3 THE COURT: What about what I just said?

4 MR. CHAMBERS: Okay. And, but I think that's
5 very marginal. I don't think it's really relevant at all.
6 You would need to get into drawing a connection between
7 their product and the patent, and then you --

8 THE COURT: Wait. The standard is for
9 willfulness. Right? It's actually knew or should have
10 known they were infringing.

11 MR. CHAMBERS: Right.

12 THE COURT: Wouldn't it be inconsistent with
13 somebody that had knowledge that they were infringing the
14 patent to cite it in a patent application to the PTO?
15 You're drawing attention to the fact there's another patent
16 out there.

17 MR. CHAMBERS: Not at all, and this gets into a
18 whole complicated explanation you need to give the jury of
19 pioneering patents versus improvement patents.

20 I will be very brief about this, but the example
21 I give people is Shockley in 1954, Bell Labs came up with a
22 very crude transistor, solid state transistor, the first one
23 ever, and that spawned the whole Silicon Valley. That
24 spawned transistors, DRAMs, microprocessors, so that it
25 created a huge industry, but Shockley was the one who

1 started it all.

2 So as long as Shockley has a patent,
3 everybody has to pay homage to Shockley and cite in the
4 Patent Office the fact that, you know, Shockley's patents,
5 so the examiner can consider it. So they have to pay homage
6 to Shockley. The fact that they developed a microprocessor,
7 you know, 15 years later is completely irrelevant to whether
8 they're infringing Shockley's patent, and it would be very
9 prejudicial if Texas Instruments could come in and say, you
10 know, we have 1500 microprocessor patents. How could we
11 possibly be infringing Shockley?

12 THE COURT: Well, I can understand, I mean, and
13 I think that you would agree, Mr. --

14 MR. CHAMBERS: Chambers.

15 MR. RAHMEIER: Rahmeier.

16 THE COURT: Mr. Rahmeier. Correct? I've got
17 Chambers now.

18 Mr. Rahmeier, you'd agree that there has to be a
19 limiting instruction. We can't have the jury think that
20 because you have a patent, that means you don't infringe
21 their patent? Correct?

22 MR. RAHMEIER: We do agree with that. That's
23 very typical in cases we provided to Your Honor in our
24 briefing.

25 THE COURT: All right. I'm going to deny the

1 motion. I think it's -- I'm sorry. You're rolling your
2 eyes, Mr. Chambers.

3 MR. CHAMBERS: Well, can I ask that we -- let me
4 let you finish, Your Honor. Let me let you finish. I'm
5 sorry. I apologize.

6 THE COURT: I'm going to deny the motion. I
7 think that, however, I do think it's appropriate to have a
8 limiting instruction because of the danger of unfair
9 prejudice to the plaintiff and confusion to the jury that
10 the fact that there's an existing patent on, and the
11 defendants say it covers the accused products, is not
12 probative of whether or not the plaintiffs' patent is
13 infringed by the accused product, and we need to make that
14 clear to the jury in an instruction. But I do think that
15 the existence of the patent and the fact that it cites the
16 plaintiffs' patent is relevant to willfulness or lack of
17 willfulness, and it's relevant to the development, there's
18 an allegation of copying, and it's relevant to that issue as
19 to whether there was copying or whether there was an
20 understanding that, no, this was something different.

21 MR. CHAMBERS: Your Honor, could I mention that
22 one of the things they are asking in their jury instructions
23 is design-around, so what they're going to try to tell the
24 jury, which could be extremely prejudicial, is that we,
25 we're entitled to design around the patent, we're encouraged

1 to design around the patent. And here we've gotten our own
2 patent, and this is evidence that we successfully designed
3 around the patent and that it's hugely misleading to the
4 jury for us, and that we're going to have to get into a
5 pretty complicated analysis of the fact that what's in that
6 '823 patent has nothing to do with the patents that are
7 being enforced, which are, of course, self-cleaning blender
8 and for reconstituting a frozen milkshake, that '823 patent
9 is for moving a carriage up and down.

10 So it really has nothing to do with what's at
11 issue here, and that's why everything can get so garbled and
12 confused for the jury.

13 THE COURT: All right. So we'll have to make
14 sure we have a good limiting instruction to make sure the
15 jury is properly informed under the law.

16 MR. CHAMBERS: Okay. Would we be entitled to
17 put on witnesses then to explain to the jury that their
18 patent has nothing to do with, and you would almost need a
19 patent attorney to get on the stand and explain why the
20 claims of their patent have nothing to do with the claims
21 that are at issue in the patents-in-suit?

22 THE COURT: I think they're going to be
23 instructed and it is has been stipulated, it sounds like,
24 they'll be instructed that whether or not the accused
25 products read on the '823 patent is irrelevant to whether or

1 not they read on the patent-in-suit.

2 MR. CHAMBERS: Well, first of all, in order
3 for it to have any relevance, they would -- and I think
4 this could be best handled, you know, once we get into the
5 trial.

6 They have to show a nexus between their '823
7 patent and their products even to show --

8 THE COURT: I'm denying the motion in limine.
9 There may be objections during the trial that a proffer
10 they make with respect to the '823 patent may be completely
11 irrelevant. I wouldn't permit inquiry into it. I'm just
12 not granting the motion in limine saying they can't bring
13 it in for those reasons. For instance, to me, I'm not going
14 to let them bring in the patent to show what the features
15 of the accused products are. That's redundant, it's
16 wasteful. That could mislead the jury. It's not coming in
17 for that.

18 I discussed the limited purposes I could see it
19 being relevant to. It was offered for those limited
20 purposes, and coupled with a limiting instruction, I'm
21 denying the motion in limine.

22 MR. CHAMBERS: All right. Thank you, Your
23 Honor. That helps.

24 THE COURT: All right. Next. Oh, and by the
25 way, to make it really clear to the Federal Circuit, so I

1 based my analysis on that last ruling under Rule 403, and I
2 think that the probative value of the existence of the '823
3 patent is, with respect to the limited issues I discussed,
4 namely, willfulness, copying, and the development of the
5 products, is sufficiently probative that I'm not going to
6 preclude it from being put before the jury. That said, I do
7 think that the potential of misleading the jury, causing
8 confusion among the jury, would outweigh substantially the
9 probative value of that evidence with respect to what are
10 the features of the accused product, and certainly whether
11 the accused product infringes the patent-in-suit.

12 So we're denying the motion in limine with the
13 understanding that the evidence could be proffered for a
14 limited bases and that we'll address whether the relevance
15 of it as it comes up.

16 Next?

17 MR. FLYNN: Your Honor, our third motion in
18 limine is related to some evidence and testimony regarding
19 defendants' positions that were not timely disclosed during
20 the fact discovery period.

21 THE COURT: Okay.

22 MR. FLYNN: And we address a couple. Let me
23 focus on sort of the two big ones, and they relate to their
24 noninfringement contentions and their invalidity positions.

25 THE COURT: All right. Actually, here's my

1 problem, Mr. Flynn, and I do want you to really spend time,
2 but as far as I'm concerned, I think the only one of the
3 five that you address was beyond sales. Did you discuss any
4 of the others in your motion?

5 MR. FLYNN: We do talk about the noninfringement
6 positions.

7 THE COURT: Okay.

8 MR. FLYNN: Your Honor, I mean, sort of the
9 overarching thing, and I think this is addressed in some of
10 their motions as well, is that defendants have just failed
11 to provide disclosures during the course of fact discovery.
12 I mean, through the end -- fact discovery closed in July of
13 2018 in a case that was originally filed in 2014. There was
14 plenty of time here.

15 THE COURT: So, look. I want you to walk me
16 through this slowly, because I have to say from just my
17 reading of the document, I came away with a similar
18 conclusion.

19 MR. FLYNN: Sure.

20 THE COURT: So I wanted you to go through the
21 timeline.

22 MR. FLYNN: Sure.

23 THE COURT: And then I will let them go through
24 the timeline.

25 MR. FLYNN: So let's start with noninfringement.

1 So we served contention interrogatories in 2015.

2 THE COURT: So January of 2015. Right?

3 MR. FLYNN: I think that's right, Your Honor.

4 I want to make sure I have the date right. I believe that
5 was our first -- I believe that was our first set of
6 interrogatories.

7 THE COURT: All right.

8 MR. FLYNN: I don't have them with me.

9 They responded to those as often happens kind of
10 punting the ball. The only substantive responses we got
11 back to our contention interrogatories on their
12 noninfringement positions and their invalidity positions
13 were in their supplemental interrogatory responses that they
14 served on January 5th, 2016, more than two-and-a-half years
15 before fact discovery closed. And even in those responses,
16 for noninfringement they pointed to a handful of documents
17 and reference a collection of documents from, that they cite
18 in another interrogatory response. And for their invalidity
19 position, that was our Interrogatory No. 8, they just
20 incorporate by reference their May 22, 2015, invalidity
21 contentions.

22 That's it. That's the only responses they gave
23 us on their defense, for example, on the on-sale bar or
24 public use. The May 15th responses that they sent us say,
25 at this time, Hamilton Beach does not have any disclosures

1 under U.S., 35 U.S.C., Sections 102(a) or 102(b) with
2 respect to items for sale or publicly known. That is the
3 last update they gave to our interrogatory which would have
4 gone to their on sale or public use defenses.

5 THE COURT: All right. So I want these exhibits
6 just to make sure I got it right.

7 MR. FLYNN: Hopefully, we tabbed this one, Your
8 Honor.

9 THE COURT: Okay. I'm sorry, it wasn't tabbed.
10 The only thing that was tabbed was Exhibit 15, which is the
11 motion. So let's go through it.

12 You got attached to it as Exhibit A, it looks
13 like the responses to the interrogatories.

14 MR. FLYNN: Correct.

15 THE COURT: And they are dated, as you said,
16 January 16th, so I'm seeing then at page 14, and the
17 supplemental response to Interrogatory No. Eight is on 15.
18 All right.

19 MR. FLYNN: Correct.

20 THE COURT: And they reference the invalidity
21 contention are served on May 22nd, 2015.

22 MR. FLYNN: Correct.

23 THE COURT: Where are they? They're in here,
24 too. Correct? They appear to be Exhibit B.

25 MR. FLYNN: They are Exhibit B, Your Honor.

1 THE COURT: All right.

2 MR. FLYNN: If you look at page 11.

3 THE COURT: Okay. Hold up. Yes.

4 MR. FLYNN: Under the chart, under heading C.

5 The first sentence makes clear, they have no disclosures
6 about items for sale were publicly known.

7 THE COURT: All right. I've got you there.

8 MR. FLYNN: Okay.

9 THE COURT: Yes.

10 MR. FLYNN: They do update those?

11 THE COURT: Take me there.

12 MR. FLYNN: These are the final contentions that
13 are Exhibit E.

14 THE COURT: Okay.

15 MR. FLYNN: These were served February 12th,
16 2018.

17 THE COURT: All right. I'm looking at page 13
18 and 14. Is that right?

19 MR. FLYNN: 12 and 13, Your Honor. I believe 12
20 has the chart and then begins with items offered for sale or
21 publicly known.

22 THE COURT: Okay. Hold up then. Okay. I see
23 12 and 13, but just help me out before I get there. Let's
24 go back. What's Exhibit D?

25 MR. FLYNN: Exhibit D, Your Honor, was an

1 opinion from Judge Robinson on a similar issue.

2 THE COURT: Okay. I see it. Sorry.

3 All right. So just so I've got them all right
4 here, I've got Exhibit A are the responses from Hamilton
5 Beach. Now, this is just Hamilton Beach, so help me out.

6 MR. FLYNN: Correct.

7 THE COURT: Help me out with this. What's the
8 analysis with respect to Hershey? Why weren't they served,
9 and if they were, what was their response?

10 MR. FLYNN: So Hershey never served separate
11 invalidity responses, invalidity contentions, Your Honor, so
12 they just presumably adopted what Hamilton Beach --

13 THE COURT: You say presumably, so that -- did
14 they or did they not?

15 MR. FLYNN: They definitely did not serve their
16 own. I don't know that they joined in --

17 THE COURT: Did you serve discovery on them?

18 MR. FLYNN: We did serve discovery on them.

19 THE COURT: Did you serve the identical
20 discovery on them?

21 MR. CHAMBERS: Your Honor, the defendants can
22 verify that. Hershey was handling the trademark part of the
23 case, and Hamilton Beach was handling the patent part of the
24 case, so they divided it up, so all the stuff that was on
25 patents came from Hamilton Beach and all the stuff that was

1 on trademark came from Hershey.

2 THE COURT: All right. See, I'm reading these
3 papers and, you know, what I'm stuck on is, as I mentioned
4 at the beginning, and I will hear it from the defendants,
5 but I think there's a pretty -- you know, plaintiffs have
6 understandably frustrated feelings when it comes to Hamilton
7 Beach's discovery responses, but I've got a motion in limine
8 that is directed at both defendants, and I don't see any
9 discovery with respect to Hershey. And so before I do -- do
10 I have to even decide this, because isn't Hershey going to
11 say, we get to bring it all in?

12 MR. FLYNN: Your Honor, I don't believe that
13 Hershey has a defense or counterclaim that's related to an
14 on-sale bar. That was asserted in Hamilton Beach's answer
15 and counterclaims.

16 THE COURT: But you've got five things. The
17 on-sale bar is just one of five things.

18 MR. FLYNN: Right.

19 THE COURT: What about all the other things?

20 MR. FLYNN: Your Honor, at some point
21 defendants, Hamilton Beach and Hershey, were basically --
22 actually, through the whole case with respect to the patent
23 case, they're being, Hamilton Beach's attorneys have been
24 handling that side of the case for both defendants.

25 I believe, and I can be happy to supplement if

1 Your Honor would like, but I believe that Hershey's
2 responses are similarly deficient in that, if anything, they
3 only pointed to the same invalidity contentions, for
4 example, that were served on Hamilton Beach and they never
5 provided separate noninfringement contentions.

6 THE COURT: And do you know for sure you served
7 the identical discovery on Hershey?

8 MR. FLYNN: I don't know for sure, Your Honor.
9 I know that to the extent there is anything in the record
10 about noninfringement contentions or invalidity contentions,
11 Hershey was adopting what Hamilton Beach was providing
12 because Hamilton Beach makes the products. Hershey doesn't
13 know about the way the products operate.

14 THE COURT: Okay. Well, maybe we'll just put
15 that on the back burner.

16 So we've got Exhibit A, the defendant Hamilton
17 Beach Brands' first supplemental responses. Right?

18 MR. FLYNN: That's correct.

19 THE COURT: All right. And you point me there
20 to pages 14 and 15.

21 MR. FLYNN: Correct.

22 THE COURT: And Exhibit B is defendant Hamilton
23 Beach Brands' initial invalidity contentions, and you point
24 me there to page 11.

25 MR. FLYNN: Correct.

1 THE COURT: All right. And let's see. You
2 point me to paragraph C, which is offer for sale.

3 MR. FLYNN: Right.

4 THE COURT: And you point me to paragraph --
5 what else? Anything else there?

6 MR. FLYNN: No, Your Honor.

7 THE COURT: All right.

8 MR. FLYNN: Not specifically.

9 THE COURT: Just on-sale?

10 MR. FLYNN: Just on-sale.

11 THE COURT: Okay.

12 MR. FLYNN: I will say, Your Honor, that one of
13 our frustrations is that to this day we don't know exactly
14 which issues they're raising as defenses. For example,
15 you'll see that they have a derivation defense in these
16 contentions. We don't know whether that's in the case or
17 not.

18 They've raised a public use defense in their
19 later contentions. We don't know -- they didn't oppose our
20 summary judgment motion on it, so we don't know whether
21 that's still in the case or not. They accused Mr. Cramer of
22 being a co-inventor, but I think they've dropped that, too,
23 but we don't know. And this is part of the problem, is that
24 we can't vet these things in discovery when they don't tell
25 us what they are.

1 And so, you know, the on-sale bar we're pretty
2 sure is still in the case, but the only disclosure they've
3 ever given us, even in their final invalidity contentions,
4 is go back and look at our answer and counterclaims we filed
5 at the very beginning of this case.

6 THE COURT: Well, wait. The on-sale bar,
7 don't they point that out in their final invalidity
8 contentions?

9 MR. FLYNN: So that's Exhibit E, Your Honor.

10 THE COURT: Right.

11 MR. FLYNN: And if you look at page 12 --

12 THE COURT: Yes. Page 13. Mr. Farrell offered
13 to sell blenders to certain gas station changes such as
14 QuikTrip.

15 MR. FLYNN: At the NACS show.

16 THE COURT: Yes.

17 MR. FLYNN: And what do they cite? They cite
18 their answer and counterclaims as support for that.

19 THE COURT: But I mean, they put you on notice.
20 I mean, they could have them come in and they've got -- I
21 mean, what else do you need?

22 MR. FLYNN: Well, Your Honor, this company they
23 reference here isn't the one that they're claiming is, there
24 was an offer for sale for now. This Kwik Trip with a "K" is
25 a completely different company than the QuikTrip that

1 they're asserting now. They're no longer asserting, I don't
2 believe, that the sale was made at the NACS show in October
3 of 2002, which is what they plead in their answer and
4 counterclaims.

5 But the point is that they had the benefit of
6 fact discovery and they never supplemented it. They never
7 put us on notice that, okay. We've been through discovery.
8 We've deposed Mr. Farrell. We've deposed Mr. Geford. We've
9 looked at everything. Here's what our contentions are now
10 in July of 2018, before we move into expert discovery.

11 THE COURT: All right. So this is the on-sale
12 bar. What else? Let's talk about the other four things
13 that your --

14 MR. FLYNN: Sure.

15 THE COURT: That your motion covers.

16 MR. FLYNN: So two of these, Your Honor --

17 THE COURT: Hold on. Let me go back to your
18 motion.

19 MR. FLYNN: Sure. And I think I can go through
20 these pretty quickly, because I think they --

21 THE COURT: All right. So the number one is the
22 new on-sale defense.

23 MR. FLYNN: Right.

24 THE COURT: And that's because apparently -- how
25 do you know what their new on-sale defense is?

1 MR. FLYNN: Well, Your Honor, when we moved for
2 summary judgment, we kind of had to guess because we didn't
3 know exactly what their contentions were on this. The same
4 with their public use defense, that I'm still not sure
5 whether they're still asserting it or not.

6 But --

7 THE COURT: But I mean, you know, here's the
8 thing. It's just from your summary judgment brief.

9 So incidentally, on your summary judgment -- so
10 let's go to page 3 of your motion. Right? Plainly,
11 defendants failed to identify their new on-sale invalidity
12 defense in response to plaintiffs' interrogatories.
13 Defendants concocted their new on-sale defense late in the
14 case, after it was unequivocally proven that defendants'
15 public use allegation never happened. And then you say see
16 DI 169, and that's your motion. Right?

17 MR. FLYNN: I believe that's correct.

18 THE COURT: This is a typo. Really, I think you
19 were referring to your brief, which is DI 170, 37 to 40.
20 I'm assuming that, because isn't it your argument that you
21 made such a powerful summary judgment argument, that they
22 had to abandon their initial defenses and switch gears.
23 Right?

24 MR. FLYNN: The public use and switch.

25 THE COURT: But here's the problem. So I go to

1 page 37 of your brief. Defendants have also asserted that
2 the '150, '658 and 662 patents are invalid or unenforceable
3 because Mr. Farrell publicly disclosed or offered to sell
4 a blender containing the invention. It sounds like you're
5 on notice. I mean, you're prepping for it. You're on
6 notice.

7 MR. FLYNN: Your Honor, we're on notice, but
8 that's not the standard after all of the discovery has
9 closed. The only thing we knew was what they had alleged in
10 their answer and counterclaims four years ago. Right? And
11 that was based on a display of a video that Mr. Farrell
12 allegedly made at a trade show that they've now admitted
13 never happened.

14 So when we're briefing the summary judgment, I
15 mean, I don't even know what we could have briefed because
16 they never told us, here's our contentions. They never
17 supplemented and said, we've deposed Mr. Farrell, here's all
18 the evidence about what he allegedly said that makes us
19 still believe that we have an affirmative defense based on
20 an on-sale bar.

21 So all we're left with is the exact same one
22 line they had on information and belief in their answer and
23 counterclaims that they carried through to their invalidity
24 contentions that we had to somehow sort of discern what
25 their case may be on this when we don't think there's any

1 evidence.

2 There's not a shred of documents that evidence
3 any on sale. There's not an invoice, there's not an e-mail,
4 there's no correspondence. There's nothing that supports
5 their on-sale defense, but their own theory that he must
6 have offered it for sale before November of 2002 because
7 QuikTrip made a purchase of them in July of 2003 and it
8 couldn't possibly have happened otherwise. They don't have
9 a single piece of evidence to support this.

10 THE COURT: Let's go onto the next one.

11 MR. FLYNN: Sure.

12 THE COURT: So where are you on that? The next
13 one is they have to provide visual evidence of grinding,
14 shaving, of the f'real patent.

15 MR. FLYNN: Sure. To kind of lump these
16 together, because these are all part of their
17 noninfringement positions, is that because we didn't know
18 what their noninfringement contentions were even though we
19 had served initial and final infringement contentions, they
20 never came back and said, this is missing in your
21 infringement contentions.

22 THE COURT: Let me ask this: If I let in the
23 January 2019 testing by your expert, do you need this motion
24 in limine?

25 MR. FLYNN: We don't need it on the technical

1 issue related to the grinding and shaving.

2 THE COURT: Okay.

3 MR. FLYNN: I think that Mr. Maynes had to do
4 that extra testing to rebut what Mr. Slocum had in his
5 rebuttal report to which we did not get a reply.

6 THE COURT: All right. How about number three,
7 the unrestrained splash shield for sufficient mass.

8 MR. FLYNN: So, Your Honor, again, because we
9 didn't know what their noninfringement positions were with
10 respect to those, we get them in Dr. Slocum's rebuttal
11 report where he says it doesn't meet this limitation and now
12 they are using indefiniteness issues as well.

13 THE COURT: But is there --

14 MR. FLYNN: But there's no prior disclosure to
15 us. They never said in response to our contention asking,
16 tell us why you don't infringe based on our infringement
17 contentions, they never said, here's why, here's why. It's
18 because we don't need this unrestrained limitation.

19 THE COURT: How about divided infringement?
20 They point to a 2017 oral argument where somebody on your
21 side made a pitch to Judge Sleet about the divided
22 infringement argument.

23 MR. FLYNN: Your Honor, we raised it because we
24 were concerned the claim construction could push that
25 argument one way or the other. What we argue in claim

1 construction has nothing to do with what they're asserting
2 as their position.

3 THE COURT: And I think they say that though you
4 guys never revealed at some late date, I can't remember what
5 the date was, that, in fact, you were going to say that more
6 than one person.

7 MR. FLYNN: Your Honor, from the beginning of
8 the case, we've had inducement arguments, which makes it
9 clear that there's a third party doing the infringement. So
10 I'm not sure exactly what they are referring to, but we've
11 always said that the consumers and the retailers have to
12 commit direct infringement for an inducement claim. That's
13 not surprising to them. The issue is whether there's true
14 divided infringement where they are providing a piece of
15 equipment and somebody else is completing the steps, and I
16 think we've briefed this separately in terms of, you know,
17 the Federal Circuit's limelight decisions.

18 THE COURT: Okay. All right. Anything else?

19 MR. FLYNN: No, Your Honor. I think that covers
20 it.

21 THE COURT: All right. Who is going to argue?

22 MR. FOSTER: Your Honor, it's Bill Foster on
23 behalf of the defendants.

24 THE COURT: All right.

25 MR. FOSTER: Your Honor, first of all, just to

1 kind of get this out of the way. The rule that they cite is
2 a requirement to supplement the additional or corrected
3 information has not otherwise been made known to the other
4 parties during the discovery process.

5 There has been many times in this case where
6 different arguments or different positions were made known
7 to them, the raising of the interrogatory responses above
8 all.

9 So, for example, in the opening part, they don't
10 even mention the final invalidity contentions where we talk
11 about Kwik Trip. Granted, there's a typo, it's K instead of
12 Q, but we have always had the same position that there was
13 some sort of prior sale to QuikTrip. We can go through that
14 documentation later. In fact, in the IPR, they talk about
15 negotiations with QuikTrip starting in 2001, and we weren't
16 able to depose Mr. Vogus, who made those statements until
17 after the final infringement contentions.

18 This is all their evidence. I mean, we weren't
19 in control of any of it. The same thing with talking to
20 Mr. Farrell. We didn't get to depose him until a few months
21 after that. One thing that's a little weird in this case.
22 They talk about four years ago. This case was filed. There
23 was discovery they didn't actually own the patents and it
24 was kind of restarted.

25 So when that happened, based on some of the

1 discovery that was done before, that's when the prior sale
2 or public use was put into the document. We weren't sure
3 where the evidence was going to lead us because we didn't
4 have it, we didn't talk to anyone about it yet.

5 Over the course of discovery, we have always
6 said it was a sale to QuikTrip. They put it in the
7 declaration to support their IPR position. They said
8 themselves, negotiations started in 2001. We have the
9 video. We know they had it at the NACS show. We know he
10 was trying to show it based on his deposition. Again, that
11 is all of their evidence, so we're not sure how they didn't
12 have notice of the public use given it was pled. It was
13 mentioned in the final invalidity contentions, and then the
14 evidence was further developed during discovery.

15 And, again, there's many times in this case,
16 like just to get it out of the way real quick, the divided
17 infringement issue. Your Honor, we had discussions about
18 what the claim construction should be, and during those
19 discussions we had a whole discussion about the claim
20 construction of providing a mixing machine. We had a meet
21 and confer. We had to talk about those things. They knew
22 full well that we were going to bring up this trickster
23 stuff type of argument. They knew we were going to raise a
24 divided infringement argument. And they've said inducement
25 has always been part of this case. That's a different

1 issue. And remember, the divided infringement argument
2 isn't directed to all the machines. It's only directed to
3 specific machines that are operated in Hershey Express Shake
4 Shop Express program.

5 So we're saying something about if Hamilton
6 Beach sells a machine and Dairy Queen uses it, for example.
7 That's not really an issue. And if you look at their final
8 infringement contentions, they never say who performs the
9 different method steps. That's not in their infringement
10 contentions whatsoever. Until we got Dr. Maynes' report, we
11 didn't know who was performing the different method steps,
12 and that's brought up in our summary judgment motion later
13 today.

14 So they were on full notice that we -- they were
15 on full notice of the divided infringement potential as
16 demonstrated by the statement in the Markman hearing a long
17 time ago. Again, when they fully put forth who was
18 performing which of the steps, it's only, like I said, a
19 subset, a subset of the total infringement that we're saying
20 is governed by the divided infringement.

21 Real quick, there's many issues they didn't
22 actually address in their papers. I think the prior sale
23 one we just talked about a little bit, but they don't get
24 into the meat of a lot of these things. But they had
25 opportunities to talk about all of these issues.

1 If you look at our, if you look at our responses
2 to our interrogatories, we say straight up, all the products
3 are missing at least one. Many of your interrogatories are
4 really calling for expert testimony. And the people that
5 have the most knowledge are Brian Williams and Ted Branson.
6 Go talk to them. And over the course of the discovery, they
7 learned a lot of these things.

8 Looking at Exhibit P to the summary judgment
9 brief, in many different questions about Brian Williams, the
10 splash shield. He talks about it. He goes, all right.
11 This is Exhibit P of the summary judgment motion. All
12 right.

13 So there was consideration for instead of the
14 guidewire weight, putting kind of a big screen to make sure
15 that the top of the cup shield was pressed down and held on
16 top of the cup. Right?

17 And the Answer: To perform the same function as
18 the weights.

19 The weight was most cost-effective. Brian
20 Williams testified about the sufficiency of the weight.
21 Brian Williams also testified about whether or not the blade
22 ground. This was brought up. There's another thing that's
23 also mentioned in the summary judgment briefing about Ben
24 Branson. They tried to ask him whether or not shaves, or
25 shaves chocolate chips. Ben Branson simply denied, it

1 doesn't shave anything.

2 THE COURT: Can you point to, attached to your
3 motion in limine response Exhibit D, you cite for the
4 proposition that there was a disclosure about unrestrained.

5 MR. FOSTER: Yes Your Honor.

6 THE COURT: Page 121, 25.

7 MR. FOSTER: Your Honor, Exhibit F. Exhibit F
8 is the strongest.

9 THE COURT: Wait. Let's go through Exhibit D.

10 MR. FOSTER: All right.

11 THE COURT: Exhibit D, page 121, starting at
12 line 25. Tell me, where is the unrestrained stuff here?

13 MR. FOSTER: Your Honor, which page?

14 THE COURT: Well, according to yours, I'm on
15 page 2 of your response to the motion in limine. On page 2
16 under unrestrained splash, you cite Exhibit D as 121:25
17 through 122:19. Help me out. Where is this discussion
18 about unrestrained there?

19 MR. FOSTER: Your Honor, this is a discussion
20 about the lid weight that's part of the splash field
21 assembly in the product. He asked about the specific weight
22 of it.

23 THE COURT: Has that got something to do with
24 being unrestrained? You cite it for the proposition, it has
25 a parenthetical, unrestrained. I am trying to find out

1 where there's something about unrestrained.

2 MR. FOSTER: Well, Your Honor, the witness says
3 the addition of the weight makes this entire assembly
4 heavier, and that extra weight is something that would
5 further restrain the lid.

6 THE COURT: You're telling me that goes to
7 unrestrained?

8 MR. FOSTER: Your Honor, that's not directly on
9 point.

10 THE COURT: Well, you cited it, so you help me.

11 MR. FOSTER: Right, Your Honor. Your Honor,
12 right now, the claim limitation is the splash shield is
13 unrestrained. That specifically says that the weight is
14 further applying restraint to the flash shield.

15 THE COURT: All right. You're saying it's
16 probative under unrestrained. All right.

17 MR. FOSTER: Well, Your Honor, there's two
18 things that are in these depositions that we talked about
19 that provide the restraint that's in their noninfringement
20 contentions. There's two things. One, a separate lid
21 weight, and, two, there's mechanical contact at the spindle
22 seal and the bushings that provide friction, that mechanical
23 contact. Those are the two things and they're discussed in
24 the portions of the deposition that we cite.

25 THE COURT: So I'm trying to understand it.

1 MR. FOSTER: Yes, Your Honor.

2 THE COURT: All right. I haven't been dealing
3 with this case for four-and-a-half years. A pretty simple
4 question: So you're telling me the weight is relevant or
5 probative of whether it's unrestrained. That's all I'm
6 trying to figure out.

7 MR. FOSTER: Yes.

8 THE COURT: It sounds like the answer is yes.

9 MR. FOSTER: Yes, Your Honor.

10 THE COURT: All right. So I saw friction in the
11 next one. Line 20, you say this goes to sufficient mass.
12 Now we're back to discussing the cast iron weight.

13 MR. FOSTER: And, Your Honor, page 150.

14 THE COURT: Okay. At the end you say, any small
15 amount of weight will help, but it's not sufficient, so it
16 goes to sufficiency.

17 MR. FOSTER: Yes, Your Honor.

18 THE COURT: All right. Got it.

19 MR. FOSTER: Your Honor, I think more clear,
20 again, the rule allows us to provide any sort of update in
21 writing, and I think the letter, the letter of January 30th,
22 2017, we wrote them and we told them what our
23 noninfringement position is for all of these patents. We
24 talk about the rinse chamber in the '150. We talk about the
25 splash shield that's restrained by a separate weight. We

1 talk about the -- the way it would read on any, it would
2 read on any rinsing blender.

3 So, Your Honor, we were communicating. We were
4 telling them our positions.

5 THE COURT: All right.

6 MR. FOSTER: And, most importantly, Your Honor,
7 I'm still not sure what type of discovery that they were
8 denied of.

9 THE COURT: Look, here's the thing. You know
10 what, there's a technical reading of the rule, and I think
11 you are correct. The rule refers to otherwise disclosed in
12 discovery process or in writing, but in my mind, it's not
13 the right way to practice civil litigation. That the rules,
14 they contemplate that you will be more forthcoming in
15 responding to discovery, and I don't think you guys were.

16 Now, you technically meet it, that at least the
17 second half of the rule, so, Mr. Flynn, I'm going to deny
18 your motion. I'm going to make sure that plaintiffs aren't
19 prejudiced and they get to present the evidence, and an
20 example would be, just off the top of my head, the
21 January 2019 testing.

22 So you, you know, you're going to win your
23 battle in this particular motion. Do I think it's a way to
24 practice civil litigation? I don't, and I think it's
25 unfortunate that lawyers do it, because they require parties

1 to expend resources unnecessarily, and they require courts
2 to have to expend, for instance, just in preparing for this,
3 to dive into the details I had to when if people would have
4 been just more, frankly, cooperative and candid we wouldn't
5 be here. So we're done on this motion. Let's go to the
6 next motion.

7 Mr. Flynn, do you understand the basis of my
8 ruling? You're okay with it?

9 MR. FLYNN: I do, Your Honor. I just -- to
10 close the loop on it, we served the same interrogatories on
11 Hershey. They basically pointed to Hamilton Beach's
12 invalidity contentions and they just said we don't infringe.

13 THE COURT: Basically, I'm very sympathetic
14 where plaintiffs are coming from on this, but the bottom
15 line is the way you read the rule, it has the otherwise
16 language at the end. I think there are enough disclosures
17 in the written communications.

18 It sounds like on the divided infringement,
19 there must have been some kind of disclosure or
20 understanding, and as I say, what it ends up doing, we're
21 going to allow more evidence in and I may have to extend the
22 time limitations because of that.

23 MR. FLYNN: I understand, Your Honor. Thank
24 you.

25 THE COURT: All right. Let's go to the next

1 motion. I think we're on the defense number one.

2 MR. FOSTER: Your Honor, I don't think there's
3 any real dispute about the admissibility of the IPRs. I
4 think the defendants, sorry, the plaintiffs have agreed that
5 it's more prejudicial than probative, so I think we're only
6 going to talk about a couple of issues. The use of certain
7 testimony as a -- for cross-examination purposes, and then
8 whether or not certain prior art was considered by the PTO
9 during the IPRs.

10 THE COURT: All right. So let's talk about the
11 latter first, because I think it can probably be done
12 quickly. I mean, you want to preclude them -- I mean,
13 in cross-examination, if they're cross-examining somebody
14 let's say maybe before the PTAB, can't they just call it
15 another matter and that resolves the problem of
16 cross-examination?

17 MR. FOSTER: If it's truly an inconsistent
18 statement. As we note in our briefing, it's a different
19 standard. It may not be the same combination.

20 THE COURT: How is that relevant? It's only for
21 purposes of showing an inconsistent statement. Right?

22 MR. FOSTER: Yes, Your Honor.

23 THE COURT: So the plaintiffs, who is going to
24 argue this for the plaintiffs?

25 MR. FLYNN: Mr. Chambers.

1 THE COURT: Mr. Chambers, are you okay with that
2 cross-examination?

3 MR. CHAMBERS: Yes.

4 THE COURT: So let's make it clear then. They
5 cannot, if they want to cross-examine a witness based on a
6 declaration, statement made before the PTAB for impeachment
7 purposes only and it's a prior inconsistent statement, it
8 clearly has to meet that threshold, they can do it, but they
9 cannot make any reference to what the specific matter was or
10 before whom the statement was made. They can just say, did
11 you swear under oath in another matter, blank.

12 MR. FOSTER: Your Honor, I think we agreed to
13 that.

14 THE COURT: That's what I'm getting at.

15 MR. FOSTER: Yes.

16 THE COURT: I think we've got agreement on the
17 second part.

18 MR. FOSTER: The only part, we were going to ask
19 for a review of the document before it started.

20 THE COURT: So, I mean, you know, how does that
21 work mechanically?

22 MR. FOSTER: Your Honor, I'm not sure. I'm not
23 sure what documents they're going to use. For example, they
24 talk about the Miller combination from prior art. Again,
25 the '662, I don't have an invalidity defense now because

1 you said that Sato wasn't -- isn't prior art, so I don't
2 know --

3 THE COURT: I said it's not publicly accessible.
4 I mean, if I were writing the law, I would let you have it.
5 They say publicly accessible is determined by reasonable
6 diligence. We don't have to revisit that.

7 MR. FOSTER: But, yes, that's not an issue in
8 the trial anymore, so that shouldn't come in. The other
9 thing was an indefiniteness issue. Again, that's a
10 different proceedings. 112 can't be challenged at the PTAB
11 and that's for the Court anyway.

12 I don't know what documents they plan to use.
13 That's why we have that caveat. But we agreed generally.
14 Of course, they can cross-examine. And the courts are
15 pretty consistent in terms of not letting it in because it's
16 too prejudicial, but at the same time trying to work with
17 the evidence that was created this those cases.

18 THE COURT: All right. So I'm not going to
19 require -- you know, if they're going to use it properly
20 under the ruse to impeach a prior inconsistent statement,
21 they're going to have to establish first that they got a
22 statement, that it isn't consistent.

23 I have to say at the last patent trial I had, I
24 had a patent attorney literally try to impeach a witness
25 with a prior consistent statement, and that was news to me,

1 but I don't think I will ever see that again, hopefully, and
2 it certainly wasn't in the lawyer's interest. So I think
3 we're good.

4 Mr. Chambers, you understand, it has to be a
5 prior inconsistent statement. Right?

6 MR. CHAMBERS: I do, Your Honor.

7 THE COURT: All right.

8 MR. CHAMBERS: I understand what you are saying.

9 THE COURT: All right. That dispenses with
10 that.

11 MR. FOSTER: Yes, Your Honor.

12 THE COURT: So let's turn to the other one.
13 This one I'm going to need some education on.

14 MR. FOSTER: Yes, Your Honor. And we've agreed
15 to a jury instruction. I think jury instruction 5, 4, it
16 doesn't matter. The point is, there is a principle of law,
17 if a reference was considered during prosecution of the
18 patent, there's a suggestion, it's harder to overcome the
19 clear and convincing, the clear and convincing standard.

20 And so what the plaintiffs want to say is that
21 references that were before the PTAB should get that same
22 benefit. We say that it would be highly prejudicial because
23 they weren't in front of the examiner during prosecution.

24 And just to cut this short, in our reply brief
25 of March 29th, the Federal Circuit actually commented on

1 this issue. Footnote 1 of the Tech Global case, which
2 doesn't have a publication number yet, but the Westlaw
3 number is 2019 WL1412538. And in that decision, the
4 footnote said, we do know, however, that caution is
5 advisable for purposes of retrial. The District Court
6 appears to allow Tech to present evidence to the jury
7 concerning a noninfringement. Institution decision by the
8 PTAB solely because SSI informed the jury that the examiner
9 did not have access to a particular prior art reference when
10 he allowed the asserted patent.

11 The jury here was certainly allowed to consider
12 evidence that the PTO had no opportunity to evaluate before
13 granting to the patent. Proper limits to the contention the
14 of pre-issuance examination does not by itself necessarily
15 suggest, warrant or invite introduction of evidence
16 concerning a related noninfringement institution decision.

17 So the Federal Circuit has spoken on this issue.
18 I mean, we can't say it wasn't before the PTO. We would
19 just have to say that this combination wasn't before the
20 examiner during the original prosecution, and that's all
21 there is to say on that.

22 THE COURT: Okay. So I'm on the same page you
23 are. Okay.

24 Who is going to argue this? Mr. Chambers?

25 So, Mr. Chambers, you quote on page 2 from the

1 Supreme Court's decision in Microsoft, and we're dealing, I
2 think, now with the first prong. I mean, isn't the Supreme
3 Court talking there about a situation where the prior art
4 was presented to the examiner during the prosecution of the
5 patent?

6 MR. CHAMBERS: I think in that limited factual
7 situation. What really bothers me about this whole thing,
8 Your Honor, is that the parties have put a tremendous amount
9 of energy and money, and this case has been delayed for over
10 a year because of challenges to all four of the patents.
11 They made --

12 THE COURT: I know it bothers you. It would
13 bother me, too.

14 MR. CHAMBERS: Right.

15 THE COURT: Why is it relevant?

16 MR. CHAMBERS: Your Honor, these are very good
17 judges. I think we submitted the opinions to you, but
18 they --

19 THE COURT: So why is it relevant?

20 MR. CHAMBERS: Because the patent, the Patent
21 Office did take a look at these references and did evaluate
22 them.

23 THE COURT: But are you saying -- I mean, you
24 are not making an estoppel argument, are you?

25 MR. CHAMBERS: I'm making, tying into the

1 Supreme Court i4i point, which is that, you know, counsel
2 was correct, that if the Patent Office has already looked at
3 the references and found that they're not invalidating, then
4 it is harder to sustain the clear and convincing, and in
5 this case you have the top level judges at the Patent
6 Office, the very cream of the Patent Office take a look at
7 these references.

8 You know, this is --

9 THE COURT: That sounds to me just exactly why
10 it shouldn't come in, I mean, because what you are doing is,
11 you're trying to suggest that some judge opined on an issue
12 that the jury is supposed to determine. Therefore, you
13 ought to give it special weight. I mean, that seems to me
14 to be exactly why it should be precluded from being brought
15 in.

16 MR. CHAMBERS: All right.

17 THE COURT: Wait.

18 MR. CHAMBERS: Go ahead, Your Honor.

19 THE COURT: I mean, this quote that you've got
20 from the Microsoft case is actually a quote that the Supreme
21 Court is quoting Judge Rich, and who knows what context they
22 are quoting him in. Do you know it's from the America Hoist
23 decision? I mean, again, if I go back to -- does this have
24 anything to do with patents other than, sorry, anything to
25 do with anything before the PTO accepts in the context of a

1 prosecution of the patent. Right?

2 MR. CHAMBERS: This was unquestionably before
3 the PTO.

4 THE COURT: In the context of a patent
5 prosecution. Right?

6 MR. CHAMBERS: Well, this is all part of the
7 Patent Office record. That's for sure, Your Honor.

8 THE COURT: That's the only question.

9 MR. CHAMBERS: All right. If you are going to
10 say original, it wasn't part of the original patent
11 prosecution.

12 This is the point I would make to try to get to
13 the heart of this. If they opened the door and they suggest
14 that the Patent Office never looked at these references,
15 that is hugely misleading to the jury, and we ought to be
16 able to impeach them.

17 THE COURT: Well, wait. It's only relevant if
18 they, if it was looked at during the prosecution of the
19 patent.

20 MR. CHAMBERS: And this is --

21 THE COURT: And let me just ask.

22 MR. CHAMBERS: I will let you finish.

23 THE COURT: Do you agree with that?

24 MR. CHAMBERS: I really don't, Your Honor.

25 THE COURT: Okay. Do you agree with that,

1 Mr. Foster?

2 MR. FOSTER: Your Honor, it is limited to when
3 the examiner --

4 THE COURT: Why would it be relevant after the
5 fact?

6 MR. CHAMBERS: Okay. You know, we do have a
7 re-examination proceeding involving one of the
8 patents-in-suit, and defendants agree that that is part
9 of the prosecution history, the re-examination proceeding --

10 THE COURT: All right. Stop for a second. Do
11 you agree with that?

12 MR. FOSTER: Your Honor, we moved for a motion
13 in limine on a re-examination because it's different than an
14 IPR. It's actually agreed by the examiner.

15 THE COURT: Which is part of the prosecution.

16 MR. FOSTER: Yes, Your Honor.

17 THE COURT: I mean, that seems very reasonable.

18 MR. CHAMBERS: I guess the part I'm struggling
19 with, Your Honor, is that you have the very best judges in
20 the Patent Office writing very good opinions and you're
21 saying those are worth nothing. Those are completely
22 worthless, and then you have an entry level examiner doing
23 the initial evaluation of the application. Oh, that counts
24 for a lot.

25 So the entry level examiner, you know, counts

1 for a lot before the jury, and what the top, top cream of
2 the crop at the Patent Office, the top judges, they count
3 for nothing. They're worthless. That just doesn't make
4 sense to me.

5 THE COURT: Well, what you are saying makes no
6 sense to me, I have to say, so I am going to grant the
7 motion in limine insofar as that there will be no reference
8 to the IPR or what was presented to the PTO, I should
9 say, except insofar as what occurred during prosecution of
10 the patent.

11 Does that satisfy the defense?

12 MR. FOSTER: Your Honor, no reference that
13 whatever prior art we have, if it wasn't before the office
14 during prosecution. If it was before the office during
15 prosecution, of course, it falls under the...

16 THE COURT: So let me just make sure. You
17 want -- okay. Here's what I'm going to do. I've heard
18 argument. I've heard nothing from the plaintiff as to why
19 it would be relevant or probative for the jury to hear
20 anything about the decision in connection with the inter
21 partes review of the '150, '658 and '662 patents or why the
22 final written decision of the PTAB or the Federal Circuit
23 opinion for the '662 patent would be relevant under the
24 rules or probative of anything that is relevant for the
25 jury. The only thing I understand plaintiff is making is

1 that the specialized knowledge and expertise of the PTAB
2 folks and those that sit on the Federal Circuit somehow
3 would be, ought to influence the jury, and it seems to me
4 that the Rules of Evidence call for exactly the opposite to
5 occur, that they should not be so influenced that it would
6 be misleading. It would be very unfair and prejudicial to
7 the defense, and so therefore I don't think it should come
8 into evidence.

9 So I'm going to grant the defendants' motion to
10 preclude from offering any testimony, evidence, argument or
11 reference related to any inter partes reviews of the
12 asserted patents. There is one caveat. That to the extent
13 that there are -- that the plaintiffs wish to cross-examine
14 somebody who testified or offered a declaration before the
15 PTAB, the plaintiffs will be permitted to use that
16 declaration to impeach the prior inconsistent statement
17 statements. However, there should be absolutely no
18 reference made to the IPR, to the PTAB or to the agency, or
19 the nature of the proceeding, and instead any reference to
20 the prior declaration should make clear that it was in the
21 context of "another matter." All right?

22 MR. CHAMBERS: Your Honor, I would also ask that
23 you consider if they open the door and they tell the jury
24 that the Patent Office did not look at this reference and
25 then try to persuade the jury that it's easier to carry the

1 burden of proof because the Patent Office did not look at
2 it, I would ask Your Honor to keep an open mind at that
3 point about whether that opens the door, because that's a
4 false or misleading statement in my opinion.

5 THE COURT: I guess we'll have to visit that if
6 it comes up at trial. I mean --

7 MR. CHAMBERS: That's what I'm asking.

8 THE COURT: On the other hand, if the defense
9 points out that a piece of prior art was not put before
10 the Patent Examiner, that I think would be relevant
11 potentially.

12 MR. CHAMBERS: Your Honor, I think we should
13 visit this at trial, but I would consider it highly
14 misleading because the Patent Office did look at these
15 references.

16 THE COURT: Mr. Foster, do you have anything on
17 that?

18 MR. FOSTER: Your Honor, just point to the
19 footnote in Global Tech. They distinguish between before
20 the office and non-instituted PTAB decisions. That's not
21 really an issue.

22 THE COURT: That's a demarcation I'm going to be
23 drawing. So it would be, I have no problem with the defense
24 putting before a jury what was given during the prosecution
25 of the patent. That's a separate, very distinct thing.

1 MR. CHAMBERS: But I think it's appropriate to
2 draw the line of not representing to the jury that the
3 Patent Office has never seen these things before, because
4 that's not true. They have seen the things before.

5 THE COURT: All I have to add then is the words
6 during the prosecution. Right?

7 MR. CHAMBERS: Well, in my opinion, that's
8 misleading.

9 THE COURT: All right. Well, I'm going to allow
10 it. So Mr. Foster, if you could just make it a point, just
11 add the word during prosecution, I think we'll have no
12 problem.

13 MR. FOSTER: Yes, Your Honor.

14 THE COURT: Thanks. All right.

15 Next. Motion in limine number two, plaintiff
16 should be precluded from providing any testimony, arguments
17 regarding defendants' alleged infringement under the
18 doctrine of equivalents.

19 MR. RAHMEIER: Yes, Your Honor. Thatcher
20 Rahmeier for defendants. I will be discussing this one.
21 And this is the first one that gets into our slides, so I'd
22 like to hand up some slides. And how many copies do you
23 require?

24 THE COURT: Two would be great to have.

25 MR. RAHMEIER: Two? There are a couple loose

1 slides in the front where they're corrected. There was
2 something that couldn't be seen after we bound them.

3 THE COURT: All right. Thank you.

4 MR. CHAMBERS: Do you have a copy for us?

5 MR. RAHMEIER: Yes.

6 So the way we're doing the presentation today,
7 Your Honor, we act actually had a DOE discussion planned for
8 when we're talking about noninfringement of the '658 patent,
9 so with your permission, I will handle kind of the
10 background of the other three patents and Mr. DiGiovanni
11 will address the '658.

12 THE COURT: Sure.

13 MR. RAHMEIER: Okay. So this is, as you know,
14 Exhibit 17 in the pretrial order, and there are two parts to
15 this motion in limine from the defendants. One, that
16 there's an inadequate expert analysis and disclosure by the
17 plaintiffs' expert for infringement, Dr. Maynes, and, two,
18 that the doctrine of equivalents, a patent doctrine, is
19 actually legally unavailable for specific limitations of the
20 four patents-in-suit based on what happened during
21 prosecution. Namely, what's called prosecution history
22 estoppel.

23 So the first part is about Dr. Maynes, and that
24 his burden report for infringement included only conclusory
25 opinions at the end of each section on each patent for

1 infringement, which cannot sustain their burden to prove
2 infringement of specific limitations under the doctrine of
3 equivalents. So we cited a case that clearly supports this
4 from Delaware. I think it is enlightening enough, which is
5 the MKS Instruments case.

6 So if you look at his report that we attached,
7 it's clear that Dr. Maynes, he doesn't analyze and apply the
8 doctrine of equivalents on an element-by-element basis and
9 merely concludes at the end that it's met. And that's
10 insufficient for him to come to trial and then present
11 testimony supporting application of the doctrine of
12 equivalents before the jury. Therefore, we ask that he be
13 precluded from providing any testimony regarding
14 infringement under that doctrine.

15 Just a couple points. Plaintiffs try to fault I
16 think defendants in their briefing and the fact is that
17 plaintiffs knew all along that it was their burden to prove
18 infringement. They pled infringement using the doctrine of
19 equivalents, so they had to include the analysis in their
20 expert report if they wanted their expert to support it, and
21 they failed here.

22 The second part of the motion, Your Honor, is
23 that for certain limitations of the asserted claims of the
24 asserted patent, as a matter of law for your determination,
25 Your Honor, the doctrine of equivalents is just not

1 available to be invoked or to prove infringement beyond the
2 literal scope of those limitations at issue, which I will
3 discuss.

4 So here on slide 99, it's the seminal Supreme
5 Court case Festo from around 2002, and in a nutshell, the
6 Court laid out a framework that the Courts are to apply
7 regarding prosecution history estoppel, and basically, once
8 a patentee amends his claims for purposes of patentability,
9 then they presumptively have surrendered all scope beyond
10 the literal language of the claim. It's a rebuttable
11 presumption, Your Honor, but after the, after it has been
12 shown that they've made amendments and it can actually be
13 argued, but in this case it's actually written amendments to
14 the claim language, giving up scope, narrowing an amendment
15 for the purposes of patentability, then it is presumed that
16 they have surrendered all scope beyond the literal language
17 of the claims, and therefore the doctrine of equivalents
18 cannot be met.

19 And that's a determination, as I said, for Your
20 Honor, and I think it's important that when we're addressing
21 this now, because it will affect the trial presentation, it
22 will affect the verdict form, it will affect the jury
23 instructions, and, in fact, the presentation to the jury of
24 what must be shown to prove infringement in this case. So
25 it's very important it's done pretrial.

1 So I will just go through the three patents that
2 I mentioned and Mr. DiGiovanni will address the last one.
3 The first here is the '150 patent. I said I'm going to walk
4 through kind of specific amendments that occurred during
5 prosecution that's relevant to our motion and show why
6 estoppel presumptively applies and it has not been rebutted
7 by the plaintiffs.

8 So, first, the '150 patent, and so the rinse
9 chamber limitation. This is a specific limitation in the
10 asserted claims of the '150 patent, and as can be shown here
11 on the left, the rinse chamber was added during prosecution,
12 which narrows the claim, and it was argued on the right that
13 it was claim 10 as amended was therefore patentable over
14 Nielson in view of Levine.

15 So it was amended, narrowed, and argued that it
16 is now patentable based on that amendment. That is what
17 gives rise to prosecution history estoppel. So therefore,
18 there's a presumption that the scope of all equivalence
19 has been surrendered beyond the literal language of the
20 claim.

21 THE COURT: All right. Let's just stop for a
22 second.

23 Who is going to argue this? Mr. Chambers, are
24 you going to argue doctrine of equivalents with respect to
25 rinse chamber?

1 MR. CHAMBERS: Your Honor, I don't think we need
2 to. As --

3 THE COURT: I just want to know if you are.

4 MR. CHAMBERS: Well, we're reserving the right
5 to. Yes, Your Honor.

6 THE COURT: All right.

7 MR. CHAMBERS: Do you want to hear anything else
8 from me?

9 THE COURT: No.

10 MR. RAHMEIER: And just to clarify why this
11 matters, it's because we do have a disputed instruction in
12 the jury, I'm sorry, in the final instructions that would
13 instruct the jury when they cannot apply the doctrine of
14 equivalents. So it would apply to certain limitations.

15 THE COURT: All right.

16 MR. RAHMEIER: In this case.

17 THE COURT: And your point is that they narrowed
18 the scope of the patent to avoid -- so that this limitation
19 could go forward?

20 MR. RAHMEIER: Yes. Narrowed the scope of the
21 highlighted language on the left.

22 THE COURT: Mr. Chambers, sorry. Do you agree
23 that -- well, why aren't you estopped from arguing doctrine
24 of equivalents with respect to rinse chamber?

25 MR. CHAMBERS: So counsel has omitted one part

1 of the analysis, which is first you look and determine
2 whether there has been a claim amendment. We concede there
3 has been a claim amendment here, Your Honor.

4 Then you look at the purpose of the claim
5 amendment. Well, in this case, the purpose of the claim
6 amendment is you had open prior art, Levine in particular,
7 that didn't have any sort of enclosure whatsoever. It
8 was just open. It was unsuitable for rinsing. The rinse
9 water would just be spraying all over the place, so the
10 amendment was to say we have an enclosure. All right. So
11 that's the second part of the analysis, why was the
12 amendment made.

13 The third part of the analysis is you look at
14 the accused product and are you trying to recapture the same
15 thing with the accused product that you gave up, which is
16 not permitted.

17 So the accused product, and this is the summary
18 judgment and why it was mentioned earlier, the summary
19 judgment might go first. All right. But the accused
20 product has an enclosure. It looks -- it has exactly the
21 enclosure that is specified in the claim. That's why we
22 believe there is literal infringement, but there is an
23 enclosure, and so what the claim amendment has and what it
24 was distinguishing has nothing to do with the issue with the
25 accused product because the accused product has an enclosure

1 also.

2 The issue with the accused product, which we'll
3 get to on summary judgment, is they are saying that, okay.
4 We're going to add an extra piece in here which is a
5 partition inside and so we avoid infringement because we
6 have a partition inside, and so that's a completely
7 different issue than this amendment was submitted to
8 address. And as we'll get to on summary judgment, the law
9 says that adding an extra element doesn't avoid
10 infringement.

11 So it's the third part of the analysis is what
12 is a distinction over the accused device which is missing
13 here, and on that basis, there would be equivalents.

14 THE COURT: Okay. All right.

15 MR. RAHMEIER: Your Honor, if I could.

16 THE COURT: You're welcome to rebut that.

17 MR. RAHMEIER: Yes.

18 THE COURT: We're going to come back to summary
19 judgment.

20 MR. RAHMEIER: That's not how this doctrine
21 works at all. In fact, you don't look at the accused
22 product. You look at the claim language and you look at
23 what happened during prosecution.

24 It would make no sense to look ten years later
25 at the accused product. He's talking about an infringement

1 analysis. I'm talking about the legal determination that
2 infringements are not available for this limitation that was
3 added for the purposes of patentability. They have not
4 rebutted that. And, Your Honor, I was looking at this just
5 the other day. In fact, there's a good quote from a
6 Delaware case I can cite.

7 THE COURT: Yes, please do.

8 MR. RAHMEIER: There is no principle of patent
9 law that the scope of a surrender of subject matter during
10 prosecution is limited to what is absolutely necessary to
11 avoid a prior art reference that was the basis for the
12 examiner's rejection, which is what we just tried to assert
13 today, that they narrowed it for a certain reason about
14 Levine or Nielson or whatever it was.

15 First of all, there's no evidence of that.
16 There's only what we see here, and the public is entitled to
17 rely on the public record here. And that case cite, Your
18 Honor --

19 THE COURT: Yes, please.

20 MR. RAHMEIER: Innovative Patents LLC versus
21 Brain-Pad, Inc., 719 F. Supp 2d., 379 at pages 34 to 86, and
22 that's the District of Delaware from 2010.

23 THE COURT: Who was the judge?

24 MR. RAHMEIER: Judge Thyng issued that opinion.

25 THE COURT: All right.

1 MR. RAHMEIER: So I think that addresses what is
2 a misstatement of the law here.

3 So, again, there is a rebuttable presumption.
4 It is a very hard presumption to rebut and they have not
5 even come close.

6 THE COURT: Okay.

7 MR. RAHMEIER: Okay. I m going to continue on
8 here.

9 MR. CHAMBERS: Your Honor, do you want me to
10 respond to that point?

11 THE COURT: No.

12 MR. RAHMEIER: The '662 patent, Your Honor.
13 Here, reporting on the left is one of the relevant, but the
14 main one, limitation that's added during prosecution. In
15 fact, this was actually added to a parent of the '662, which
16 is the '150 patent.

17 So the '150 had a continuation patent that
18 flowed from it, which became the '662. And the limitation
19 on the left, you're seeing the limit of adding the temporal
20 limitation while was added during prosecution, and then it
21 was argued that that led to the patentability and therefore
22 it should issue.

23 So this is -- again, it triggers the presumption
24 that all of the claim scope past the literal language of the
25 claim everybody surrendered and the doctrine of equivalents

1 for an infringement analysis is simply not available as a
2 legal matter for the while limitation. Again, if you look
3 to the right, it says they argued around the Nielson and
4 Levine reference, again, that we heard about. So this is an
5 unmistakable surrender that disclaims the equivalents as a
6 matter of law.

7 Again, plaintiffs have failed to rebut the
8 presumption. They do argue that it was -- that the claims
9 at issue were originally presented. I think what they mean
10 there is it was originally presented in a continuation. The
11 law is clear that you look at the claims issuing from your
12 continuation to the original claims in the originally filed
13 patent and they're clearly narrowed. They clearly have the
14 while language.

15 THE COURT: All right.

16 MR. RAHMEIER: It's kind of misleading to talk
17 about the originally filed limitation because you have to
18 look at the '105 parent.

19 THE COURT: Got you. Mr. Chambers?

20 MR. CHAMBERS: Your Honor, I think this is a
21 particularly egregious example of why this motion lacks
22 merit, particularly in the context of a motion in limine.
23 This is a claim of another patent, and it's not even the
24 same wording as the claim of the '662.

25 If you look on the left, it says, while

1 shielding the access location from the rinsing fluid. The
2 claim language is about shielding the vessel from the
3 rinsing fluid. This is a completely different patent,
4 completely different claim limitation. It just has nothing
5 to do with the '662 patent, and as a matter of fact, the
6 claim of the '662 patent that is being asserted was
7 originally claim 51, and from my review of the '662
8 prosecution history, that was never amended.

9 So we don't even get past the first step here
10 because there's no amendment. This has to do with another
11 patent and a different limitation.

12 THE COURT: All right. Mr. Rahmeier, let me ask
13 you this. I've consulted with the other judges about this
14 issue of generally, you know, what to do when motions in
15 limine come up. It came up in my last patent case. One
16 piece of advice I got, it's really just premature. You
17 have to see how this unfolds at trial. What do you say to
18 that?

19 MR. RAHMEIER: Yes. I think we wouldn't agree
20 with that, and the reason is, like claim construction, this
21 requires a legal analysis of the intrinsic record in detail,
22 really, which is why I hope this presentation kind of helps
23 our motion in limine a little bit, to show, show you where,
24 maybe you didn't get tabs, where this amendment occurred and
25 what was said to the Patent Office, and these are minutia

1 that is more akin to claim construction, which does not go
2 to the jury.

3 The jury doesn't need to dig into the record
4 here and hear arguments about, first of all, it's a pretty
5 complex legal doctrine. It's a legal determination, so I
6 think it streamlines the case for trial if Your Honor would
7 look at this and apply the Festo framework. And I think the
8 Supreme Court purposely made it in a way a simple-to-apply
9 doctrine where if there's a narrowing amendment during
10 prosecution for purposes of patentability, and that's very
11 broad, it could be for 112 purposes, it could be for
12 narrowing of the claim. It could even be by argument is my
13 understanding. But once that triggers, it's all scope past
14 literal is surrendered unless it can be rebutted by the
15 patentee, and it's a very hard thing to rebut.

16 There's barely any cases that I know of where it
17 is successfully rebutted, and I don't think we have any
18 rebuttal here in the briefing. It's really just a rehash of
19 their infringement contentions or even a discussion like you
20 heard a second ago about the accused products. But I mean
21 as a matter of common sense, prosecution history estoppel
22 can't be about what is going to be accused of infringement
23 ten years down the road. You have to look at the record and
24 public notice that the prosecution history provides to
25 apply, and I think it's very valuable to apply it before

1 trial. It will frame the questions for the jury. It will
2 frame the jury instructions, and it's just not appropriate
3 for the jury to make the determination anyway.

4 THE COURT: All right. Keep going.

5 MR. RAHMEIER: Okay. There's kind of another
6 flavor of this. It's called the rule against claim
7 vitiation. There's case law that we cited. In fact, the
8 Supreme Court discusses it in the Warner-Jenkins decision
9 there, which you want to be capable about. If you ever do
10 apply the doctrine of equivalents, you don't want to
11 basically allow equivalence that would basically swallow the
12 literal language of the claim or make it -- vitiate it. So
13 our position is while can have, for instance, an equivalent
14 language because that means solely after, while has to mean
15 at the same time. I think we'll get into this more in our
16 noninfringement. We'll take it a little bit out of order.
17 I will keep moving. It's cited in our papers, as I'm sure
18 Your Honor saw.

19 And, finally, the patent I will be addressing
20 the last is the '377 patent. Again, there are three
21 limitations at issue that we have argued and shown that the
22 presumption applies that there can be no doctrine of
23 equivalents, infringement under the doctrine. And aeration
24 means a rotatable blade assembly.

25 So the first one. As you'll see here, aeration

1 means, at the bottom, aeration means language was there.
2 Two words were there. But there's an amendment that's
3 narrowing and clarifying exactly what is meant by aeration
4 means. So it's limiting what could meet this limitation of
5 aeration means.

6 So while the words, again, the two words
7 aeration means may have already been there and
8 means-plus-function, as Your Honor knows, is kind of a
9 special way to claim things in patent law, so what is being
10 clarified here and narrowed is the function, is the means
11 function.

12 So that is a narrowing amendment. In fact,
13 Festo, the Supreme Court case, was a 112 case, so Festo does
14 apply to 112 limitations. And, again, on the right-hand
15 side is the argument that shows that it was made for
16 purposes of patentability.

17 The same for the next one. Rotatable blade is
18 there, and then there's extensive limitation and detail and
19 narrowing made to the claims during prosecution, the
20 underlying portion clarifying what's meant. And so, in
21 fact, this one -- I mean, the narrowing is quite extensive.
22 The rotatable blade now includes shaving element, aeration
23 element and all the stuff that's underlined. And, again, on
24 the right-hand side, they argue, this is all related to
25 getting the claims allowed. So the presumption applies.

1 And, finally, similar. This limitation is
2 almost exactly the same as the one we just discussed, but it
3 was added in a new claim. But there is case law and we
4 cited it, I believe we cited it, but I have the cite, if
5 not, that new claims with basically the same limitation
6 would also be subject to estoppel. You can't avoid estoppel
7 by canceling a claim and then just adding a new one during
8 prosecution. That wouldn't avoid estoppel.

9 THE COURT: Okay.

10 MR. RAHMEIER: Okay. And if there's no
11 questions, Mr. DiGiovanni.

12 THE COURT: All right. Thank you.

13 MR. DiGIOVANNI: Your Honor, we split this up
14 because it was part of the --

15 THE COURT: Summary judgment. I realize that.
16 I may have erred in doing it this way. Very hard to figure
17 out how to plow through this. Do what you can, I mean. I
18 will allow you to come back to it if we have enough time.

19 MR. DiGIOVANNI: Okay. I appreciate that, Your
20 Honor. So Mr. Rahmeier actually said it set forth the law.
21 I'm not going to repeat anything regarding the law.

22 So for the '658 patent, we have two limitations
23 that I'm going to talk about that have the preclusion of
24 doctrine of equivalents, and the first one is unrestrained.
25 The second one would be sufficient mass limitation.

1 So for unrestrained, we actually have three
2 separate doctrines that preclude the doctrine of
3 equivalents, prosecution history estoppel, claim vitiation,
4 both of which you've heard about, and there's also
5 the disclosure-dedication rule, and they're addressed in
6 both our summary judgment motion and the MIL or perhaps
7 just one of the doctrines maybe is discussed just in one of
8 them.

9 But let me talk about for unrestrained, starting
10 with the prosecution history estoppel, skipping over the
11 law. This one is straightforward. It's a classic or
12 quintessential type of doctrine of equivalents argument
13 similar to the first one that Mr. Rahmeier addressed.

14 So the unrestrained limitation was just
15 expressly added. It didn't exist in the claim and it was
16 added during prosecution, and you can see it here in both of
17 the asserted claims. These are during prosecution you have
18 different claim numbers.

19 So 18 ends up becoming claim 1, and 26, Your
20 Honor, ends up becoming claim 6. Those are the two
21 independent claims that are asserted. So we have them side
22 by side here. And you can see, in the prosecution, the
23 unrestrained was added, underlined, the entire phrase and
24 being unrestrained against sliding movement on the shaft in
25 a direction away from the opening.

1 THE COURT: And do you agree that I should not
2 be taking into consideration anything about the accused
3 products, that this is purely, I can look at the prosecution
4 history and make this call?

5 MR. DiGIOVANNI: Yes, Your Honor. As
6 Mr. Rahmeier said, that's very similar to the claim
7 construction in that regard. Claim construction -- think
8 about what claim construction does. You're binding the
9 patent owner to things that they said to the Patent Office,
10 exactly what we are doing here.

11 THE COURT: Okay.

12 MR. DiGIOVANNI: You're binding them to what
13 they did in terms of their amendments, their changes that
14 they did to get the patent admitted. And also off topic a
15 bit, you had asked should it be decided, and I understand
16 you conferred with the judges. We think absolutely, because
17 we think from day one we would otherwise be hearing about
18 doctrine of equivalents, and we think that would be to try
19 to then determine later that it should be precluded.

20 THE COURT: Well, part of it is in the context
21 of it was a biological product. Well, sometimes very
22 difficult to get an appreciation up front as to what the
23 difference is.

24 MR. DiGIOVANNI: I understand that.

25 THE COURT: I didn't mean to suggest that my

1 colleagues think we should never, ever --

2 MR. DiGIOVANNI: No. I didn't mean to suggest
3 that either. And I guess I would say here, these are
4 mechanical, relatively simple, I think it's understandable.
5 So anyway, again, sort of quintessential prosecution history
6 estoppel.

7 And the bottom right you can see where they
8 actually explain why they did it, and it's this Harr
9 reference that was cited. Claim 18 through 21 and 21
10 through 26 have been rejected as anticipated by Harr. They
11 say the Harr cover is not unrestrained against movement.
12 They so explain very expressly why they added the
13 unrestrained, and under Festo, it's prosecution history
14 estoppel.

15 Moving onto the second doctrine that prevents
16 DOE for unrestrained, and that would be this rule against
17 claim vitiation. I don't even talk about the law, although
18 the second case is interesting because sort of the classic
19 claim vitiation is when you have the opposite.

20 So Mirror Worlds versus Apple, the Federal
21 Circuit said, reading the limitation out of the claim
22 improperly vitiates claim language by allowing the exact
23 opposite of what is required. Well, that's what you have
24 here. You actually have any kind of doctrine of equivalents
25 that you're going to have for unrestrained, it's actually

1 going to make it restrained. So you can't do that. The
2 doctrine of claim differentiation, that's the most express
3 strain of that, and it tells us you can't do that.

4 And the third doctrine is the
5 disclosure-dedication rule. I know we cited three different
6 doctrines not because we're grabbing for straws. They were
7 just our three doctrines that apply expressly, and in this
8 one, what the cases say, and the Johnson and Johnston case
9 from the Federal Circuit, an en banc case that gets cited
10 quite a bit.

11 They are talking about the patent specification.
12 Here it is a little different. We're talking about the
13 provisional application. Okay. So I will tell you that's a
14 little different than what you typically see in the
15 disclosure-dedication doctrine, but it's the same concept.
16 If you disclose something yet you don't claim it, then it's
17 dedicated. That's what the cases say and all the cases
18 following it say that.

19 And in this case, here's the disclosure in the
20 provisional application. They say -- the provisional
21 application is very short and we attach it. This isn't the
22 entirety of it. This states when they are talking about how
23 to hold down that lid on top of the cup when you are making
24 the milkshake or when you are blending whatever beverages,
25 they talk about it can be held on by a spring and to secure

1 the cup in contact with it with the holder holding the cup.
2 They say another approach to this is to use a heavy weight
3 to hold the shield and cup in place.

4 So the inventor contemplated and disclosed to
5 the world this other potential way to hold down the shield
6 on top of the cup as a lid so you don't get the spillage.
7 He says, let's use a heavy weight to hold it down.

8 Well, now, fast-forward to the claim. They
9 never claim that. They claim a lid. They don't claim a lid
10 assembly connected to a weight or anything like that. So
11 they've disclosed it, and by not claiming it, they've
12 dedicated it to the public.

13 And I did want to point out that this was a
14 provisional because I couldn't find the case. I can't say I
15 looked. I did look pretty hard, Your Honor, but I don't
16 know that I looked comprehensively.

17 THE COURT: An exercise of diligence of the
18 person of skill as an attorney.

19 MR. DiGIOVANNI: I looked for a case where we
20 had a provisional application and then the doctrine was
21 supplied. I didn't see it, but I don't see a difference in
22 it, especially in view of the fact that the provisional
23 application is something that the plaintiff, patentee is
24 relying on for two things. The earlier date, okay. So they
25 want the date from it, and they are allowed to do that, and

1 it's referenced in the patent's provisional. And they also
2 need some of the disclosure in there to try to get that
3 earlier date.

4 So they are relying on the date and they're
5 relying on what's in there. I saw no reason why the
6 disclosure-dedication doctrine would not apply to a
7 provisional application.

8 THE COURT: Well, if I were in a Markman, that
9 application would count as intrinsic evidence. Right?

10 MR. DiGIOVANNI: It would, Your Honor.

11 THE COURT: Yes.

12 MR. DiGIOVANNI: Yes. So that's the
13 unrestrained, I believe that's the last slide I have on
14 unrestrained.

15 Now we go to sufficient mass. A little bit more
16 complicated, but I will go through this.

17 So, again, we're looking at claim 1 and claim 6,
18 and this is just the claims as issued just to show you the
19 context because we have not talked about those.

20 So the sufficient mass as issued. Those
21 limitations in claim 1 and claim 6 say that the mass of the
22 splash shield, and that has been defined as the lid, just
23 the lid, that's also relevant to what I was talking about
24 before when you add a weight and a lid, that's different.

25 So the splash shield is just the lid, the lid

1 for the cup opening. So the limitations end up being the
2 splash shield has sufficient mass -- let me read it from the
3 right. It's as simple as it gets. The mass of the splash
4 shield prevents separation of the holder and the vessel
5 during translation.

6 So what that means is, Your Honor, the holder is
7 the cup holder in this milkshake machine. The vessel is the
8 cup. The user takes the cup, puts it in the holder. Okay.
9 And then the blade comes down. The spindle, and the blade
10 comes down with the lid. Okay. Now, the lid is on it. The
11 mass of the lid has to prevent separation of the holder and
12 the vessel. It keeps the cup in place. Okay. That's what
13 the -- the mass has to be sufficient to keep that cup in
14 place in the holder. Okay. That's the claim as issued.
15 That's just a little background because we hadn't gotten to
16 that yet.

17 So now let me get to the claim, which is the
18 limitation on DOE. So start with prosecution history
19 estoppel. I need to flip ahead.

20 Okay. So prosecution history estoppel. Not as
21 straightforward as the other one because you don't just have
22 that limitation being added in here. Okay. What you have
23 is, you have the limitation being -- you have language being
24 amended that's important to that limitation to the point
25 where that limitation ought to be bound by -- they should

1 not have a doctrine of equivalents.

2 So in this one -- let me just catch up here with
3 my notes.

4 So in this one, in the last -- this is claim 18,
5 dependent claim 1. Toward the bottom, the splash -- I'm
6 sorry. It says, the splash shield having sufficient mass to
7 retain the vessel within the holder during the relative
8 axial movement of the mixing element and vessel from the
9 first position to the second position.

10 So what's happening here is, there was some
11 prior art cited that apparently had some kind of other type
12 of movement other than axial movement, so they narrowed the
13 claim to require that the mass prevent axial movement,
14 meaning exactly what it ends up being in the as issued
15 claim, axial movement meaning the up and down with the cup
16 in the holder. Prior to that, it was broader than that. It
17 allowed any kind -- it precluded any kind of movement, and
18 now they've limited it to axial movement.

19 So that's the type of narrowing limitation that
20 ought to be, they ought to be precluded from the doctrine of
21 equivalents.

22 THE COURT: Okay.

23 MR. DiGIOVANNI: It's a bit more complicated
24 than on --

25 THE COURT: Axial is up and down movement? I

1 would have thought it was more like rotating.

2 MR. DiGIOVANNI: No. They -- I think they
3 explained it somewhere else, but it is along the axis.
4 Because the claim is written I won't say from the
5 perspective of the blade, but the axis.

6 THE COURT: Along the axis?

7 MR. DiGIOVANNI: Yes, yes.

8 Claim 6 -- okay. Yes. So prosecution claim
9 26, which ends up being claim 6. Let me catch up on my
10 notes.

11 So this one is a whole different situation, but
12 the key here is that prior to this amendment -- so this is
13 an amendment that happened during prosecution. If you see
14 prior to the amendment here --

15 THE COURT: So just help me out. Mr. Rahmeier,
16 you had sufficient mass as well. Right? No? Am I getting
17 confused?

18 MR. RAHMEIER: No.

19 THE COURT: Okay. I'm getting confused. All
20 right. A long day. All right.

21 MR. DiGIOVANNI: Yes. So what happens here is,
22 there's an amendment -- actually, that's very significant,
23 this amendment, because prior to this amendment -- and what
24 they change is, they change the word splash shield to
25 holder.

1 So prior to this amendment, the way the claim
2 read was, the mass of the splash shield prevented separation
3 of the splash shield, that's the lid and the vessel. But
4 here now it's preventing -- which was very different than
5 what it ends up being in the final claim, and what it ends
6 up being here is, the mass prevents separation of the cup
7 holder and the vessel. So it's keeping the cup in the
8 holder. So it's a significant difference in terms of how
9 sufficient that mass must be. So it goes directly to the
10 phrase sufficient mass in this prosecution history.

11 THE COURT: How is this going to come up? What
12 do you anticipate?

13 MR. DiGIOVANNI: Okay.

14 THE COURT: Take this particular term.

15 MR. DiGIOVANNI: Okay.

16 THE COURT: How is it going to come up at trial
17 if I deny the motion?

18 MR. DiGIOVANNI: Can I get a prop, Your Honor --

19 THE COURT: Yes.

20 MR. DiGIOVANNI: -- that I think would be quite
21 useful? We have our lid. Okay. This is part of the
22 machine, the accused machine.

23 THE COURT: Okay.

24 MR. DiGIOVANNI: Some of the accused machines.
25 The other ones are different, but not in a material way for

1 this point.

2 So literally, okay. The lid -- remember, the
3 shield has to be as defined as the lid. Literally, the
4 shield cannot be restrained. I will address both of those
5 points if you don't mind.

6 THE COURT: Okay.

7 MR. DiGIOVANNI: Literally, this cannot be
8 restrained, the lid can't be restrained. It has to by
9 itself be sufficient to -- it can't be restrained at all,
10 period. It can't be restrained, and it has to be
11 sufficient, the lid, to do what it says in the claim
12 language. That is, to keep that, keep that cup, the
13 milkshake cup, into the holder.

14 THE COURT: All right.

15 MR. DiGIOVANNI: So two different limitations.

16 They are saying, oh, we have an equivalent.
17 Okay. This thing. There's a doctrine of equivalents that
18 allows us to use the assembly or a rod and this, and they
19 are saying, that's an equivalent, and we're saying, no. If
20 you didn't have a process for estoppel or vitiation or a
21 third doctrine, okay. Maybe you could argue doctrine of
22 equivalents, but you don't get it here because of what you
23 did in the prosecution.

24 So that's where it comes up is, from the get-go
25 they're going to be arguing that's an equivalent, and we say

1 you don't get equivalent. They still get to argue literal.
2 Okay. That's a different story. We do have a motion for
3 summary judgment on that, but they, under the law, because
4 of what they did in the prosecution, and they had to do that
5 to get around the prior art, or maybe if they didn't have to
6 do it, they did it. The law says, even if they didn't have
7 to do it, they did it.

8 THE COURT: All right.

9 MR. DiGIOVANNI: So they don't get an
10 equivalent. All right. That's process history estoppel for
11 sufficient mass.

12 We also have -- Your Honor, I want to make sure
13 of something. We didn't argue vitiation on this. I have it
14 in the slide because sufficient and insufficient are
15 different. That wasn't in our brief I noticed. I would say
16 this. In a way, it's a strand of these other doctrines, so
17 I don't know that I had to --

18 THE COURT: If it's not in your brief, let's
19 move on then.

20 MR. DiGIOVANNI: Okay. We did argue dedication
21 disclosure.

22 THE COURT: Right.

23 MR. DiGIOVANNI: The same statement here.
24 Another approach where they say, another approach is to use
25 a heavy weight to hold the shield. We say, okay. The same

1 argument. I don't need to make it again.

2 THE COURT: All right.

3 MR. DiGIOVANNI: I'm sorry. This is now --
4 that's my -- that concludes my argument as to why DOE
5 doesn't apply.

6 THE COURT: All right.

7 MR. DiGIOVANNI: There was one additional point.
8 One of the pieces of prosecution history was Exhibit T to my
9 declaration. My declaration stated the right Bates number,
10 but the correct Bates number was not attached. So may I
11 approach, Your Honor?

12 THE COURT: Yes.

13 MR. DiGIOVANNI: We provided this at the outset
14 of the day to plaintiffs' counsel (handing documents to the
15 Court.)

16 THE COURT: So your declaration was --

17 MR. DiGIOVANNI: I have two declarations. The
18 one I'm talking about is the one in support of --

19 THE COURT: So do I just replace this Exhibit T
20 with what's in the pretrial order?

21 MR. RAHMEIER: It's in the summary judgment.

22 THE COURT: Summary judgment?

23 MR. RAHMEIER: We can file a corrected copy.

24 THE COURT: Well, I will leave it to you what
25 you want to do.

1 MR. DiGIOVANNI: I think we'll file a corrected
2 copy.

3 THE COURT: Please file a corrected copy.

4 MR. DiGIOVANNI: We will do that.

5 THE COURT: Okay.

6 MR. DiGIOVANNI: Yes.

7 THE COURT: All right.

8 MR. DiGIOVANNI: One additional point.

9 Mr. Rahmeier made the argument about Dr. Maynes. The DOE
10 was not in their infringement contentions I'm told. That
11 was the first -- that was my argument.

12 THE COURT: All right. Mr. Chambers?

13 MR. CHAMBERS: I've got a lot of ground to cover
14 here.

15 THE COURT: I'm sorry. What?

16 MR. CHAMBERS: I've got a lot of ground to cover
17 here.

18 THE COURT: No, and I know someone is going to
19 come back again on the summary judgment issue, so I get
20 that.

21 MR. CHAMBERS: Well, let me start with
22 disclosure-dedication. That's not even mentioned in their
23 in limine motion, so --

24 MR. RAHMEIER: Yes, it is, Your Honor.

25 MR. CHAMBERS: In your in limine motion?

1 MR. RAHMEIER: Yes.

2 MR. CHAMBERS: Where is that in your in limine?

3 THE COURT: Well, you know what --

4 MR. RAHMEIER: Page 2.

5 MR. CHAMBERS: All right.

6 MR. RAHMEIER: The en banc case is cited.

7 MR. CHAMBERS: I will have to retract that. I
8 didn't see a heading for disclosure-dedication.

9 So let's talk about disclosure- dedication.

10 While I mentioned it, they said -- they mentioned it right
11 here on the slide, the heavy weight. They said, oh, that
12 was never claimed, and then they say, oh, sufficient mass.
13 We're going to limit that.

14 Sufficient mass is the heavy weight. It was
15 claimed. That's exactly -- so I don't understand what their
16 point is on the disclosure-dedication doctrine. But let me
17 get to some basic principles so Your Honor can understand
18 exactly what is at issue here.

19 In the prior technology, and this is the Harr
20 they were talking about, they had a spring to kind of hold
21 down the splash shield, and the problem with the spring is
22 if you push it up as your cup is going up to mix, it gets
23 greater tension and it creates a lot of binding, and then as
24 you go down, it has lower tension. So that created all
25 sorts of headaches from an engineering perspective. And

1 they also had motors, which is the Nielson, to raise the
2 splash shield up and down, and that created lots of
3 headaches, too.

4 So the invention here in the '658 patent, which
5 is actually very elegant, is to get rid of the springs, get
6 rid of the motor, and have a heavy weight of a splash
7 shield, which has sufficient mass, to hold the lid down on
8 the cup as it's moving up and down, and you want to do that
9 in an unrestrained or free-floating way. So that's what the
10 invention is, a weighted splash shield that moves up and
11 down in a free-floating way.

12 So if they don't mind, I would like to borrow
13 their prop.

14 So this is what they did. They had a splash
15 shield, and we talked earlier about their '823 patent, and,
16 you know, I was mentioning that, you know, somebody needs to
17 connect it up. But there was no -- no weight shown in the
18 '823 patent.

19 So it doesn't correspond with their commercial
20 product, but they decided after being aware of f'real's
21 invention in the '658 patent and the technology, that they
22 were having problems of holding down the cup, and so they
23 decided, okay. We need to have a weighted splash shield,
24 and so they put this heavy weight on the splash shield to
25 hold down, which is exactly Mr. Farrell's invention, and

1 they have this kind of moving up and down with not binding.
2 They say in their technical instructions that this needs to
3 move up and down freely and essentially they say it has to
4 move up and down unrestrained. So they have the two
5 elements of the invention here, which is the weight and
6 moving up and down in an unrestrained manner.

7 THE COURT: Why do you need doctrine of
8 equivalents?

9 MR. CHAMBERS: I don't think we need to.

10 THE COURT: So why are we arguing about this?

11 MR. CHAMBERS: I will tell you why.

12 THE COURT: Okay.

13 MR. CHAMBERS: So they are saying that, yes, we
14 added the weight, but we moved the weight up eight inches.
15 So your patent only covers when you put the weight down on
16 the lower cover, so we avoid your patent because we moved
17 the weight up eight inches. That's their noninfringement
18 argument.

19 And then their noninfringement argument for
20 unrestrained is, yes, this moves up and down, and we say in
21 our technical specifications that it has to be freely
22 moving, but they say we're hiring an MIT professor as our
23 expert, and that there's a theoretical possibility that
24 there could be an incidental de minimis amount of friction
25 here, so because there theoretically could be from friction

1 even though it's supposed to be unrestrained, that's our
2 noninfringement defense.

3 So this is what we're dealing with on their
4 infringement defenses, both of them petty and insubstantial
5 in our view.

6 So let's get back to the prosecution history
7 estoppel. As we cite in our opposition, when you make the
8 amendment, you must look at the scope of the estoppel must
9 fit the nature of the narrowing amendment. And we cite
10 Intervet citing Festo. There is no reason why a narrowing
11 amendment should be deemed to relinquish equivalents beyond
12 a fair interpretation of what was surrendered.

13 So what was being -- to the extent there was an
14 amendment on sufficient mass, for instance, it was to get
15 around the spring, which is hard, and pushing it up and down
16 and all the compression. That's what the amendment was all
17 about. It was not taking the invention, which is adding a
18 heavy weight and raising it up 12 inches.

19 So you have to consider, you know, what is the
20 issue for the doctrine of equivalents. The issue is not
21 putting on a spring which is Harr. That is what was
22 surrendered. We're not disputing we surrendered the spring
23 of Harr, but we're saying if you do the same invention of a
24 heavy weight but decide to move it up a few inches, that's
25 different, and that should be an equivalent. Similarly,

1 with unrestrained, that was again Harr, and you had the
2 spring there, which was pushing it down and restraining
3 it.

4 But here, you have it designed to be freely
5 moving up and down. That's what their technical
6 specification says. It freely moves up and down. So that's
7 not what was surrendered. What was surrendered was the
8 spring, and their argument is, well, there's a theoretical
9 possibility of friction. Completely different issue, so
10 that's why it's equivalent.

11 And then with respect to aeration means, that's
12 means-plus-function, so you do get equivalents under the
13 statute. That's statutorily required. And then for their
14 vitiation, what they quote is if it's exactly the opposite
15 of what the claim is.

16 Okay. Well, is putting a heavy weight so you
17 can have a weighted splash shield, is that the opposite of a
18 weighted splash shield? Well, I think the answer is no.

19 THE COURT: What about restrained?

20 MR. CHAMBERS: What?

21 THE COURT: What about restrained?

22 MR. CHAMBERS: Yes. What about restrained? Is
23 moving this up and down an unrestrained way the opposite of
24 unrestrained? I would say no. So I think that answers that
25 one.

1 THE COURT: All right.

2 MR. CHAMBERS: Thank you, Your Honor.

3 THE COURT: All right. I'm going to reserve
4 judgment on this motion in limine. I mean, you know, in
5 retrospect, I should have had this pretrial conference weeks
6 and weeks ahead of time before the trial, just do what I can
7 to get stuff out to you as fast as I can.

8 I think the good news is I don't think that my
9 determination of this motion really affects the presentation
10 that much at trial, and I think that you can quickly move,
11 it sounds like, to address it.

12 All right. I think we have one more motion in
13 limine. Is that correct?

14 MR. CHAMBERS: Very quickly, Your Honor. Could
15 I ask them to bring that to trial?

16 MR. DiGIOVANNI: It's on our exhibit list, Your
17 Honor.

18 MS. SILVERSTEIN: Good afternoon. Brianna
19 Silverstein again.

20 So our motion in limine number three is to
21 preclude plaintiffs' expert from offering to, and
22 plaintiffs, sorry, from offering evidence, argument or
23 reference related to their expert's untimely disclosure and
24 improper reliance on two different sets of testing.

25 And I know Your Honor made reference to some of

1 this earlier, but I would like to go through each part
2 that's in the 2019 testing report because I do think some of
3 it is completely irrelevant to plaintiffs' claims that they
4 were prejudiced because they weren't put on notice.

5 So I want to start with the 2019 testing, and
6 just as a quick reminder, the fact discovery deadline was
7 July 2018 and expert discovery ended on November 2nd, 2018.
8 We filed our motion for summary judgment on December 14th,
9 and then on January 11th the plaintiffs filed a declaration
10 from Dr. Maynes that included a new testing report that was
11 dated January 7th. And the new testing addressed -- had
12 five different questions in it.

13 So the first one was the weight of the splash
14 shield assembly. And in this one, Dr. Maynes weighed what
15 we were just looking at, that whole thing, and this deals
16 with claim 5 of the '658 patent, which specifically requires
17 that the weight of the lid be five pounds. And in his
18 original report, Dr. Maynes stated that the weight was
19 3.74 pounds. So it's unclear why he needed to revise his
20 report, to put in a new weight, or how, you know, it was
21 somehow our, you know, our burden to show that it wasn't
22 five pounds, or that 3.74 isn't five pounds. I think that's
23 what we argued in our summary judgment motion. So that is
24 that first question.

25 The second one is whether the splash shield

1 moves freely or is affected by friction, which that's what
2 Mr. Chambers was just talking about.

3 This is, again, about the '658 patent, and in
4 his original report, Dr. Maynes acknowledged that there was
5 friction, and the only thing he is doing in this new report
6 is now coming up with some way of measuring it and trying to
7 say that it's not a lot of friction, but as Mr. Chambers
8 acknowledged, the plaintiffs have known that that is one of
9 our arguments. In fact, our engineers commented that there
10 was friction.

11 The third one is the MIC2000 cutting blade has a
12 slim cross-sectional profile. This deals with the '377
13 patent and the means, the grinding means, which Judge Sleet
14 said would include a blade with a thin cross-sectional
15 profile.

16 Now, again, Dr. Maynes, he had addressed this in
17 his original report. In that report he looked at the prior
18 art and just did a visual comparison, and now all of a
19 sudden in 2019, he comes up with some new equation that he
20 wants to do to show that it's a thin cross-sectional
21 profile. Again, unclear how that was at all affected by
22 anything that defendants did or did not disclose.

23 And then I'm going to skip the next point and go
24 right to the aeration. And this kind of actually ties into
25 the 2015 testing, where basically Dr. Maynes kind of

1 consulted again with one of the f'real employees who did the
2 testing, and then he's confirming it.

3 THE COURT: Your first slide, I thought we were
4 just talking about the testing. Your motion is to get, you
5 know, to exclude his January 2019 testing and f'real's
6 withheld 2015 testing.

7 MS. SILVERSTEIN: Yes. This was all in the
8 testing report. This exhibit was Exhibit A to his new
9 declaration. All of these points were in his testing
10 report. It wasn't just the new grinding testing. It
11 included all of these even though, again, on summary
12 judgment, that some of these, such as the last point,
13 aeration, wasn't even related to our summary judgment
14 motion. That wasn't even related, but he still put in a new
15 report about that.

16 So unless you have more questions about 2019, I
17 can go onto the 2015 testing.

18 THE COURT: All right.

19 MS. SILVERSTEIN: Again, during discovery --
20 this is in our papers. During discovery defendants
21 requested any testing that supported f'real's infringement
22 claims, and there was a specific, a specific interrogatory
23 related to aeration.

24 f'real didn't produce anything during discovery,
25 and then on August -- in August 2018 in their opening

1 report, the plaintiffs produced for the first time two sets
2 of testing that were performed in 2015 by f'real employees.
3 The first one was testing performed by Curtis Tom and
4 documents by Jen Voges. And the second set is a set of
5 testing that did not have any name associated with it, and
6 that we found out at Dr. Maynes' deposition in October were
7 performed by an employee named Mike Partsuf. His name had
8 been completely absent from the record in the case. He was
9 never mentioned in any deposition, interrogatory request,
10 was not even mentioned in their document production at all.
11 And that was the second set. And that's actually the set
12 that Dr. Maynes admitted at his deposition that he relied
13 upon.

14 THE COURT: Okay. But in December of 2015, in
15 response to interrogatory number 10, f'real referenced,
16 right, f'real's experiments indicate that air is initially
17 removed. Now, that sounds like aeration testing to me.
18 Right?

19 MS. SILVERSTEIN: Yes.

20 THE COURT: So they disclosed it to you in
21 December of 2015. Did you make a request to follow up on
22 this interrogatory? Did you do anything to ask for the test
23 results?

24 MS. SILVERSTEIN: We had outstanding discovery
25 that would have asked for the testing results.

1 THE COURT: Did you follow up on it? This is
2 December of 2015. When did discovery close?

3 MS. SILVERSTEIN: July of 2018.

4 THE COURT: Did you go to the Court and say, you
5 know, that we know they've got this testing out there.
6 They've not turned it over. They are not hiding it. They
7 say it.

8 MS. SILVERSTEIN: No, we did not, Your Honor,
9 but as they said in their opposition here, that would
10 have not mattered because they are now claiming there was
11 some sort of work product privilege over it and that, you
12 know, that's why they said they didn't produce it to begin
13 with.

14 THE COURT: Well, they didn't produce it to
15 begin with because if you are an attorney and you ask
16 somebody to run something, and I don't know that it has been
17 tested, but as I understand it, they represented that these
18 two folks who did this test were directed to do it
19 by attorneys. They did it. They didn't make the decision
20 to disclose it until a later date, and it sounds like it's
21 in response to specific allegations of noninfringement
22 raised by you all.

23 MS. SILVERSTEIN: This was in his opening
24 report.

25 THE COURT: So this one is not?

1 MS. SILVERSTEIN: Right. This is in his
2 infringement analysis.

3 THE COURT: Anyway, so I don't even know what
4 the harm is here. You've got it in the initial disclosure
5 report. It was referenced in December of 2015 in a response
6 to an interrogatory. You did nothing to follow up on it.
7 I'm trying to understand why there's a problem.

8 MS. SILVERSTEIN: Well, the harm is that at
9 least as to the second set of testing that was performed by
10 Mike Partsuf, we had no idea that existed. We found out
11 from Mr. Voges at his deposition that he had performed some
12 testing, and there was no work product privilege objection
13 made at that time, and we actually don't think that they
14 have met their burden of showing work product.

15 There's nothing on these documents that says
16 that it was, that the testing was at the request of counsel,
17 and they didn't put any testimony in from either of the, or
18 any of the f'real employees saying that they only ran it at
19 the request of counsel.

20 Like I said, at the deposition -- now, we didn't
21 have the report at the deposition, so we were asking the
22 question blindly at that point. But at the deposition --

23 THE COURT: What is it that they didn't respond
24 to? They didn't produce these to?

25 MS. SILVERSTEIN: Well, we had a specific

1 interrogatory.

2 THE COURT: Right. The number 10, the one I
3 read to you. Right?

4 MS. SILVERSTEIN: I'm sorry. We had a specific
5 request for production that asked for -- hold on one second.
6 That asked for, I believe, all documents relating to the
7 allegations of infringement, something to that effect.

8 THE COURT: So I mean, here's what's cited as
9 far as I can tell. It's a request for production number 10
10 and 43. Is that right?

11 MS. SILVERSTEIN: Yes.

12 THE COURT: Okay. So, and number ten is all
13 documents and things concerning their contention that
14 Hamilton Beach is infringing any claim of the
15 patents-in-suit, and they respond to this in February of
16 2015. They say, impermissibly seeks attorney/client
17 privilege and attorney work product. And then that would
18 be -- all right. So then you learn about it when?

19 MS. SILVERSTEIN: So we didn't get the testing
20 until August, and it's in the second report, the one --

21 THE COURT: And did they supplement this
22 response?

23 MS. SILVERSTEIN: No. They never.

24 THE COURT: So they never supplemented the
25 response?

1 MS. SILVERSTEIN: No. And the report on the
2 right, as you can see, which is the one that Dr. Maynes
3 relies on and that he redid in 2019 again, apparently
4 because Dr. Slocum responded to it in his rebuttal report,
5 although that was the first time that Dr. Slocum could have
6 responded to it, because we didn't have it until August. It
7 doesn't have a name, a date, anything on it.

8 THE COURT: All right.

9 MS. SILVERSTEIN: We couldn't learn any of that
10 until we talked to Dr. Maynes about it.

11 THE COURT: All right. Now, how are you
12 prejudiced?

13 MS. SILVERSTEIN: So as to the 2015 testing, we
14 were specifically prejudiced because we never had a chance,
15 especially like it says to the second report there that Mike
16 Partsuf did, we never had a chance to talk to Mr. Partsuf.

17 Dr. Maynes did not observe the test and he had
18 had some conversations, but there were a bunch of things
19 that he didn't know when we asked him at his deposition
20 about how the tests were conducted or anything like that.

21 THE COURT: Okay.

22 MS. SILVERSTEIN: And --

23 THE COURT: Now, before we go on --

24 MS. SILVERSTEIN: Yes.

25 THE COURT: Mr. Chambers, who is doing this on

1 your side?

2 MR. CHAMBERS: I am.

3 THE COURT: Are you trying to introduce the 2015
4 test in front of the jury?

5 MR. CHAMBERS: What she has up on the screen,
6 the answer is no.

7 THE COURT: We can agree on it. I don't have to
8 rule on it. It's not coming in.

9 MR. CHAMBERS: One on A. Now, there is another
10 test B that we plan to put in as well as the retests which
11 were done --

12 THE COURT: By May of 2019?

13 MR. CHAMBERS: In 2019.

14 THE COURT: That's not my question. My question
15 is 2015. Let's just deal with 2015. Are you trying to
16 bring that in? And the answer is no.

17 MR. CHAMBERS: Right. If we get 2019, we don't
18 need 2015.

19 THE COURT: Okay. So then let's talk about
20 that. So it sounds like 2015 is off the table.

21 MS. SILVERSTEIN: Okay.

22 THE COURT: All right.

23 MS. SILVERSTEIN: So the only reason I had to do
24 2019, this -- to the aeration point specifically. The only
25 reason that they say in their opposition they had to do the

1 2019 report was because the first time that Dr. Slocum
2 addressed it was in his rebuttal report.

3 THE COURT: Right. And he said that there's no
4 visual, that nobody saw any grinding or -- right?

5 MS. SILVERSTEIN: No. This is completely
6 separate from there.

7 THE COURT: All right.

8 MS. SILVERSTEIN: We did not bring summary
9 judgment on this. This is not part of the summary judgment.

10 THE COURT: Okay.

11 MS. SILVERSTEIN: This is an aeration issue. If
12 you can go back, I can show you.

13 THE COURT: Hold on.

14 MS. SILVERSTEIN: If you look at the 2019
15 testing, as I said, he does five different tests. Only one
16 of those relate to the grinding, which is the visual
17 evidence of grinding.

18 THE COURT: All right. Slow down for just a
19 second.

20 MS. SILVERSTEIN: Sure.

21 THE COURT: Sorry.

22 MR. CHAMBERS: Your Honor, I think I can help
23 get to the heart of this.

24 THE COURT: Well, just stop for a second. So
25 I'm looking at your motion.

1 MS. SILVERSTEIN: Yes.

2 THE COURT: And you say, in January of 2019,
3 long after fact and expert discovery closed, plaintiffs
4 support their opposition with a declaration of their
5 technical expert, Dr. Maynes, that included brand-new
6 grinding and shaving testing.

7 MS. SILVERSTEIN: Yes, but the testing -- I
8 guess this --

9 THE COURT: So, you know, when I read your
10 motion, that's what I'm looking at. And now I'm hearing
11 about aeration testing.

12 I mean, is it mentioned in your motion in
13 limine? Can you show me anywhere in your motion in limine
14 where you mention aeration testing?

15 MS. SILVERSTEIN: Well, we talk about the -- I'm
16 sorry for the confusion, Your Honor. In limine -- we had a
17 separate section on testing and grinding just in the summary
18 judgment portion. I understand.

19 THE COURT: Do you mention aeration in here?
20 You know, we're coming up on three hours on this oral
21 argument. You know, we have 500 cases each here in this
22 Court. I'm spending time. I just read all of these
23 motions. Where is it about aeration?

24 MS. SILVERSTEIN: I'm sorry, Your Honor. It
25 doesn't. It's not included in here specifically. This was

1 supposed to cover his whole test, his whole new testing
2 report.

3 THE COURT: So you've waived it as far as I'm
4 concerned. You had an opportunity. You waived it. You
5 asked to preclude his testing for grinding and shaving, and
6 now it sounds like --

7 MS. SILVERSTEIN: Oh, I will note that in the
8 opposition, they do address the aeration testing, so I think
9 it was --

10 THE COURT: I'm going by what your motion is.
11 This is the first I'm hearing of aeration as you're talking
12 about it today, which is why I got confused.

13 MS. SILVERSTEIN: Okay. I'm sorry, Your Honor.
14 It was supposed to cover the entire new report.

15 THE COURT: Yes. Well, I'm sorry, too, but
16 you waived it. I'm going to let the grinding and testing
17 in.

18 So I'm going to deny the motion in limine to
19 preclude the grinding and testing of 2019. It sounds like I
20 don't need to deny the 2015 because it's rendered moot
21 because I understand, and I will have Mr. Chambers confirm,
22 there will be no attempt to bring in 2015 testing. Is that
23 correct?

24 MR. CHAMBERS: Correct, Your Honor. We'll go
25 with 2019. Yes.

1 THE COURT: All right.

2 MS. SILVERSTEIN: Oh, I will mention that the
3 2019 testing refers to the 2015 testing.

4 THE COURT: All right. I mean, I would imagine
5 you could excise any references to the 2019 testing. Sorry.
6 In the discussion at trial of the 2019, can't you just
7 excise or redact any reference to the 2015 testing.

8 MR. CHAMBERS: I can, Your Honor. Let me --

9 THE COURT: You can or you cannot?

10 MR. CHAMBERS: We can do that, definitely.

11 THE COURT: All right. That takes care of that
12 then. It's moot, but I'm going to grant the motion in
13 limine insofar as it seeks to exclude the 2015 testing. I'm
14 going to deny it to the extent it seeks to, as it did,
15 requested the exclusion of the grinding and testing,
16 grinding and --

17 MR. DiGIOVANNI: Shaving, Your Honor.

18 THE COURT: Shaving. Thank you. Testing done
19 in 2019. I think that was a fair response to inadequate
20 disclosures, and I think it was appropriate, as I mentioned
21 earlier. There was no motion in limine to exclude other
22 parts of the report, and it's too late. We have to have
23 rules, and we have to -- so...

24 MR. CHAMBERS: Just so we're clear, Your Honor.
25 The subject matter in Dr. Maynes' January 2019 summary

1 judgment responsive declaration, that can be admitted into
2 evidence?

3 THE COURT: No. He's going to testify.

4 MR. CHAMBERS: Yes, he's going to testify.

5 THE COURT: So we're not going to admit a
6 declaration.

7 MR. CHAMBERS: Right.

8 THE COURT: The --

9 MR. CHAMBERS: The subject matter.

10 THE COURT: The subject matter, the answer is
11 yes.

12 Now, are we all clear? We're all on the same
13 page? Mr. DiGiovanni?

14 MR. DiGIOVANNI: I guess the one thing I would
15 say, I mean, the Federal Rules say if it's not in someone's
16 expert report, then at trial, we would -- normally, we would
17 object and maybe have a sidebar and say, hey, this is not in
18 his expert report. Does your ruling affect that? Are we
19 considering that part of his expert report because that
20 testing was certainly not in his expert report, not subject
21 to his deposition.

22 THE COURT: Well, but, you know, this goes back
23 to what I think are inadequate disclosures. Now, you've
24 just pointed out, the other side's disclosures could be
25 severely criticized it seems to me as well. But I mean,

1 you're going to get to argue that -- I guess you can argue,
2 well, you didn't see any grinding or testing, and then he
3 comes back and says -- I'm sure what he's going to say is, I
4 wasn't looking for it. We've been litigating this case for
5 a long time. I didn't think this was an issue. I didn't
6 look for it. You raised it. I went and I looked for it and
7 I proved it. I mean, that seems fair.

8 MR. DiGIOVANNI: Okay.

9 THE COURT: All right.

10 MR. DiGIOVANNI: The one point of unfairness I
11 would raise --

12 THE COURT: Okay.

13 MR. DiGIOVANNI: -- we now have this whole group
14 of testing that he put in.

15 THE COURT: Right. But you didn't move in
16 limine for it.

17 MR. DiGIOVANNI: No, no. I mean, technically,
18 Your Honor, we don't even have to because if it's not in his
19 original report, if it's not in his original report --

20 THE COURT: What is the purpose of a limine? I
21 guess you help me out because the Court has been doing this
22 for a long time.

23 You raised, they got four, you got three.
24 Actually, I mean, I thought the whole purpose of having
25 motions in limine was so that you would tee up these

1 issues.

2 MR. DiGIOVANNI: It is, Your Honor, and we
3 think it helps the Court, and I sometimes struggle with the
4 fact that the Courts limit us to do that, because to me it's
5 helpful to the Court, even if we did 15 of them. It seems
6 like that would be helpful. If we only get three, let's say
7 we have those other 12, what are we going to do? We're
8 going to object at trial and then we'll have to deal with it
9 then. That's neither here nor there, Your Honor. But what
10 I would say is, anything in anybody's expert report, the
11 expert has to be bound by their expert report.

12 We didn't move on, hey, they shouldn't be able
13 to talk about issue five that maybe they'll raise, or maybe
14 they won't. No. We're just going to use the expert report
15 as our motion in limine at trial. You know, as our
16 evidentiary.

17 THE COURT: Yes. That's okay. That's fair
18 enough.

19 MR. DiGIOVANNI: Yes. That was my point, Your
20 Honor. I guess I will suggest this, Your Honor.

21 THE COURT: No. Actually, it's a fair point.
22 Frankly, I thought about the plaintiff got four motions in
23 limine, you got three, and I mean, frankly, you could raise
24 it at trial, and so maybe I ought to decide it now when I
25 have some time, I suppose, as opposed to on the fly in front

1 of the jury. But I mean, on the other hand, if you are
2 going to file a motion in limine, why not -- all right.

3 So then let's deal with this aeration issue.
4 Mr. Chambers?

5 MR. CHAMBERS: This is how I think I can
6 shortcut it, Your Honor. The 2015 aeration was in Dr.
7 Maynes' opening report, so that addresses that question.

8 They came back and they said, oh, this is
9 unprofessional of you because you were not personally there
10 to witness the experiment. You just took the experiment and
11 looked at it.

12 THE COURT: Right. I got it.

13 MR. CHAMBERS: Okay. So as long as we were
14 doing all the visual stuff, we reran the experiment in
15 January, and he was personally there and reran the exact
16 same experiment and got exactly the same results, period.

17 THE COURT: All right.

18 MR. CHAMBERS: That's all there is to it.

19 THE COURT: Now, so let's continue with Mr.
20 Chambers for a minute if you don't mind.

21 When did you disclose the 2015 testing? The
22 first time was in the expert report. Right?

23 MR. CHAMBERS: In his expert report.

24 THE COURT: What took you so long?

25 MR. CHAMBERS: By the way, we did have the bogus

1 testimony which they refer to and the, I guess it's the
2 interrogatory response where we alluded to it. I considered
3 it attorney work product until I showed it to Dr. Maynes
4 before his opening report and said, take a look at this. Do
5 you think it ought to be included in your opening report,
6 and it's only when he looked at it and said, yes, I think it
7 should be included in my opening report.

8 And I will mention one other thing, and this is,
9 you know, here's a letter that they wrote to us, and this is
10 actually the reason we -- the reason we did the test. But
11 they said that their expert, Dr. Slocum, which is 2015, had
12 done his own aeration test, and that they had found no
13 aeration.

14 I don't think we've ever gotten a copy of those
15 reports, but we're not making a big stink about that.
16 Actually, if we can go ahead and put in our evidence, we're
17 not going to try to do another in limine motion on that
18 stuff.

19 THE COURT: All right. So would the defense
20 prefer -- I mean, look. You may come up.

21 So don't parties all the time make a decision
22 after they retain the expert, towards the end of discovery,
23 whether they want to go and rely on certain testing,
24 and it's at that point they would have to disclose it.
25 Right?

1 MS. SILVERSTEIN: I would disagree. I mean, we
2 just, we had our expert do his own test and we disclosed it.
3 We didn't have --

4 THE COURT: You disclosed every single test
5 that you guys -- what is the date of the letter, Mr.
6 Chambers?

7 MR. CHAMBERS: Yes, Your Honor. The letter is
8 from Mr. Schlitz at the Baker Botts firm, June 17, 2015.

9 THE COURT: All right. There must have been
10 testing done prior to that. Has that been disclosed?

11 MS. SILVERSTEIN: No, because we're not relying
12 on it.

13 THE COURT: Okay. And that's fair. And I think
14 the point was the plaintiffs weren't going to rely on it.
15 They didn't make the decision to rely on it until they went
16 forward with their expert report.

17 MS. SILVERSTEIN: I would argue that that is an
18 improper use of privileged material, a sword and a shield.
19 I mean, it's just like, for instance, with willfulness. We
20 had to make a decision during fact discovery if we were
21 going to rely on opinions of counsel.

22 THE COURT: You agree that they at least
23 reference, they asserted the attorney/client privilege and
24 work product in response to interrogatory number 10. Is
25 that correct?

1 MS. SILVERSTEIN: Correct.

2 THE COURT: All right. Did you file a motion to
3 compel?

4 MS. SILVERSTEIN: No, we didn't.

5 THE COURT: Did you ask to get a privilege log
6 for it?

7 MS. SILVERSTEIN: No.

8 THE COURT: Okay. So under those circumstances,
9 even where we are and the fact that it's 4:00 o'clock, I
10 have to make discretionary decisions. What I'm going to do
11 is -- would you prefer to have the 2015 test on aeration or
12 the 2019 test on aeration?

13 MR. DiGIOVANNI: Do we have to make that
14 decision today, Your Honor?

15 THE COURT: No.

16 MR. DiGIOVANNI: Okay.

17 THE COURT: But then what I'm going to do is,
18 I'm going to let them choose. Okay? They are going to get
19 to pick -- the 2019 grinding and shaving test comes in
20 because of inadequate disclosures by the defendants in
21 response through the course of discovery such that it was
22 fair, it seems to me, to allow Dr. Maynes to conduct the
23 January 2019 test. All right.

24 As far as the 2015 test for grinding and shaving
25 or anything else, it's not admissible. On aeration, the

1 defendants will get to choose whether to bring in the 2015
2 test conducted by the employees, relied upon by Dr. Maynes,
3 or Dr. Maynes' 2019 test. Is that fair?

4 MS. SILVERSTEIN: I just want to -- just
5 clarification. Did you say everything other than aeration
6 and the grinding and shaving is out, or --

7 MR. CHAMBERS: No.

8 THE COURT: No, no, no.

9 MS. SILVERSTEIN: Okay.

10 THE COURT: So they get to bring in -- how do
11 you want to characterize it? We've got the grinding and
12 shaving and then we have the aeration.

13 MR. CHAMBERS: I think we described it earlier
14 is what was in his declaration. He also responded to Dr.
15 Slocum, where he said there's no cross-sectional profile for
16 the first time in the rebuttal and summary judgment.

17 THE COURT: All right. So I don't remember this
18 from the papers, but you didn't move --

19 MR. CHAMBERS: Right.

20 THE COURT: Is that true? Did Slocum raise for
21 the first time some things he's responding to?

22 MS. SILVERSTEIN: That was Dr. Slocum's first
23 report, so he wouldn't have had a chance to raise it before
24 then.

25 THE COURT: I guess Judge Sleet didn't allow a

1 reply report. What happened? Is that what it is?

2 MS. SILVERSTEIN: Yes. There was an opening
3 report and a rebuttal report.

4 THE COURT: This is the challenges of inheriting
5 a case, so --

6 MS. SILVERSTEIN: These three things are
7 infringement issues that Dr. Maynes did address in his first
8 report. I mean, the weight of splash shield, he said the
9 splash shield assembly is 3.74 pounds in his first report.
10 Now he does a second report months later and finds that it's
11 heavier and closer to five pounds.

12 THE COURT: Aren't you going to just decimate
13 him on cross-examination at that point?

14 MS. SILVERSTEIN: We could, but we would prefer
15 to get summary judgment of noninfringement.

16 THE COURT: We're talking about a motion in
17 limine for trial.

18 MS. SILVERSTEIN: Right. But this is one of our
19 summary judgment points as well.

20 THE COURT: When we get to summary judgment,
21 we'll deal with it.

22 MS. SILVERSTEIN: Okay.

23 THE COURT: We're just talking about the motion
24 in limine right now.

25 MS. SILVERSTEIN: Well, to the second point

1 about friction, the first time in his report he acknowledges
2 there's friction, and in 2019, he all of a sudden has some
3 sort of calculation he's performing to determine the amount
4 of friction and whether it's negligible or not. The same
5 thing on cross-sectional profile. He references it in his
6 report because it's part of the infringement report, it has
7 to be, but in that report, he's just doing a visual
8 comparison of prior art, and then all of a sudden 2019 comes
9 around and now he has a self-deletion.

10 MR. CHAMBERS: Your Honor, as counsel has
11 mentioned a number of times, what Dr. Maynes is doing in
12 addition to being responsive to new issues raised is
13 elaborating on positions he has already taken, and to the
14 extent he mentions infringement, I can get the part in his
15 expert report, but he says that that's not a basis for
16 noninfringement. And then he actually pulled the -- their
17 prop up and down and then dropped it, and therefore he felt
18 discernible friction. This is all consistent with what
19 they've been on notice of since his opening report. There's
20 no surprises, no prejudice.

21 MS. SILVERSTEIN: We weren't able to depose him
22 about these new calculations he has. Those were not part of
23 his first report.

24 THE COURT: Mr. Smith, how did Judge Sleet
25 handle the situations when new -- because he did not allow

1 for reply briefs as a general rule. Is that correct?

2 MR. SMITH: Your Honor, he would typically get
3 to a question of prejudice and how to best alleviate the
4 prejudice. It would come up in front of Judge Robinson as
5 well.

6 One solution here that I would have seen Judge
7 Robinson handle would be to treat the 2019 declaration as a
8 supplemental expert report, a reply report, if you will,
9 however you wanted to think of it in trying to meld the two
10 scheduling order-type regime and alleviate the prejudice
11 with a short deposition of Dr. Maynes, if appropriate, and
12 go forward that way.

13 Indeed, at some point Judge Robinson eliminated
14 all Daubert motions. You couldn't file a Daubert motion
15 unless you came and talked to her in part because she
16 understood that a lot of this was just about prejudice and
17 about how to alleviate the prejudice, not what to strike and
18 what not to strike.

19 So I think -- I don't know if I've answered your
20 question, Your Honor, but I think it's a question of
21 alleviating the prejudice. They've been on notice now for
22 three months of this testing. It has been vetted through
23 the summary judgment process, and if there's some issue
24 about not having cross-examined the expert, a short hour or
25 two deposition in advance of trial may cure whatever

1 prejudice might remain.

2 THE COURT: Mr. DiGiovanni?

3 MR. DiGIOVANNI: I am not going to dispute
4 anything that Mr. Smith said except for the fact that we're
5 18 days from trial. In the ordinary case, if Dr. Maynes or
6 plaintiffs had seen something in Dr. Slocum's
7 noninfringement report or elsewhere at that point, that's
8 when you move for supplemental -- a meet and confer. We
9 want to file a short supplemental expert report or maybe
10 move if we say no --

11 THE COURT: That didn't happen here.

12 MR. DiGIOVANNI: Didn't happen here.

13 THE COURT: Why?

14 MR. DiGIOVANNI: They didn't ask to have Mr.
15 Maynes do additional testing. They didn't do that. They
16 didn't do that.

17 THE COURT: Wait. You found out about it?

18 MR. DiGIOVANNI: Summary judgment. I'm talking
19 about the 2019 testing. So, you know, Dr. Maynes has this
20 test report that he did really three months ago, or four
21 months ago, in January -- three months ago, where he says,
22 it looks like a scientific report. It says, here are the
23 experiments I conducted. Number one, is the weight of
24 splash shield -- he has five different points that should
25 have been done during expert discovery.

1 If their point is, hey, we didn't know Dr.
2 Slocum was going to raise these things, you asked for a
3 supplemental expert report at that time, and if we say no,
4 he moves the Court, or perhaps you would have said you could
5 do a short one. Whatever, that would have been the time to
6 do this, and he could have been deposed on it.

7 Now we're 18 days from trial. We've got these
8 tests. Perhaps it would be good cross at trial if we were
9 prepared for it, but we're now 18 days from trial and this
10 is what we have.

11 THE COURT: Right. You have to understand,
12 right, I came into this hearing reading up on grinding
13 and shaving, so now the problem is, we've got 18 days and
14 I'm just being bombarded by all of this information right
15 now.

16 MR. DiGIOVANNI: Understood.

17 THE COURT: I have no idea how it all fits in.

18 MR. CHAMBERS: Your Honor, I will mention very
19 quickly, they did submit an expert declaration with their
20 summary judgment motion. We have not tried to exclude that,
21 but what's fair for fish is fair for foul, and it seems
22 unfair, I will try to put it mildly, for them to say, okay.
23 We can get to submit a new expert declaration after all the
24 reports with lots of stuff for our case, but you don't get
25 to respond to it in your opposition.

1 MR. DiGIOVANNI: Your Honor, I would challenge
2 them to tell me anything in that new expert declaration by
3 Dr. Slocum that's not in his expert report.

4 We did what you are supposed to do. We confined
5 his summary judgment declaration to what was in his expert
6 report, things that he was deposed on. We did not go beyond
7 that.

8 MR. CHAMBERS: Why do you need a declaration in
9 the first place?

10 THE COURT: Okay. Mr. Chambers --

11 MR. CHAMBERS: Okay.

12 THE COURT: Just direct your comments to me
13 instead of to other counsel.

14 So what is the question that you would like
15 maybe me to put to counsel or at least to consider?

16 MR. CHAMBERS: Thank you, Your Honor. I will
17 try not to belabor this, but they are saying, oh, it was the
18 same thing in the expert report. We didn't say anything
19 further. That was one sentence where he said, yes, I
20 reaffirmed my expert report, and then he goes on for another
21 15 pages. So the comment doesn't make any sense.

22 THE COURT: Do you know one fact or one opinion
23 that he puts forth in his declaration that's not within the
24 scope of his expert report?

25 MR. CHAMBERS: Yes. Could I have a few minutes

1 to look through it?

2 THE COURT: Yes. All right. We've been doing
3 this for three hours. Why don't we take a 15-minute break.
4 We'll come back at 4:25. The pretrial was supposed to start
5 at 4:00. Correct?

6 MR. DiGIOVANNI: According to the docket, yes.

7 THE COURT: We're short on time. All right.

8 (Short recess taken.)

9 - - -

10 (Proceedings resumed after the short recess.)

11 THE COURT: All right. Please be seated.

12 All right. Does anyone want to say anything
13 else about the last motion?

14 MR. CHAMBERS: Your Honor, very quickly. I
15 don't have Dr. Slocum's rebuttal report, so I was not able
16 to do the comparison.

17 MR. DiGIOVANNI: In the event Your Honor is
18 considering a supplemental deposition as suggested by --

19 THE COURT: Here's what I'm going to do. I'm
20 going to -- just whoever has this before the Federal
21 Circuit, please reference this. I inherited this case. It
22 has been going on for years. I inherited the scheduling
23 order. I inherited the procedures and the parties briefed
24 this last motion.

25 They didn't mention anything in the motion other

1 than grinding and shaving with respect to the 2019 test, and
2 so that was the issue before me. So I've already explained
3 that I do think -- I think both sides here did not represent
4 the best in our profession in terms of their disclosures
5 during discovery, and that's unfortunate, and that I also
6 inherited that situation.

7 And so in light of all of those circumstances,
8 what I'm going to do is, I'm going to grant the motion --
9 sorry. I'm going to deny the motion in limine with respect
10 to the 2019 testing on grinding and shaving. That's the
11 scope of the motion, and as I've explained, I think that
12 there were inadequate disclosures during the course of
13 discovery that necessitated from the plaintiffs' perspective
14 the need to conduct this testing. I am going to, however,
15 grant the motion with respect to the 2015 testing, and it
16 sounds like, to a certain extent, the motion has been
17 rendered moot anyway on that.

18 And then as far as the other aspects of the 2019
19 report, we'll just take it as it arises at trial. We'll
20 have to address it.

21 So that's the world I inherit and that's the
22 world I'm going to give. All right.

23 Now, I guess we should go to summary judgment
24 then. Mr. Smith?

25 MR. SMITH: Your Honor, Mr. DiGiovanni and I

1 spoke at the break. We're obviously here at your disposal
2 to present argument on whatever motions you think are most
3 appropriate or necessary for Your Honor to consider today,
4 so we leave it to your discretion both as how long you would
5 like us to present argument and if there are particular
6 issues on which you would prefer.

7 THE COURT: All right. Thanks. I appreciate
8 that.

9 So one of the -- you know, I did not get through
10 the summary judgment briefing as much as I would otherwise
11 like, but I think I will point out why.

12 You can have a seat, Mr. Smith.

13 I know you're one of the first cases, in fact, I
14 think you are the first that adopted the procedures I put in
15 place about summary judgment. The concise statement of
16 facts in this case was not what I had envisioned, and other
17 parties actually have briefed these summary judgments along
18 the way I did, and so let's walk through that. And the
19 reason why I say that is because that may influence kind of
20 how we do the argument. All right.

21 So let's start with the plaintiffs' motion and
22 let's look at the concise statement of facts.

23 The whole point of having this concise statement
24 of facts was because, the idea was I would get right to the
25 heart of the dispute and find out whether we had to dive

1 into the legal issues.

2 Now, the plaintiffs' concise statement of facts
3 is basically just a recitation of the elements of the
4 patent. So, you know, for instance, fact number -- well,
5 let me just pull up the plaintiffs' response and we'll go
6 through it. Sorry. One minute.

7 Okay. So I'm comparing now 171, DI 171, and
8 then I guess we could just go right to DI 197.

9 Mr. DiGiovanni?

10 MR. DiGIOVANNI: We corrected one statement. We
11 noticed an error.

12 THE COURT: Okay.

13 MR. DiGIOVANNI: It was our response to
14 plaintiffs' statement of fact number 18.

15 THE COURT: Okay. Well, we'll get to that.
16 Good to know.

17 MR. DiGIOVANNI: All right.

18 THE COURT: All right. So just then, especially
19 for those who appear before me in the future and for the
20 number of people who will a lot, what I envisioned with this
21 was the facts not, any legal argument. So, and -- or legal
22 conclusions, in other words, another way of stating it.

23 So fact number one is a fact. Hamilton Beach
24 demonstrated the accused and then the four products -- I'm
25 not even sure what that means. It demonstrated the accused

1 products in the United States. That's right. So it
2 demonstrated them. Okay. And that's admitted. That's
3 good.

4 All right. The next fact. Hamilton Beach
5 engineers testified that demonstrations of the accused
6 products by Hamilton Beach included performing, and then the
7 following steps are going to follow. To me, the fact is
8 that they demonstrated it, not that they testified at trial,
9 and then you would put in to support it the testimony in the
10 record. And then the flip side would be then, the
11 respondent would put in the record citations facts that
12 contradicted that if it was disputed.

13 So here, I'm not really sure how to read this
14 box, but -- and then the numbers get off. If I look at box
15 number, what's labeled box number two is a method for
16 rinsing a splash shield.

17 Now, how does that line up with what the
18 plaintiffs have? In other words, what's going on is the
19 plaintiffs -- there's an unnumbered box that is in the
20 plaintiffs' concise statement, but I think that the
21 defendants, their box number two was responding to that
22 unnumbered box. Is that right?

23 MR. SMITH: That's how I would read it, Your
24 Honor.

25 THE COURT: All right.

1 MR. FOSTER: It appears so, Your Honor.

2 THE COURT: All right. Anyway, that seems okay.
3 I'm all right with it.

4 So then I will go to plaintiffs' box number
5 three -- sorry, plaintiffs' box number two, which is a
6 method for rinsing a splash shield on a mixing machine.

7 And do I understand correctly that the defendant
8 admits that?

9 MR. FOSTER: I do see where the numbering is
10 off, Your Honor, so just give me a second.

11 THE COURT: Yes. I just want to make sure, so
12 that's why I'm asking.

13 MR. FOSTER: Right. Okay. It appears, Your
14 Honor, we took their unnumbered boxes, kind of a preamble
15 that applied to 2, 3, 4, 6 and 7, and then our numbers do
16 match up. So our two matches with their number two. That
17 un-numbered one we took to apply to all of the --

18 THE COURT: Okay. So then you just skipped over
19 their unnumbered box. So your number two you're saying,
20 which reads, disputed. No Hamilton Beach engineers
21 testified that any accused products perform each and every
22 step.

23 You are saying that's in response to box number
24 two by plaintiffs, that the engineers testified that the
25 demonstrations included a method for rinsing a splash shield

1 on a mixing machine?

2 MR. FOSTER: Yes. Structurally, that is
3 correct, Your Honor.

4 THE COURT: Well, how is it responsive to say
5 it's disputed that no Hamilton engineer testified that each
6 and every claim, each and every step is even in the -- is
7 performed?

8 MR. FOSTER: Okay. I misspoke then, Your Honor.
9 Our two response is their unnumbered plus two. So they
10 didn't number it 1A or 1B, whatever you call it. We didn't
11 respond to that except that our box 2 is intended to respond
12 to their box 2 and what is above it, in 1A.

13 THE COURT: Okay. All right. So you admit that
14 their demonstration included performing or concluded --
15 included providing a vessel containing material to be mixed,
16 the vessel having an opening?

17 MR. FOSTER: That's correct.

18 THE COURT: That's admitted?

19 MR. FOSTER: Correct, Your Honor.

20 THE COURT: Okay. Now I got it. And then you
21 admit 4, that it provides a mixing machine having a holder
22 for receiving the vessel. You admit that, too.

23 MR. FOSTER: That is correct, Your Honor. And,
24 again, this is for the demonstration only, not for
25 customers. That's what the preamble box talks about, the

1 demonstration.

2 THE COURT: Right. I mean, that's the thing.

3 And actually, it really is just that their engineers
4 testified that the demonstrations involved it.

5 MR. FOSTER: That's the way it reads.

6 THE COURT: Yes. I mean, because it was set up
7 like this, I don't even know if it's helpful for me to go
8 through these facts.

9 MR. CHAMBERS: Your Honor, I think we can get
10 right to the bottom line very quickly. There's only one
11 element that is in dispute and defendants can say otherwise
12 if they want to.

13 I think the only issue is the word "while" in
14 this claim, which, and we'll put up a slide on this if you
15 would like, which in our view is a claim construction issue.
16 There's no dispute about what the device does.

17 THE COURT: So this is the problem, you see, and
18 this is why I want you to know. That's why I have not
19 delved into your briefs, because the whole system that I
20 have instituted is set up that we have these concise
21 statements of facts, and I'm only getting to the briefs if
22 there's undisputed facts as demonstrated by the concise
23 statement of facts.

24 Do you get that?

25 MR. CHAMBERS: I do.

1 THE COURT: All right.

2 MR. CHAMBERS: I get that.

3 THE COURT: And one thing I could do is, I could
4 just strike everything and say it didn't comply with the
5 rules. I don't want to waste people's time, but you
6 understand this is what I've been going through, trying to
7 figure out what all of this means.

8 I mean, if what you say is true, your concise
9 statement of facts should say that BIC2000 has or involves
10 when it's used a method for rinsing a splash shield, and
11 then they would tell me whether that's disputed or not and I
12 would know that.

13 MR. CHAMBERS: I think we didn't format it as
14 well as we could have, Your Honor, but the issue is a very
15 simple one. There's no factual dispute about how it works
16 and the structural components. The issue is claim
17 construction, and that's not an issue that should go to the
18 jury.

19 THE COURT: Well, I'm going to guess the
20 defendants don't agree with that, or maybe they do.

21 MR. FOSTER: Most certainly don't agree. I will
22 say this, Your Honor. When we were formulating these, I
23 don't think -- at least I didn't understand it was kind of a
24 gateway. We understood it was important. Your order said
25 to focus on it, so we did. We did go find what we did in

1 the District of Hawaii to see how they did it.

2 THE COURT: I'm not reading a summary judgment
3 brief unless I get through the concise statement of facts
4 which demonstrate there's undisputed facts, because that's
5 the whole point of it. And I get, you know. I didn't give
6 an exposition when I implemented it, but that is the whole
7 point of the procedure, and it has worked in other cases
8 incidentally. So, you know, I'm not used to having oral
9 argument when I'm not prepped. And so to your point,
10 Mr. Smith, I'm just trying to figure out what's the best
11 thing to do.

12 MR. SMITH: Your Honor, I don't know how much
13 time you're interested in devoting. There may be certain
14 issues like this while issue that would be discrete. I'm
15 not sure that's one we would pick necessarily.

16 THE COURT: Right.

17 MR. SMITH: Pick at least one motion or two
18 motions that we think you would most benefit from. I don't
19 think, but I don't mean to speak for Your Honor, obviously.
20 I don't know the 12 issues or whatever there are embedded in
21 the summary judgment motion practice here that's going to
22 benefit everybody, especially for Your Honor to march motion
23 by motion.

24 THE COURT: I said I didn't read them, but I did
25 skim. It struck me on the plaintiffs' side at least, the

1 first two are the most potentially fruitful for the
2 plaintiff if I bought it, if I bought their arguments,
3 rather, which is basically, as I understand it, those are
4 the two arguments where the defense is trying to relitigate
5 claim construction.

6 All right. So why don't we at least deal with
7 those two issues. Can you do your argument in about ten
8 minutes on that?

9 MR. CHAMBERS: I think I can. I should be able
10 to do another one in 30 seconds.

11 THE COURT: All right.

12 MR. CHAMBERS: Which is the public use. They
13 said that there was a showing of an animation at a trade
14 show.

15 THE COURT: All right. Do those quickly. Let's
16 go.

17 MR. CHAMBERS: Okay. Well, is there any dispute
18 about that anymore that the animation was not shown at the
19 trade show? I think the answer is no.

20 THE COURT: Mr. Chambers --

21 MR. CHAMBERS: Sorry, Your Honor.

22 THE COURT: You can ask me and I will ask them.

23 MR. CHAMBERS: Your Honor, I would like to find
24 out from defendants if there was any dispute about the
25 public use on the animation.

1 THE COURT: Mr. DiGiovanni or Mr. Foster?

2 MR. FOSTER: Yes, Your Honor. There's a video
3 that was created. He testified that he had intended to show
4 it to customers. There was a dispute about whether or not
5 Fed-Ex went to him at the trade show, but our public use
6 isn't limited to that particular fact. And Mr. Farrell's
7 testimony will see where that goes and the jury can balance
8 his credibility.

9 MR. CHAMBERS: Okay.

10 THE COURT: I don't even understand. Sorry.
11 Sorry.

12 MR. FOSTER: Your Honor, Mr. Farrell paid to
13 have a video created by the design company that helped them
14 develop the blender. This video he was creating with an eye
15 of showing it at a convenience store trade show about a year
16 and a month before the filing date of the '150 patent
17 family.

18 There's some testimony that shows that a Fed-Ex
19 package with a video didn't get to Mr. Farrell, but he
20 admitted he had the video before, before the priority date,
21 and he was trying to show it to customers. So that's the
22 evidence right now.

23 So I don't know if it was at the NACS show or
24 where, and we had evidence that he was in discussions with
25 QuikTrip, which ultimately led to a sale.

1 THE COURT: What is the difference in what Mr.
2 Chambers is saying? He's asking whether there was a
3 demonstration at a trade show?

4 MR. FOSTER: Yes. He's asking if we're
5 asserting there was a demonstration specifically at a trade
6 show in Orlando October 6th, 2002, and I think our
7 allegation is he was trying to show the video.

8 THE COURT: Not that he actually did show it?

9 MR. FOSTER: It's not clear.

10 THE COURT: Okay.

11 MR. FLYNN: Your Honor, if I may, I mean, this
12 is one of those where I think there's a fact here. If you
13 look at our number 32 on the undisputed facts, we say, an
14 animated video of a blender created by Kablooe was not shown
15 to anyone at the NACS show in October 2002. Their response,
16 admitted.

17 THE COURT: Yes.

18 MR. FLYNN: That's the entirety of their public
19 use defense.

20 THE COURT: This is part of the problem. I
21 didn't know whether that meant 32 or 33, although I guess 33
22 is admitted, too.

23 MR. FLYNN: They admitted all of our facts.

24 THE COURT: Okay.

25 MR. FLYNN: They didn't respond. In the summary

1 judgment, they offered no opposition on the public use.

2 THE COURT: Well, I will hear brief argument on
3 it although, Mr. Foster, it sounds like you did admit it in
4 your paper.

5 MR. FOSTER: Your Honor, specifically we didn't
6 have the evidence to counter that it was specifically shown
7 at the NACS show. I think our papers, we don't talk about
8 it.

9 THE COURT: All right. Well, then, if you
10 didn't talk about it, plaintiffs will win on summary
11 judgment.

12 MR. FOSTER: At least that particular part of
13 it.

14 THE COURT: Both sides, let's just cut to the
15 heart of things. I should grant summary judgment on that.
16 Right?

17 MR. CHAMBERS: Bingo.

18 MR. FOSTER: No, Your Honor. The record shows
19 Mr. Farrell was in constant discussions with QuikTrip from
20 2001 on about a self-rinsing blender, and we would argue
21 even though there was some sort of offer for sale or public
22 use during discussions, they even had mockups done of the
23 proposed blenders put in the store in 2002.

24 THE COURT: Is that in your brief?

25 MR. FOSTER: Yes.

1 THE COURT: Okay. Sorry.

2 MR. FOSTER: So it's different than --

3 MR. FLYNN: Your Honor, I didn't see any
4 opposition to our public use summary judgment in their
5 opposition.

6 THE COURT: I will look for it. I will look for
7 it.

8 MR. FLYNN: Again, this goes back to the
9 contentions. The only contention they ever had about public
10 use, Mr. Farrell showed a video at the NACS conference in
11 2002. That's it. That's all we ever knew. That comes from
12 their counterclaims, comes from their invalidity
13 contentions. That's all that was explored in discovery even
14 if we could cobble what we're supposed to understand what
15 their contentions to be from depositions. Now we do a
16 summary judgment on it. They admit, yes, video never shown,
17 never arrived. Mr. Farrell couldn't have shown it to
18 anybody. They didn't oppose and now we don't get summary
19 judgment on their public use defense?

20 THE COURT: Well, look, if it's as you say,
21 you're going to get it. I'll go read it.

22 MR. FLYNN: Your Honor, can I hand up copies?

23 THE COURT: Yes, please.

24 (Mr. Flynn handed slides to the Court.)

25 MR. CHAMBERS: All right, Your Honor. Let me go

1 to infringement, summary judgment, which we submit are both
2 claim construction issues.

3 So one of them is this claim 21 of the '662
4 patent. That's the claim that went all the way through the
5 trial at the PTAB and then all the way to the Federal
6 Circuit, so that has been thoroughly vetted on validity.

7 Here is the claim --

8 THE COURT: You are like a dog with a bone.
9 Okay.

10 MR. CHAMBERS: Yes. I enjoy saying that.

11 Here's all the elements of the claim, and the --
12 I think Dr. Slocum on the admissions, Dr. Slocum admitted to
13 everything. The only one they address in their opposition
14 that they're disputing is the last element here, directing
15 rinsing fluid onto the splash shield using the nozzle while
16 isolating the vessel from the rinsing fluid. So this is the
17 only one that they are disputing that I could see.

18 And so how does it work? There's no factual
19 dispute about how they operate. The cup must be removed
20 from the blender before rinse fluid is directed onto the
21 splash shield. So while the cup is isolated from the rinse
22 fluid, rinse fluid is directed onto the splash shield using
23 the rinse nozzle. Dr. Slocum said at his deposition, so I
24 guess you could call that it's isolated because there's no
25 way the water is going to get to the cup, because it's in my

1 hand.

2 So it's undisputed that is how it works. In
3 other words, everybody agrees, the traffic light is red. So
4 what do you do about it with the law?

5 Okay. The only dispute is the reargument of
6 this word while, and at the Markman hearing, defendants
7 argued, and they also argued in their Markman briefs that
8 while precludes physical removal of the cup from the
9 blender. They said, the term, again, the term while is
10 there. We said, at the same time, shielding the vessel
11 providing to the mixing machine to rinse from the fluid.
12 What the plaintiffs are trying to do is trying to read
13 the claim on to someone making their drink, taking the cup,
14 walking into their car, and then rinsing occurs. That is
15 right. That's exactly the way the claim reads. Okay.

16 So this was the Markman presentation to Judge
17 Sleet and this is what they argued in their briefs and at
18 the hearing. So this is what Judge Sleet decided.

19 He rejected their interpretation and pointed to
20 the specification and said, the cup may then be removed from
21 the drink machine in his claim interpretation after blending
22 as a way of isolating it from the rinsing fluid.

23 So he went for the -- our proposed construction,
24 and cited to this, and said, no. I reject your while
25 argument. Look in the specification. That supports

1 taking the cup in your hand and removing it from the drink
2 machine. So we have a claim construction dispute that has
3 been resolved by Judge Sleet and that is all there is to it,
4 really. It's pretty simple.

5 THE COURT: All right. You're done. That's
6 good. Let's hear from the defense.

7 MR. DiGIOVANNI: Looking for the clicker, Your
8 Honor Your Honor. Sorry.

9 I have a series of slides, Your Honor. You
10 know, I will tell you, to be honest, I have 18 slides, 17
11 slides. Let me go to the one slide that does address very
12 directly claim construction.

13 So, Your Honor, I need to go to the claim. So,
14 first of all, Judge Sleet did not reject defendants'
15 arguments regarding the while. That didn't happen. Judge
16 Sleet ruled that it should be the plain and ordinary meaning
17 of the phrase direct rinsing fluid onto the splash shield
18 using the nozzle while isolating the vessel from the rinsing
19 fluid.

20 So for the term while in there, and that's a
21 necessary term, it's the plain and ordinary meaning of
22 while, which is at the same time. Just as, this is a method
23 claim, every step --

24 THE COURT: So, wait, wait.

25 MR. DiGIOVANNI: Sure.

1 THE COURT: Is Sleet's ruling in the appendix?

2 MR. DiGIOVANNI: I have it in the slide.

3 THE COURT: Okay.

4 MR. DiGIOVANNI: The very next slide. So here's
5 Judge Sleet's claim construction order.

6 THE COURT: Okay.

7 MR. DiGIOVANNI: The term while isolating the
8 vessel from the rinsing fluid is construed to have its plain
9 and ordinary meaning.

10 THE COURT: Right. What did you guys ask to
11 have it construed as?

12 MR. DiGIOVANNI: What we asked for was that the
13 term be given a meaning that required shielding. Okay.
14 That required an actual trap door mechanism or something
15 that actually physically shielded.

16 THE COURT: All right. Do you have what you
17 asked for up here?

18 MR. DiGIOVANNI: I don't.

19 THE COURT: Mr. Chambers, was it on your slide?

20 MR. CHAMBERS: Well, you see the footnote there,
21 Your Honor, number five.

22 THE COURT: Yes.

23 MR. CHAMBERS: That's the other thing you need
24 to read.

25 THE COURT: Okay. All right.

1 MR. DiGIOVANNI: But the judge does not address
2 in the claim construction the term while. He recognizes
3 that we -- our construction would have had the word, would
4 have had the word while in it, but he doesn't address it.

5 THE COURT: What is footnote five? Can you
6 remind me?

7 MR. FLYNN: If you switch back to plaintiff for
8 a second.

9 MR. DiGIOVANNI: Sure.

10 THE COURT: All right.

11 MR. CHAMBERS: Here's a pertinent part --

12 THE COURT: Mr. Chambers, you can have a seat.
13 All right.

14 So footnote five. Do that begin with the Court
15 is guided by the following specification language?

16 MR. DiGIOVANNI: That's not the entire footnote,
17 Your Honor. I can read it, Your Honor. It's DI 83. The
18 Court says, the Court finds no need to define the term while
19 isolating the vessel from the rinsing fluid because the term
20 should be given its plain and ordinary meaning.

21 THE COURT: Right. I'm listening.

22 MR. DiGIOVANNI: Okay. And then it quotes
23 Phillips, the Phillips case. I can skip that, I think.

24 And then the Court says, the Court is guided by
25 the following specification language.

1 THE COURT: Right.

2 MR. DiGIOVANNI: That's what we see up here.

3 THE COURT: Okay.

4 MR. DiGIOVANNI: Okay. And then the Court says
5 after that, defendants' construction improperly introduces
6 the word shielding as a negative limitation by arguing that
7 a barrier or door must shield. But the Court will not read
8 those into this term.

9 So as I said, the Court did not reject plain and
10 ordinary meaning. In fact, adopted the plain and ordinary
11 meaning, but rejected this affirmative negative limitation
12 that we did ask for for a barrier or a door. So we're left
13 with plain and ordinary meaning. And what they are doing as
14 claim construction -- and I have a slide to show that, Your
15 Honor. You know, it was No. 16. 16.

16 So this is an excerpt of their brief. So this
17 is their summary judgment reply brief. They really -- this
18 is a real tell here, Your Honor, because here's what they
19 say. They say, defendants argue that the word while in the
20 isolating step requires that the initial action to isolate
21 the cup take place at the same time as the rinsing.

22 Yes, we're arguing plain and ordinary meaning.
23 We are arguing that the word while has its plain and
24 ordinary meaning, because that's what the judge told us to
25 do. We have to do that. But here's what they did. Then

1 they go into the specification. They say, oh, no, that's
2 not right. Look what the specification says.

3 That's claim construction. They're the ones who
4 are looking to, instead of import the plain and ordinary
5 meaning of while, which is at the same time, no one disputes
6 that that's the plain and ordinary meaning of the word
7 while. They are the ones who are saying, oh, no. You have
8 to go to the specification to really see what that means.
9 That's claim construction. They are doing that.

10 We are going with plain and ordinary meaning.
11 You know, it's true that in Dr. Slocum's expert report, he
12 does provide some bases on alternative constructions,
13 because we had a motion for reconsideration pending, but
14 that's behind us. He does, Dr. Slocum gives an opinion on
15 when he uses the plain and ordinary meaning of while, which
16 is at the same time, and he applies the claim to the accused
17 product and he says, yes. It doesn't happen. It requires
18 the rinsing step, active step to occur while this active
19 isolating step occurs. And Dr. Slocum explains, that just
20 doesn't happen in our products.

21 And this is another tell here, Your Honor. I
22 have a number of these that are tells. Why don't we go back
23 to slide -- go to slide seven, please.

24 So this is from their brief. You read their
25 paraphrase -- you read their paraphrase of the claim.

1 Instead of while, they have after. That's not while.
2 That's the opposite of while. So they're reading while out.
3 They are doing what they can to read while out of it.

4 THE COURT: All right. You've made a valid
5 point. Do you have anything else on it?

6 MR. DiGIOVANNI: I mean, yes.

7 THE COURT: Keep going. I just want to hear
8 from the other side on this point, so go ahead.

9 MR. DiGIOVANNI: Your Honor, I don't know if
10 there's anything I could add other than, to the core point
11 here except that, you know, another way they sort of -- they
12 sort of avoid while is they use the phrase isolated, a past
13 tense thing. Again, they're missing the point of rinsing or
14 isolating while rinsing. Instead they either hide while,
15 they don't use it. I don't mean to say that in the bad
16 sense of hiding it, but they avoid the word while. They use
17 the word after, or they use the past tense isolated, and
18 they -- we are using the plain and ordinary meaning of
19 while.

20 THE COURT: Hold on. Okay.

21 MR. DiGIOVANNI: Your Honor, those are the core
22 points. Do you have anything else for me, Your Honor?

23 THE COURT: Well, why don't I just follow up.

24 MR. DiGIOVANNI: Sure.

25 THE COURT: So demonstrate to me, how are you --

1 Judge Sleet rejected, what was your limitation you wanted?

2 MR. DiGIOVANNI: Shielding.

3 THE COURT: Right.

4 MR. DiGIOVANNI: There's another word, but
5 shield.

6 THE COURT: How do you shield?

7 MR. DiGIOVANNI: I can tell you how the sole
8 embodiment in their patent does it, right, is it has -- the
9 milkshake goes up after mixing. I'm sorry. The lid goes
10 up. The milkshake stays there.

11 MS. SILVERSTEIN: No, no, no.

12 MR. FOSTER: Mixing up there.

13 MR. DiGIOVANNI: There's a chamber up top.
14 There's an open area on the bottom. This is their machine.
15 This is the embodiment, too. Select your milkshake, put
16 it in, you put it in the holder, press a button. It goes
17 up into this chamber. Goes through these secret trap doors.
18 Not secret, but they're trap doors. Goes up in there.
19 The blending happens. You don't see it, there's no window.
20 It comes down. There's a milkshake. Wow, all blended.
21 Okay. Then, as soon as it does that, the lid goes back up
22 into that chamber through the trap doors.

23 MS. SILVERSTEIN: No.

24 MR. DiGIOVANNI: The lid never comes down. I'm
25 sorry, Your Honor. The lid never comes down. So the

1 trap -- the door is used for the holder and the cup. The
2 cup goes up, gets mixed.

3 THE COURT: Okay.

4 MR. DiGIOVANNI: So the lid stays up in the top
5 chamber. The trap doors close and then the rinsing happens.
6 Okay. Then the lid is now clean and ready to be used.

7 We had asked for a construction that required a
8 type of shielding door, so based on this whole embodiment.

9 THE COURT: Okay.

10 MR. DiGIOVANNI: The judge rejected that and
11 said, no. We're going to use the plain and ordinary meaning
12 that has the word while in it. It requires that rinsing
13 occur while the isolating step occurs.

14 THE COURT: Okay. Mr. Chambers?

15 MR. CHAMBERS: Your Honor, I think I can be
16 really brief here. First of all, I think we've established
17 that there's only one dispute on infringement of claim 21,
18 and that's the word while, period, just while. And our
19 proposed claim construction was plain and ordinary meaning.
20 Theirs was that you need the trap door, and it's true in the
21 specification, the trap door is a preferred embodiment. And
22 we said that, no, you don't have to have a trap door. You
23 can also isolate it while you're doing the rinsing by
24 removing the cup from the drink machine. We said there was
25 a second way of doing that in the specification. So that

1 was our position. You didn't need a trap door. You could
2 satisfy the while by removing the cup from the drink
3 machine.

4 And so Judge Sleet, and they argue, no, you
5 can't do a while by removing the cup from the -- from the
6 machine, and you can see what Judge Sleet determined.
7 That's essentially it.

8 THE COURT: All right.

9 MR. DiGIOVANNI: Can I point to just one more
10 slide, Your Honor?

11 THE COURT: Sure.

12 MR. DiGIOVANNI: I think it would be helpful.
13 They said this in their brief and Mr. Chambers said it just
14 now, that there's this second way to do it in their patent
15 that doesn't have a hinged door. It's just not -- it's not
16 supported by the patent specification.

17 The language they cited and that Judge Sleet
18 quoted is the part in yellow at the bottom where it says,
19 the cup may then be removed from the drink machine. The
20 very next line is, next, the hinged doors are closed and
21 rinse fluid is directed. So there's only one embodiment.

22 THE COURT: Why is that relevant to what's
23 before me though?

24 MR. DiGIOVANNI: It's not directly relevant.

25 THE COURT: Okay.

1 MR. DiGIOVANNI: But it certainly corrects what
2 they said in their brief.

3 THE COURT: All right.

4 MR. DiGIOVANNI: And what they said right here.
5 And I think it reflects that the cup may then be removed
6 from the drink machine. That statement itself, that's not
7 what isolating is all about.

8 THE COURT: Okay. Do you want to quickly hit
9 the next one?

10 MR. CHAMBERS: Yes. That would be the '150
11 patent. And so the '150 patent, this is the one with the
12 rinse chamber, Your Honor. And the prior art for that was
13 open, so if you tried to do rinse, it would splash all over
14 the place.

15 So we're asserting claim 15 of that patent, and
16 the only disputed claim limitation on this one that I know
17 of is the rinse chamber in the mixing machine.

18 So at the Markman hearing, Judge Sleet adopted
19 our proposed construction of rinse chamber to mean an
20 enclosure in which a rinse apparatus is positioned to
21 provide rinsing.

22 So if you look at their machine, the MIC2000,
23 the BIC3000, they both have an enclosure in which a rinse
24 apparatus is positioned to provide rinsing, and I put in
25 arrows on the slide to show what defines enclosure. You

1 have the door there. You have these side panels of the door
2 assembly. At the bottom you have the wash chamber and
3 drain. That's where the rinse nozzles are located. They
4 come up from the bottom and they shoot upward towards the
5 splash shield, and that's actually a very key invention of
6 Mr. Farrell, is pre-positioning the rinse nozzle so they hit
7 the top, or, excuse me, the bottom surface of the splash
8 shield.

9 So the rinse nozzles are on the bottom, and then
10 on the top you have the splash shield defines enclosure. So
11 they have the enclosure that meets the limitations of the
12 claim, which is that it has an entrance in the door moveable
13 to a closed position cover in the entrance.

14 So they have a structure in all of their accused
15 blenders that matches Judge Sleet's claim interpretation and
16 the requirements of the claim.

17 So what is their defense here? Their defense is
18 that, well, we now added to our rinse chamber this
19 retractable partition that can go up and down. We put
20 something else inside that can move up and down. And so the
21 law is actually very clear on this, that if you have all of
22 the elements of the claim, in this case, the door, the side
23 panels forming the enclosure, simply by adding more
24 structure, that does not avoid infringement, and that's the
25 A.B. Dick case we cite.

1 So, again, what their argument is during the
2 claim construction, they argued that the enclosure must be
3 separate from the splash shield. The rinse fluid must be
4 confined in the chamber, and so their argument is, well, we
5 put in this new retractable partition, and it wouldn't meet
6 these proposed claim limitations of ours, so -- and Judge
7 Sleet rejected it. He said, no. The claim is does not
8 require that. So what they're doing, they are just trying
9 to reargue the point.

10 THE COURT: Right. I get it. Anything else
11 specific? No? All right.

12 Defendants?

13 MR. DiGIOVANNI: So, Your Honor, just as the 622
14 motion, we don't infringe because we don't do the rinsing
15 while the isolating step occurs. Here, we do not have a
16 rinse chamber.

17 THE COURT: You know, go back to the plain and
18 ordinary meaning. Let's just go back to claim 21 for a
19 second.

20 MR. DiGIOVANNI: Sure.

21 THE COURT: The rinsing, when is the rinsing
22 taking place?

23 MR. DiGIOVANNI: In the accused product?

24 THE COURT: Yes.

25 MR. DiGIOVANNI: In our accused product, the

1 rinsing -- I actually have a video I could play, but the
2 rinsing takes place after someone removes the cup from the
3 machine.

4 THE COURT: Right.

5 MR. DiGIOVANNI: It has to. It's in the way.
6 The cup with the milkshake in it that has just been blended,
7 it's in the way of the whole rinse nozzle and the rinse
8 container. You have to move it out of the way.

9 THE COURT: Isolate it.

10 MR. DiGIOVANNI: You have to do that. You have
11 to --

12 THE COURT: It's occurring while you're
13 isolating.

14 MR. DiGIOVANNI: The rinsing?

15 THE COURT: Yes.

16 MR. DiGIOVANNI: No. We would say no. We
17 would say no, Your Honor. The isolating, and I have a slide
18 where they -- what they point to is isolating, and they have
19 a -- they say in this case -- can you go to slide 10? Thank
20 you.

21 This is in response to our -- we cite case law
22 that says you have to have an active step and this is in
23 footnote three of their reply brief. They say, defendants
24 argue that isolating must be construed as an active step,
25 and their response is, well, in this case, the user is

1 actively removing the cup with their hand from the accused
2 blenders to isolate it from there. Well, if the active
3 removing is isolating, because the word is isolating in
4 there. Rinsing isn't happening. The rinsing is not
5 happening at that point. The rinsing does not happen until
6 after the isolating occurs, not while it's being isolated.
7 While -- after -- I'm sorry. The rinsing does not occur in
8 our product, in our blenders, all the blenders until after
9 this step of isolating occurs. It does not happen while it
10 occurs.

11 THE COURT: Is this in the briefing? I mean, is
12 there a trigger mechanism when you remove the cup that
13 switches on the rinsing, if you know?

14 MR. DiGIOVANNI: I know. I just wonder if it's
15 in the briefing. It's the safety door. You can see the
16 handle on the right there. There's little magnets. You can
17 actually see them. There are two different mechanisms,
18 safety mechanisms. Open that door up, those magnets unclick
19 and now nothing can happen, so someone can reach their hand
20 in there and you are going to be safe.

21 Not only that, but there's a sensor behind where
22 the milkshake would be to sense if the milkshake is still
23 there, because if the milkshake gets somehow stuck into the
24 washer over here, you're going to make a big mess. There's
25 a double sensor, double safety mechanism. You pull that

1 milkshake out, okay, close the door. The sensor senses
2 there's nothing there. Then, only after that happens, after
3 that happens, not while, our wash chamber mechanism, the lid
4 on the wash chamber mechanism comes down over the nozzle and
5 then you see spraying. Actually, you see the spraying going
6 on on the right. So it's sequential in ours. The isolating
7 step is not happening while the rinsing is happening.

8 THE COURT: All right.

9 MR. DiGIOVANNI: Okay. Back to --

10 THE COURT: Yes. Go back.

11 MR. DiGIOVANNI: Okay. And I guess one last
12 thing, Your Honor, just before I leave the '662. Remember,
13 this is all about a method for rinsing a splash shield on a
14 mixing machine, so if their contention is somehow somebody
15 takes this away and that counts as part of the isolating, we
16 disagree. There needs to be that active step of isolating,
17 and that's our -- our argument does not hinge on that, but
18 that's additional reinforcement for that concept.

19 THE COURT: All right.

20 MR. DiGIOVANNI: If we can go back to slide 19.
21 Let's go to 19.

22 Okay. Yes. So the accused products don't
23 infringe because we do not have a rinse chamber having a
24 door. Okay. Judge Sleet did defines rinse chamber and
25 we're abiding by that and there's no complaint about that

1 whatsoever. But the rinse chamber has to have a door.

2 Okay.

3 The plaintiffs construct an ad hoc enclosure
4 that they point to. They say, aha, that's your enclosure.
5 That's your rinse chamber. But there's a problem with that,
6 three problems with that. It's not an enclosure. Okay.
7 It's not a rinse chamber having a door, and it's certainly
8 not suitable for rinsing.

9 Now, so just as a summary, the accused products
10 have a wash chamber without a door, and on the accused
11 products, the door assembly is immaterial to rinsing.

12 So let me get to these points quickly. Claim
13 language we've already seen, requires that there be a rinse
14 chamber having an entrance and a door moveable to a closed
15 position covering the entrance. Okay. And there's no
16 dispute, whatever it is that's being pointed to as a rinse
17 chamber has to be, has to have a door. And then Judge
18 Sleet's construction is below. Rinse chamber is construed
19 to mean an enclosure in which a rinse apparatus is
20 positioned to provide rinsing. Okay.

21 So that was my video. I won't play the video to
22 save time unless Your Honor wants to see it. Okay.

23 Here are stills of the video. This is a view of
24 our wash chamber, I will call it, in which rinsing does
25 occur. The safety doors are taken off here so you could see

1 it better. So is the top sort of -- the control panel, so
2 you can see what's going on.

3 So our wash chamber is that cylinder with the
4 lid and the cylinder and it comes down and it comes down.
5 In the left position it's down, and you can see there's
6 water. That's rinsing going on.

7 That would be the natural thing for them to
8 accuse, ah, there's your rinse chamber. The problem is it
9 doesn't have a door, so they can't accuse that. So they
10 don't accuse that as being the rinse chamber. There's no
11 door. That would clearly, absolutely not infringe, so they
12 don't even bother with that. Instead they have to
13 construct, and this is where their expert says, I don't see
14 a door on that. So there's no dispute there's no door on
15 our cylindrical wash chamber.

16 So, and, again, here is -- this is just -- this
17 is their brief talking about -- yes. I think we can skip
18 over some of this, Your Honor. I'm just looking to save
19 some time here.

20 THE COURT: Yes. This is repetitive. You've
21 got a door.

22 MR. DiGIOVANNI: Yes. There's no door.

23 THE COURT: I'm sorry. Right.

24 MR. DiGIOVANNI: That's right. There is no
25 door. That's right. So what do they do? They have to find

1 something in order to accuse us of infringing the door.

2 There's only one door on that machine and it's that safety
3 door.

4 So they say, okay. That's your door, and then
5 once they do that, they have to then figure out, well, what
6 are we going to now accuse as the rinse chamber? So they
7 kind of -- they construct one and this is both their opening
8 and reply brief and it actually says the same thing on the
9 slide we just saw from Mr. Chambers. They say, the
10 enclosure is defined by the door, the door assembly side
11 panels, which are these clear panels that kind of look like
12 a door. There's no handle and they don't open or close.
13 And then they say the wash chamber/drain. Presumably,
14 that's the bottom of it. And then the splash shield. They
15 say, aha, that's your enclosure and that's your rinse
16 chamber. That's what they say.

17 So that's their infringement contention. They
18 say that, Hamilton Beach, that is your enclosure and that is
19 your rinse chamber. But here's what looks like it if you
20 put it into graphical. The enclosure is defined by -- the
21 left may be the most clear, Your Honor. It's the door and
22 then you have the left and right clear panels, and then you
23 have the splash shield, which is defined as the lid, which
24 moves up and down, and then they say, the wash
25 chamber/drain, which is depressed a couple inches

1 underneath.

2 How is that an enclosure? It's not, Your Honor.
3 That's sort of a mishmash of parts, makeshift, cobbled
4 together components, but in no way is that an enclosure let
5 alone a rinse chamber with a door.

6 So that is their allegation. They say, that's
7 your enclosure, that's your rinse chamber. We say, no, it's
8 not even an enclosure, and it's certainly not a rinse
9 chamber.

10 So --

11 THE COURT: Can the mixing occur when the door
12 is open?

13 MR. DiGIOVANNI: Oh, no, Your Honor. Safety.

14 THE COURT: Yes.

15 MR. DiGIOVANNI: There's a two safety mechanism
16 lockout. That cannot happen. Once that door is open, I
17 understand it's an electrical lockout. Nothing else can
18 happen.

19 But it's important to note sort of to understand
20 this functionally, and on the right this explains it. The
21 safety door doesn't even catch water. It doesn't get
22 splashed on and neither do the left and right panels,
23 because our rinsing is happening -- it's happening all in
24 that cylinder. So that would be the natural thing to say,
25 hey, there's your rinse chamber, because that is our wash

1 chamber I will call it just to distinguish the two. There's
2 no door on it. So they had to scramble and they come up
3 with this sort of a makeshift -- makeshift chamber. That's
4 not a chamber. I mean, you have a disk on the left. I
5 tried to make a PowerPoint. That moves up and down. That's
6 the top? That doesn't make any sense. That's not an
7 enclosure.

8 THE COURT: Okay.

9 MR. DiGIOVANNI: I think I said that. This is
10 just showing you that it's not just me saying that. Our
11 expert did the same thing, did the analysis and said, that's
12 not consistent with the structure and operation of the
13 accused product. He points it out. Comes up with, he says,
14 you know -- this is a different point. But I mean, he says
15 that's not -- what they're accusing he said is not a rinse
16 chamber.

17 THE COURT: All right.

18 MR. DiGIOVANNI: Okay. And this is sort of --
19 one of my final points is, you know, another reason that
20 last limitation talks about the nozzle being within the
21 chamber. I mean, I'm not a hundred percent clear what
22 they're accusing is the chamber, because what they pointed
23 to is certainly not a chamber, but these are recessed pretty
24 significantly below that. That wouldn't even be part of
25 some kind of chamber.

1 And as I stated already, you know, these outer
2 safety doors and pans, they have nothing to do with rinsing
3 in any event if we're talking about bigger picture about
4 what they are actually accusing just to demonstrate that, in
5 fact, their read is quite a stretch. This goes to that
6 point, Your Honor. Thank you.

7 THE COURT: Thank you.

8 MR. CHAMBERS: Your Honor, I can be real brief
9 here. There's only one element in dispute for this claim,
10 which is the rinse chamber, and if you look at Judge Sleet's
11 construction, an enclosure in which a rinse apparatus is
12 positioned to provide rinsing. It also in the claim
13 mentions a door moveable in an entrance.

14 THE COURT: Can I ask you --

15 MR. CHAMBERS: Go ahead.

16 THE COURT: The rinse chamber in their product,
17 is it the cylinder?

18 MR. CHAMBERS: That's added to the enclosure.
19 Now, remember, in the prior technology you just had it
20 opened where you didn't have any sort of enclosure
21 whatsoever, and the water would be splashing all over the
22 place. So part of the invention was coming up with the idea
23 of having an enclosure so you don't have water splashing all
24 over the place with a door.

25 So this meets the literal -- the literal

1 language of the claim and also the concept, which is having
2 an enclosure within which to contain the water.

3 So let me give you an analogy here, which would
4 be a shower room. So a shower room in Judge Sleet's
5 construction is an enclosure in which a rinse apparatus is
6 positioned to provide rinsing. So you could describe a
7 shower room with that.

8 So what they've done is they put in shower
9 curtains in the shower room and they said, okay. We no
10 longer have a shower room because we put a curtain in the
11 shower room to restrict the water. Well, it still meets the
12 definition of shower room because you've still got an
13 enclosure with a rinse apparatus positioned to provide
14 rinsing.

15 So, again, the structure is not in dispute. We
16 only have one claim element. It really is getting back to a
17 claim construction dispute, but the Court can make its own
18 determination about whether they have a door and an
19 enclosure.

20 THE COURT: Okay. All right. There was a third
21 thing you had real quick? No. Mr. Flynn, you were dealing
22 with that. Did you already deal with that?

23 MR. FLYNN: Your Honor, the only other one in
24 addition to the public use which we discussed is we did have
25 a final summary judgment on no invalidity of the '662 patent

1 based on any admissible prior art. The Court has now struck
2 all of their prior art for the '662 patent, so we would ask
3 for summary judgment on that.

4 THE COURT: Do you challenge that now that I've
5 ruled on Sato?

6 MR. FOSTER: As far as prior art goes, that's
7 right, Your Honor.

8 THE COURT: All right. Then the defense, do you
9 want to present argument on your summary judgment motion at
10 all?

11 MR. DiGIOVANNI: Yes Your Honor. Thank you.

12 So this one, Your Honor, we've talked about a
13 bit earlier in the context, the '658 patent. We've talked
14 about it in the context --

15 THE COURT: Can I ask you incidentally --

16 MR. DiGIOVANNI: Yes.

17 THE COURT: -- how these patents work? You
18 know, if one or two patents is taken out of the case, what
19 is do it really do? What's the effect?

20 MR. DiGIOVANNI: If one or two are taken out of
21 the case?

22 THE COURT: Are taken out of the case, yes.

23 MR. DiGIOVANNI: It's all case specific, but in
24 terms of this case, the '377 --

25 THE COURT: I meant this case.

1 MR. DiGIOVANNI: The '377 has expired, so I'm
2 not sure why it's in it. I'm not the damages person in this
3 case, but as I understand it, there's no damages even being
4 alleged based on '377.

5 MS. SILVERSTEIN: Well, it affects our damages
6 calculations. Their expert has said that it has no value to
7 their damages case.

8 THE COURT: Do you agree with that?

9 MR. CHAMBERS: Do you want to address that?

10 MR. FLYNN: Your Honor, I think both experts
11 analyzed the '377, but I agree that any damages implications
12 on the '377 are fairly minimal.

13 THE COURT: Okay.

14 MR. DiGIOVANNI: And it's expired, so there's no
15 injunction.

16 THE COURT: Right.

17 MR. DiGIOVANNI: So it seems not to have purpose
18 in this case.

19 THE COURT: All right.

20 MR. DiGIOVANNI: And another thing is, Your
21 Honor, as we had -- well, anyway, that one stands alone in
22 that it has a different priority date, a different
23 specification, and the other three stand, are together as a
24 group because they're all based on the '150. So '377 does
25 stand out. So I hope that addresses your question in terms

1 of what you do.

2 THE COURT: Okay.

3 MR. DiGIOVANNI: All right.

4 THE COURT: Go ahead.

5 MR. DiGIOVANNI: So '658, Your Honor. The '658.

6 As you'll recall, that's the patent and this is our motion
7 for summary judgment of noninfringement on the '658.

8 Okay. So we're going to focus on for
9 noninfringement, but we thought we would focus on the two
10 limitations that we talked about in terms of no DOE, and
11 that would be the unrestrained limitations. I say plural
12 because there are a couple of claims asserted, so they're
13 slightly different but not materially that it would affect
14 this motion.

15 Unrestrained limitations and the sufficient mass
16 limitations. A quick summary even again. This all is about
17 the splash shield. Okay. And the splash shield, now that
18 we're getting familiar with the prop here, the splash
19 shield, agreed upon definition, is the lid. Okay. The
20 black part. That's the lid. We certainly say it's the
21 black part. It's all about the splash shield, and it has to
22 do two things that are independent of each other. The
23 splash shield has to be unrestrained against sliding
24 movement on the shaft away from the opening, so up and
25 down, axial. And the splash shield has to have sufficient

1 mass to retain the cup within the cup holder. We talked
2 about that. I don't need to repeat that.

3 THE COURT: All right.

4 MR. DiGIOVANNI: Unrestrained, we'll go with
5 unrestrained first. In both claims, they're precisely the
6 same because the parties have agreed upon a construction as
7 to what unrestrained means in both claims, both claims 1 and
8 6. Those are the two independent claims.

9 Unrestrained means at the bottom without any
10 other mechanical means of restraining the upward sliding
11 movement of the splash shield on the shaft apart from the
12 mass or the weight of the splash shield itself. Okay.

13 That construction is particularly important
14 because there's an implication within it that, in fact,
15 weight is a mechanical means. Okay. Without any other
16 mechanical means of restraining the upward sliding on the
17 shaft apart from the mass or weight of the splash shield
18 itself. Okay.

19 Now, that comes up a little bit later when we
20 talk about what we -- this is going to the patent. This is
21 the embodiment of the patent. It's the floating splash
22 shield by itself. No weights, no springs, nothing. No
23 friction. There's no bearings it's dealing with. This is a
24 floating splash shield. Okay.

25 In the accused product our lid is restrained two

1 different ways. One by that additional weight, holding up
2 this for the record. Restrained number one by the
3 additional weight. And, number two, by the friction force,
4 friction that results between three different things.
5 You saw in some of those other videos -- let me just go to
6 one.

7 There are bearings that grasp the two rods that
8 are above the lid. Okay. And there's the -- the blade rod
9 goes through here, and this is called the spindled seal.
10 There's friction in all three of those locations resisting,
11 restraining. Okay. So those are the two restraints, means
12 of restraint, mechanisms of restraint, mechanical means of
13 restraint.

14 THE COURT: If you go back to the drawing of
15 the, I'm going to call it the third or an embodiment.

16 MR. DiGIOVANNI: Sure.

17 THE COURT: Right. How is that lid moving up
18 and down? That is supposed to be unrestrained. Isn't it
19 hitting friction on the axle or on something? No?

20 MR. DiGIOVANNI: The only thing that causes it
21 to move up and down, it has no -- nothing attached to it.
22 The only thing is the cup that's below it. When the cup
23 moves up, the lid moves up.

24 THE COURT: Well, so in rest, point of rest,
25 just down at the bottom there over the blade?

1 MR. DiGIOVANNI: Exactly. I think that's
2 correct. You see that sort of trapezoidal portion there.

3 THE COURT: Yes.

4 MR. DiGIOVANNI: It gets caught on that.

5 THE COURT: All right.

6 MR. DiGIOVANNI: But when the cup is up there --

7 THE COURT: Right.

8 MR. DiGIOVANNI: When the cup elevator goes up
9 and it will take it off of that trapezoidal point and lift
10 it up, you know, the side of the length of a cup. Never
11 does the embodiment have anything else -- have anything else
12 restraining it other than the weight of itself. It's like a
13 baseball donut or whatever you would call it that's heavy
14 enough to force that, the cup down so it's on the --

15 THE COURT: Okay.

16 MR. DiGIOVANNI: So looking at the two different
17 ways, our, the defendants' lid is restrained, the first one,
18 number one here. It's restrained by the additional weight,
19 attached by rods. The cast iron weight, you know, the
20 engineers say it's cast iron. The addition of the weight
21 makes it heavier. Their expert Maynes says to retain the
22 Hershey cup, that's the cup they use in the machine, in the
23 MIC2000, that's one of our models, the Hamilton Beach --
24 Hamilton Beach places a heavy cast iron guide rod weight on
25 top of its splash shield. That's what they say. And in

1 their opening brief they say, look, this heavy guide rod
2 weight pushes down on the cup and thermally holds the cup
3 firmly in the cup holder. There's no doubt that guide rod
4 weight, which is elevated as you saw above the lid, and even
5 if it weren't elevated, the elevation is irrelevant. It is
6 not the lid, and the construction makes clear that it needs
7 to be the lid, okay, that is unrestrained, and the lid that
8 has sufficient mass.

9 THE COURT: Okay.

10 MR. DiGIOVANNI: The same with unrestrained.
11 This is from plaintiffs' answering brief to the motion.

12 The defense, they're putting in is a DOE
13 defense -- not defense. They're the plaintiff. But the
14 allegation is not one that, hey, no, no, your lid is heavy
15 enough. Your lid is unrestrained. They are using DOE
16 language here. They are saying, well, the guide rod weight,
17 that's an integrated functional part of it. That's DOE
18 language. They are saying, okay. You don't have -- you
19 don't have the lid, but you've got something that kind of
20 acts like it. That's DOE language and that's why the DOE is
21 very important to us.

22 THE COURT: Okay.

23 MR. DiGIOVANNI: And then this is their
24 answering brief. Again, DOE language. They call it a
25 splash shield assembly as a functional unit. DOE word.

1 They are not even making the literal infringement argument.
2 It essentially, it is a DOE argument, and that's why we
3 argue that.

4 Okay. Now we go to part two, and this is the
5 friction. It's really the bushings and the spindle seal as
6 I pointed out. Those are the three points where friction is
7 occurring. Those are the three mechanical means that are
8 restraining it.

9 Okay. Our engineer says, yes, there's several
10 things that would inhibit moving the lid upwards. The
11 weight would be one. You'd also have the friction inside
12 the bushings, and you'd have the friction inside the
13 spindle. This is our engineer.

14 Another engineer says, friction? Yes, there
15 will be friction. It would restrict the upward movement.
16 And then we have their own expert. He says, there
17 theoretically could be minor friction on the guide rods, and
18 he says it's possible that there could be friction in the
19 spindle. This is his report. Then at his deposition he
20 says, there's friction. Of course, there's friction there.

21 And as a sort of footnote to this slide, you
22 know, one of Dr. Maynes', in response to the summary
23 judgment motion, one of his five points of testing in his
24 new report, he does some kind of technical friction test and
25 he says, the friction is tiny. Therefore, you shouldn't

1 consider it. I'm paraphrasing it. I didn't study it to the
2 point where I know it is. But, again, we have not had a
3 chance to depose Dr. Maynes. It would be unfair to you.
4 I'm not going to reargue that point, Your Honor. But at a
5 deposition he says, yes, there's friction. Of course,
6 there's friction there.

7 And --

8 THE COURT: So you're going to get to put in
9 front of a jury his earlier statement. Right?

10 MR. DiGIOVANNI: Yes.

11 THE COURT: You don't dispute that. Right, Mr.
12 Chambers? They get to put in front of the jury --

13 MR. CHAMBERS: Yes, they get to put in his
14 deposition testimony.

15 THE COURT: No. They get to put in his expert
16 report to the extent he had a prior inconsistent statement.
17 Right?

18 MR. CHAMBERS: Yes, I would say so.

19 THE COURT: All right.

20 MR. DiGIOVANNI: The problem is he's going to
21 say, but, yeah, I tested it, and look, it's .0001 Newtons.
22 I'm not sure what it says exactly.

23 THE COURT: Right.

24 MR. DiGIOVANNI: But he's going to say that is
25 negligible, and the person -- a person of ordinary skill in

1 the art would consider that to be no restraint whatsoever.
2 It's very different than what we had when we had his
3 deposition in his original report. All right. I don't want
4 to belabor that point.

5 So this is something in their answering brief.
6 Not much to say about it except they say that the friction
7 argument is analogous to arguing that gravity is an other
8 mechanical means that restrains the splash field. Gravity
9 is part of the weight. Mass plus gravity is weight, so
10 actually gravity plus mass is another mechanical means. We
11 wouldn't point to gravity, but if there's a mass like there
12 is, gravity acts on that and that is another mechanical
13 means.

14 More about the friction. Their own Dr. Maynes
15 says before that new testing, but he says in his report,
16 nonetheless, these incidental frictional contacts, so he's
17 conceding there's frictional contacts. These incidental
18 frictional contacts are not the type of mechanical means
19 that the patent, the patent was designed to avoid. So he is
20 the one doing claim construction here once again.

21 THE COURT: Let me just ask you. I want to ask
22 Mr. Chambers, and I do not have an opinion on resolution of
23 this pending dispute, but for argument's sake, if I've got
24 Hamilton Beach's expert says the -- let me see. Hamilton
25 Beach's position is the lid is restrained by friction. Is

1 that correct?

2 MR. DiGIOVANNI: As well as --

3 THE COURT: As well as the weight.

4 MR. DiGIOVANNI: As well as the weight, correct.

5 THE COURT: And they've got an expert who
6 supports that he says. And then I've got Maynes. And I
7 look at Maynes' opening report and it's consistent entirely
8 with that. And then I've got -- just hear me for argument's
9 sake. I'm not saying I concluded that. But if I accept his
10 expert and I say that's right, but then I've got Maynes
11 takes a subsequent different position, and let's say that
12 the subsequent position he takes is the only arguably
13 disputed factual assertion. Can't I just grant summary
14 judgment for the defendant at that point because I've got
15 really undisputed fact that it's too late for him to make it
16 up?

17 MR. CHAMBERS: Let me just read from his report.

18 THE COURT: Just answer the question. I'm
19 asking a hypothetical question. I will let you argue all
20 you want.

21 MR. CHAMBERS: Okay. So the answer is he's now
22 taking a different position. It's not the case.

23 THE COURT: Okay. All right. Well, actually,
24 that's helpful. So your position would be that I need to
25 interpret his subsequent report consistently with what his

1 opening report said?

2 MR. CHAMBERS: Yes. They're both consistent,
3 I'd agree with that.

4 THE COURT: Okay.

5 MR. CHAMBERS: Yes.

6 THE COURT: All right.

7 MR. DiGIOVANNI: Okay.

8 THE COURT: Mr. DiGiovanni, if that's the case,
9 then do you really have to worry about his testimony?

10 MR. CHAMBERS: Again --

11 THE COURT: I was asking Mr. DiGiovanni a
12 question.

13 MR. DiGIOVANNI: Do I have to worry about --

14 THE COURT: In other words, he says he's going
15 to come in and put up these numbers, but he has an estimate
16 that's definitive there.

17 MR. DiGIOVANNI: We absolutely have that, but he
18 is going to come in and say, yeah, since that time I've gone
19 out of the laboratory and I've done this and that. Look at
20 these wires, look at my photos doing that, and I used this
21 calorimeter, whatever he used. I mean, he comes up with
22 this testing protocol that, you know, we certainly don't
23 agree with. We haven't had him tested on it. We didn't
24 take his deposition.

25 THE COURT: But your point, am I right that

1 you're saying this excerpt from Maynes' opening report
2 supports your summary judgment argument?

3 MR. DiGIOVANNI: Yes, it does.

4 THE COURT: All right.

5 MR. DiGIOVANNI: Yes.

6 THE COURT: And so if I find that, I'm being
7 told by Mr. Chambers that the subsequent report is entirely
8 consistent with this?

9 MR. DiGIOVANNI: You are being told that and I'm
10 willing to accept that stipulation, but I'm worried about
11 him on the stand showing his --

12 THE COURT: But I'm on summary judgment now.

13 MR. DiGIOVANNI: Yes.

14 THE COURT: All right. Do you have anything
15 else you want to add?

16 MR. DiGIOVANNI: I think there are a few more
17 Your Honor. A few more slides that would be worthwhile.

18 So we were talking about friction. I think we
19 end friction. Oh, get to DOE. I think maybe I don't have
20 any more, Your Honor.

21 THE COURT: All right.

22 MR. DiGIOVANNI: I'm sorry. Can I just check
23 how I concluded that? I didn't get to sufficient mass, Your
24 Honor. I actually did not get to my sufficient mass slide.
25 I will start at 51, please.

1 So I can go through this quick. Just like we
2 don't have unrestrained, that lid by itself, which is what
3 the claim construction requires, claim construction calls
4 the splash shield is a lid, they have no proof, they've put
5 nothing forth to show that the splash shield is sufficient
6 to retain the cup into the cup holder. Completely failed
7 proof on that. So there's nothing that they have.

8 THE COURT: Because they have not isolated the
9 weight you would say?

10 MR. DiGIOVANNI: They have not done that, that's
11 correct, and they have not even suggested doing that.
12 Instead they are saying, I think they're still saying you
13 look at all of this stuff against the DOE argument.

14 THE COURT: All right.

15 MR. DiGIOVANNI: Yes. They have not isolated it
16 or done the math. I don't think he did it any new testing.
17 No, okay.

18 THE COURT: All right. That's a pretty quick
19 argument.

20 MR. DiGIOVANNI: Yes. See, here they point to
21 the assembly in sufficient mass.

22 THE COURT: All right.

23 MR. DiGIOVANNI: Then we go to DOE. I think
24 that's it, Your Honor.

25 THE COURT: All right.

1 MR. DiGIOVANNI: Except there is one last one,
2 slide 58. This is five seconds. There's also this other
3 claim 5. I'm not sure whether you are still maintaining
4 that. That's about the five pounds. So I do have a slide
5 on that if Your Honor wants to see slide 58. That is,
6 there's no material -- we can't possibly infringe this
7 claim that says the splash shield is approximately five
8 pounds.

9 Here is showing somebody weighing the thing and
10 it's 527 grams. That's 1.6 pounds. The Dairy Queen version
11 on the right is only half that weight. It's only half a
12 pound, yet they are still alleging, they are still bringing
13 this claim against us that says the splash shield has to be
14 half a pound. So we would urge --

15 THE COURT: Okay.

16 MR. FOSTER: We would urge noninfringement on
17 all of the '658 claims, Your Honor, based on sufficient mass
18 and unrestrained limitations.

19 THE COURT: All right. Thank you.

20 Mr. Chambers?

21 MR. CHAMBERS: So here, let me go back to the
22 point I made earlier. Remember, the prior art had springs
23 to keep the splash shield down or to have the motor to keep
24 it down. So Mr. Farrell's invention was the idea of
25 weighted splash shield with free movement up and down.

1 That's the essence of his invention, and I think that is
2 shown. Let's see. Here we go.

3 Yes. You can see it here. And to answer Your
4 Honor's question, yes, there can be friction there also when
5 that splash shield is moved up and down. If that gets
6 misaligned somehow, there is going to be friction against
7 the spindle.

8 So, you know, for one of ordinary skill in the
9 art, what mechanical means is in the context of this
10 invention is what was being distinguished when the
11 prosecution was made in Patent Office, which is, no, we're
12 not going to do springs, no, we're not going to do motors.
13 We have a different approach of a weighted splash shield
14 that moves freely up and down. So that is the invention.

15 So let's go to the sufficient mass first. So if
16 they're not going to do sufficient mass, why do you put a
17 heavy cast iron weight on top here? That screams out and to
18 the jury right there, that's the big question for the jury.
19 If you are not using Mr. Farrell's patented invention, why
20 do you put this heavy weight on top -- and you can see from
21 the way I'm holding it, that this is an integrated unit,
22 that this is an integral structural part of this unit and a
23 very integral functional part. That's something that the
24 jury can look at and they can decide whether this weight has
25 anything to do with keeping the splash shield down so that

1 the cup is not spinning around. And when they say that,
2 well, they have not shown that it doesn't move around, well,
3 we actually have. They showed it in their own videos, and I
4 think I may have that here also.

5 Yes. Here it is. In their videos, when they
6 put the, this cast iron weight on top, it solves the problem
7 that they were having earlier of the cup spinning around,
8 and you can see from the videos, and the jury will be able
9 to see, too, that the cup is not spinning around anymore
10 when you use Mr. Farrell's invention.

11 So, yes. And then Dr. Maynes, as you can see,
12 put a gauge on the weight here, this unit that I'm holding,
13 and you can see it measured 4.5 pounds, which is
14 approximately five pounds.

15 So let's go to unrestrained. Still, the key
16 point here is why do you put on this heavy weight if you are
17 not trying to take the invention? Okay. Unrestrained. And
18 let's see.

19 Yes, we discussed the other mechanical means,
20 which were the springs and the motors and the nature of
21 his invention and the fact that there could be friction
22 there.

23 And so what about the Hamilton Beach device?
24 Let's work in the real world now instead of the theoretical
25 physics world. Hamilton Beach technical specifications

1 said, the shield assembly must move freely up and down with
2 no binding. All right. Move freely. I can cross-examine
3 Dr. Slocum on that. Is moving freely restrained or
4 unrestrained?

5 Two, Hamilton Beach's design engineer,
6 Mr. Branson, testified that design for that assembly has
7 always been for it to fall under its own weight. Free
8 movement, unrestrained.

9 Dr. Maynes, there he is right there in the
10 picture. He tested it and moved it up and then dropped it
11 and he found no discernible friction. This is the real
12 world. It's free moving in the real world.

13 And then so incidental friction. Again, as Dr.
14 Maynes testified in his declaration, one of skill in the art
15 would not consider that an other mechanical means. What was
16 referred to there is what was the prior art before the
17 Patent Office that was being distinguished.

18 And so let me read what Dr. Maynes said in his
19 report because we keep referring to it, and this is on page
20 57 of his opening report.

21 He says, although there theoretically could be
22 minor friction on the guide rods holding Hamilton Beach's
23 cast iron weight that may inhibit unrestrained upward
24 movement of Beach's splash shield during mixing, Hamilton
25 Beach's engineers freely acknowledge that the purpose of the

1 splash shield design has always been for it to fall under
2 its own weight, citing Branson and Williams' deposition. To
3 accomplish that objective, Hamilton Beach uses lubricious
4 materials from the seals and bushings coming in contact with
5 Hamilton Beach's spindle and guide rods. It's also possible
6 there could be friction between f'real's rotatable spindle
7 and f'real's weighted splash shield that could inhibit the
8 unrestrained upward movement of f'real's waited splash
9 shield. Nonetheless, these incidental frictional contacts
10 are not the type of mechanical means, e.g., springs, gear
11 assemblies, to hold down the splash shield that the weighted
12 f'real splash shield was designed to avoid.

13 Within the context of the '658 patent disclosure
14 and the real world, Hamilton Beach has plainly appropriated
15 f'real's invention of a splash shield having sufficient mass
16 that is unrestrained as it moves upward during the mixing
17 process.

18 THE COURT: All right. Thank you.

19 All right. Those were helpful. I mean, I've
20 got to really do a deep dive now into the briefs and I will
21 just try to move as fast as I can.

22 MR. DiGIOVANNI: We did have one more
23 noninfringement motion, the '377 patent. That's the
24 patent --

25 THE COURT: That expired. Okay. Go ahead.

1 Sorry.

2 MR. DiGIOVANNI: I don't have to, Your Honor. I
3 guess they withdraw it. They withdraw their motion.

4 THE COURT: Actually, what's the position on the
5 '337?

6 MR. CHAMBERS: Yes. We can put on a
7 presentation. We obviously curtailed ours because this has
8 been going on for five hours now.

9 THE COURT: Yes. I think I've heard enough.
10 So on jury instructions and voir dire, you
11 submitted the Word versions. Is that correct?

12 MR. FOSTER: Yes, Your Honor.

13 THE COURT: Both sides?

14 MR. FLYNN: We had, Your Honor. We submitted
15 joint instructions. We're going to perhaps need to modify
16 those.

17 THE COURT: I expect that.

18 MR. FLYNN: As being part of the case.

19 THE COURT: And, yes. You know, we'll get to it
20 as soon as we can.

21 So the trial is scheduled to begin a week from
22 Monday.

23 MR. FLYNN: Two weeks from Monday.

24 THE COURT: Two weeks. Well, that's good. All
25 right. So we're doing willfulness, so we'll plan on

1 eleven-and-a-half hours each side. I think that's
2 sufficient. And I've already explained how we'll move --
3 how we'll time it rather.

4 Anything else?

5 MR. DiGIOVANNI: Just on that '377 patent. Just
6 to let you know, there are slides in my deck.

7 THE COURT: Oh, that's fair enough. Frankly, I
8 will probably look at them. In fact, Mr. Flynn, were you
9 going to do the '377 argument?

10 MR. FLYNN: I'm sorry?

11 THE COURT: Were you doing the '377 argument?

12 MR. FLYNN: No.

13 MR. CHAMBERS: No. I hate to be a hog here,
14 Your Honor. I was planning on doing it. We do have slides
15 in our deck.

16 THE COURT: Do you want to bring them up?

17 MR. FLYNN: Yes.

18 MR. DiGIOVANNI: Ours are part of our master
19 deck. Slide 59 through the very, which is -- that is not
20 the very end. Through 69.

21 THE COURT: Okay. We'll start picking the jury.
22 They come up at 9:30. I get here at 9:00 on Monday morning.
23 I'm going to seat the jury and so far every jury has done
24 it. They again at 8:30 and we cruise.

25 MR. FLYNN: Your Honor, if I could just get one

1 clarification with respect to the Daubert motion with
2 respect to Dr. Maynes.

3 THE COURT: Yes.

4 MR. FLYNN: I understand that the evidence that
5 he cites, you want that coming in through a precipient fact
6 witness regarding commercial success.

7 THE COURT: Yes. I mean, I wouldn't mind
8 hearing where you're coming from on that. I read that
9 affidavit. I thought there were gratuitous, you know,
10 references to how greedy these people are. I don't know how
11 anybody thought that would come in. He's an infringement
12 guy. Why is he talking about all of the sales revenue
13 numbers, and then even in the response brief you all
14 basically said, yes, he's reciting undisputed facts. I
15 mean, it didn't seem necessary to his opinions.

16 MR. FLYNN: Your Honor, I only ask --

17 THE COURT: I'm inviting you if you want even
18 though I've already ruled to maybe tell me in 30 seconds,
19 what's the point?

20 MR. FLYNN: Your Honor, it's relevant to the
21 secondary considerations of nonobviousness where he's
22 discussing the commercial success of the products.

23 THE COURT: Right. But he's a mechanical
24 engineer. How does he offer opinions about that? That
25 seems economic or it seems a factual issue.

1 MR. FLYNN: I understand, Your Honor, but he's
2 also offering opinions about copying, which go to
3 willfulness, which we didn't really address because we
4 thought it was out.

5 THE COURT: But I don't have a problem if he
6 says, I'm looking at this device and I compare this device
7 to the accused device and they're the same. I get that.

8 MR. FLYNN: Right.

9 THE COURT: But his paragraphs in question went
10 to the state of mind and the intent to copy and that seems
11 to me clearly precluded by the law from coming in. And so I
12 did not mean to suggest by the opinion that he can't look
13 at a device and compare it to another device. I mean, he
14 can do that. I don't think you would reject that. Would
15 you?

16 MS. SILVERSTEIN: I want to just note on the
17 record, he doesn't do that in his report. We would object
18 to it on that basis.

19 THE COURT: So if he didn't do it in his report,
20 then he can't do it.

21 MS. SILVERSTEIN: Yes. If he had in his report
22 something where he was comparing our machine to the f'real
23 machine, we would have no objection. He has no opinion of
24 that in his report. He compares to the claims. That was
25 all briefed.

1 THE COURT: Right.

2 MR. CHAMBERS: Your Honor, let me mention, with
3 regard, he does testify on obviousness, which is important
4 on validity since they are challenging these patents on
5 obviousness. And you have the Graham versus John Deere test
6 for the scope and content of the prior art, level of
7 ordinary skill in the art, the differences, and then the
8 fourth factor, which the Federal Circuit has said is often
9 the most probative, is secondary considerations, such as
10 commercial success and copying.

11 THE COURT: But what's his specialized
12 knowledge? I didn't see anything. He's a mechanical
13 engineer. Commercial success you need an economist or you
14 need -- and, frankly, you don't even need an expert. You
15 can just introduce the sales figure and make a legal
16 argument.

17 MR. FLYNN: Your Honor, the issue is we need
18 somebody to tie the f'real patents to the commercial,
19 f'real's commercial embodiment. Somebody needs to do that
20 nexus analysis. He discusses that in his report, that
21 they do embody the f'real commercial product, that they
22 copy, embody the f'real patents. And you have to have that
23 nexus.

24 THE COURT: Wait a second. Go ahead.

25 MS. SILVERSTEIN: I would dispute that. He

1 specifically testified that in the deposition he did not
2 perform an analysis of whether the commercial success goes
3 to each claim, and that's the nexus that is required for
4 obviousness and he didn't do that. He said during the
5 deposition, I did not look and see what success went to
6 claim 21 of the '662, what goes to these two.

7 THE COURT: Right. Here's where I am. I
8 invited it. I'm tired. It's five of 6:00. I appreciate
9 you, Mr. Flynn, making the arguments. I'm going with my
10 ruling, but anyway. So you want clarity?

11 MR. FLYNN: Your Honor, all I wanted clarity was
12 he won't -- that evidence won't be introduced to him,
13 through him, but to the extent we have it introduced through
14 other witnesses, can he still say, I can rely on these
15 things to demonstrate their copying of the f'real product?

16 THE COURT: I think copying is an intentional
17 thing. He can say -- I mean, that to me goes to intent.
18 Unless you've got a case that tells me copying is something
19 else, copying is -- I look at this and I go and I make
20 something to copy this. That's an intentional act it seems
21 to me, and if you want to -- unless you've got a case that
22 says, no, copying is something different, but it seems to me
23 that's state of mind.

24 MR. FLYNN: But, Your Honor, it's one of the
25 secondary considerations.

1 THE COURT: So you argue it. It's called legal
2 argument. You basically say -- I mean, the way I would do
3 it is I would have factual evidence that says, the accused
4 products copy f'real's products, and I've got evidence
5 through your inventor that says, I came up with this idea
6 and I made this product, which is one of the embodiments in
7 this patent, and then I sold it on the market, and either
8 through this witness or somebody else you say, you know,
9 within a year, it's astounding, a hundred million dollars in
10 sales, something like that. Right? You put that in there
11 and that's commercial success.

12 MR. FLYNN: Okay.

13 THE COURT: The lawyer makes the argument that
14 that is commercial success and that shows you.

15 MR. FLYNN: Understood, Your Honor. I just
16 wanted to make sure we weren't going to be required to have
17 an expert testify about the secondary considerations to the
18 extent that, you know, we needed to do it to show
19 nonobviousness.

20 THE COURT: I don't think so. Does the defense
21 think you need an expert to do that?

22 MS. SILVERSTEIN: I mean, I would argue that
23 they need an expert to show nexus, which their expert hasn't
24 done.

25 THE COURT: To show a nexus?

1 MS. SILVERSTEIN: To show the nexus between the
2 commercial success and the claims of the patent that's
3 required under the law, and their expert didn't to that.

4 So at this point I would imagine that is
5 something we would ask for after they rest their case, that
6 they have not shown that burden, but, no, they don't need an
7 expert to show commercial success.

8 Mr. Farrell or whoever from their company can
9 get up and say the numbers of commercial success. That
10 doesn't require --

11 THE COURT: All right.

12 MR. FLYNN: Understood, Your Honor.

13 THE COURT: Then you're good, I think?

14 MR. FLYNN: Yes.

15 THE COURT: All right.

16 MR. DiGIOVANNI: Just a couple housekeeping
17 matters.

18 THE COURT: Yes.

19 MR. DiGIOVANNI: When Your Honor made the ruling
20 on willfulness, witness availability is something we need to
21 check on and then the pretrial order.

22 I would say we'll meet and confer with these
23 guys about making sure we can get this all done. If there's
24 any issues, we'll contact the Court. That would be my
25 suggestion.

1 THE COURT: I guess. I mean, we're talking
2 though I think one witness. A lawyer, probably?

3 MR. DiGIOVANNI: There might be two. I know
4 there would be at least one. There may be a second witness
5 as I understand it.

6 THE COURT: I mean, look, the plaintiffs are in
7 the same shoes. We've had this trial. There's a
8 misunderstanding. I guess I could be more dictatorial and
9 say, I thought it was clear as a bell. I thought it was
10 clear. I clearly was wrong because there are reasonable
11 people here who interpreted it differently than I did. I
12 don't think we want to be delaying trial because we can't
13 get these witnesses.

14 MR. DiGIOVANNI: Understood, Your Honor. I
15 wasn't asking for that.

16 THE COURT: All right.

17 MR. DiGIOVANNI: There are some things to do.

18 THE COURT: Yes, there definitely are. Please
19 work diligently to see if we can't get them done
20 cooperatively.

21 MR. DiGIOVANNI: Will do.

22 THE COURT: All right.

23 MR. DiGIOVANNI: Inequitable conduct is off?

24 THE COURT: Yes. I've never done one of these,
25 but my understanding is that we'll probably be here like we

1 are right now. We'll do the inequitable conduct testimony
2 in the evenings outside of the province of the jury, so if
3 you have a witness that is going to testify. I mean, that's
4 my understanding how you all have done it in front of some
5 of the other judges. No?

6 MR. SMITH: There are many ways to do it.
7 Occasionally, it's done that way, but I think doing it that
8 way at this stage is going to create -- compound the
9 problem.

10 THE COURT: Okay. What's the alternative?

11 MR. SMITH: It would be to wait and get a
12 verdict back. It's a bench issue.

13 THE COURT: Okay.

14 MR. SMITH: Do a separate, maybe a one-day.

15 THE COURT: Yes. Because of the confusion over
16 willfulness, I think you are probably right, Mr. Smith.

17 What do you think, Mr. DiGiovanni?

18 MR. SMITH: Your Honor, if I might elaborate. I
19 think the same issues on witness availability, exhibits,
20 framing out the pretrial order, all of that would also have
21 to be done on the inequitable conduct, and just --

22 THE COURT: Do you agree with that?

23 MR. DiGIOVANNI: I would agree. I think we
24 assumed it is not going to be done in the evenings.

25 THE COURT: All right. Lesson learned on my

1 part. We'll do inequitable conduct at a date to be
2 determined.

3 MR. CHAMBERS: Your Honor, let me give you
4 another answer to that question very briefly.

5 THE COURT: What question?

6 MR. CHAMBERS: I would respectfully request that
7 Your Honor take a look at our summary judgment brief. Very
8 quickly, there were two prongs for their inequitable conduct
9 argument. One was the alleged public use of this animation
10 at the trade show, and we've shown you the slide where
11 they've admitted that that animation never occurred. So
12 scratch out one leg of their inequitable conduct.

13 The other leg of their inequitable conduct is
14 inventorship.

15 THE COURT: Okay. So I'm going to read the
16 briefs carefully.

17 MR. CHAMBERS: Okay. Could I -- 15 seconds?

18 THE COURT: No. I think we've had a lot of
19 argument today.

20 MR. CHAMBERS: Okay.

21 THE COURT: Let's just call it a day. I read
22 the briefs carefully. That's why I came in here saying, you
23 all threw me for a loop. I think the Delaware counsel can
24 tell you, I normally come very prepared. So a little bit
25 different on the summary judgment today.

1 All right. Anything else housekeeping? No?

2 MR. DiGIOVANNI: We raised earlier about
3 limiting the claims.

4 THE COURT: That I'm going to leave to you. You
5 know what the timing is and I will issue my orders as soon
6 as I can. That may influence your decisions. I don't know
7 how to, especially in this case, which I inherited. All
8 right. Thank you.

9 (Counsel respond, "Thank you, Your Honor.")

10 (Hearing concluded at 6:02 p.m.)

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